

San Francisco Law Library

No.

Presented by

EXTRACT FROM BY-LAWS.

Section 9. No book shall, at any time, be taken from the Library Room to any other place than to some court room of a Court of Record, State or Federal, in the City of San Francisco, or to the Chambers of a Judge of such Court of Record, and then only upon the accountable receipt of some person entitled to the use of the Library. Every such book so taken from the Library, shall be returned on the same day, and in default of such return the party taking the same shall be suspended from all use and privileges of the Library until the return of the book or full compensation is made therefor to the satisfaction of the Trustees.

Sec. 11. No books shall have the leaves folded down, or be marked, dog-eared, or otherwise soiled, defaced or injured. A party violating this provision, shall be liable to pay a sum not exceeding the value of the book, or to replace the volume by a new one, at the discretion of the Trustees or Executive Committee, and shall be liable to be suspended from all use of the Library till any order of the Trustees or Executive Committee in the premises shall be fully complied with to the satisfaction of such Trustees or Executive Committee.

728

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

No. 2195.

H. J. HEINZ COMPANY,

Appellant,

vs.

MAX M. COHN,

Appellee.

BRIEF AND ARGUMENT FOR APPELLANT.

THOMAS A. BANNING,

For Appellant,

SAMUEL W. BANNING,

THOMAS A. BANNING, Jr.,

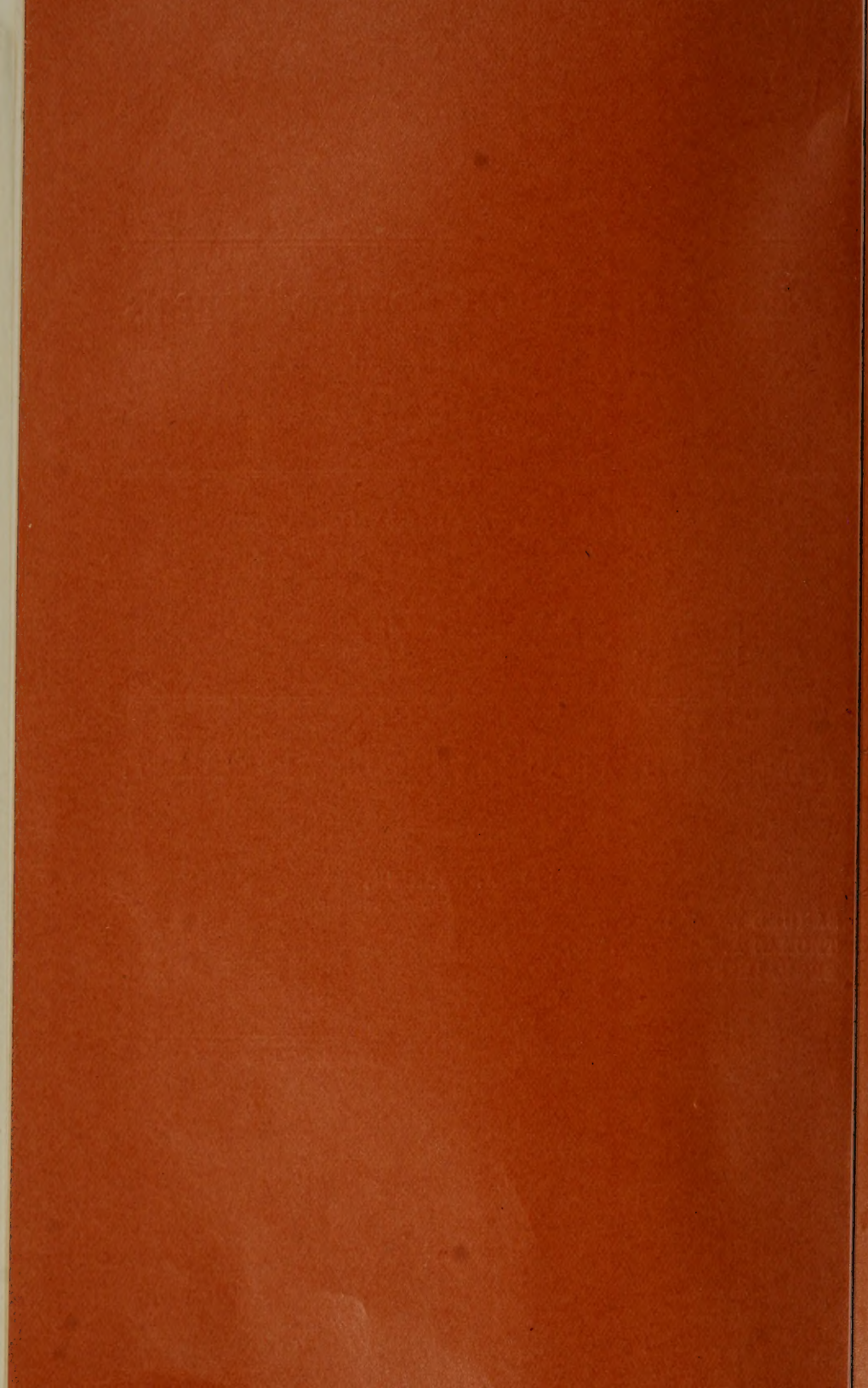
EPHRAIM BANNING,

Of Counsel.

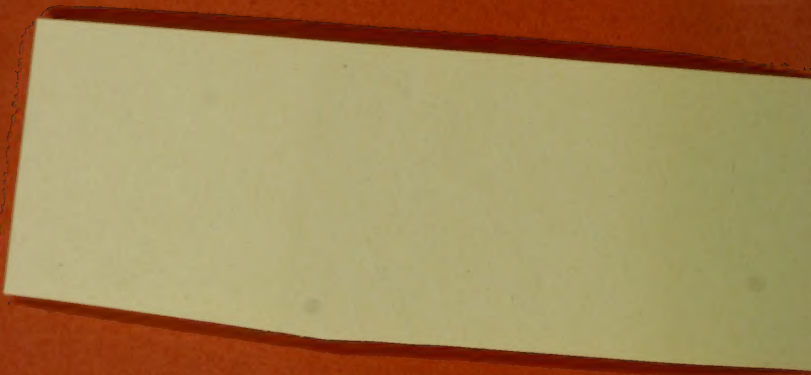
Eastman Bros., Law Printers, 542 So. Dearborn St., Chicago.

FILED

FEB 14 1913



Records of U.S. Circuit
Court of appeals
778



UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE NINTH CIRCUIT.

No. 2195.

H. J. HEINZ COMPANY,

Appellant,

vs.

MAX M. COHN,

Appellee.

BRIEF AND ARGUMENT FOR APPELLANT.

May it please the Court:

This is a suit in equity under letters patent No. 835,850, issued November 13, 1906, to Max M. Cohn, for improvements in Envelopes, and letters patent No. 824,908, issued July 3, 1906, to Max M. Cohn, for improvements in Envelopes.

The patent No. 835,850, issued November 13, 1906, was applied for first, and so throughout the record it has been designated as the first Cohn patent, while the patent No. 824,908, applied for last, has been designated as the second Cohn patent. For convenience, we will discuss the Cohn patents under these names or designations. For a like reason we will refer to the appellant as the defendant and to the appellee as the complainant.

General Statement of the Matter in Controversy.

The two Cohn patents sued on relate to what are known, in popular language, as one-piece transparent window envelopes—envelopes made of one piece of paper by applying a grease or oily preparation to the spot where the address of the enclosure is to appear so as to render it transparent, and allow the address to appear through the transparent portion or window—to distinguish them from two-piece transparent window envelopes—envelopes where the portion over the address of the enclosure is cut out and a piece of oiled or transparent paper pasted in.

The improvement of the first Cohn patent consists in printing a border around the window, either in the form of a ring or large enough to cover the entire face of the envelope outside of the transparent space, so as to cover up and conceal any running of the oily preparation in the fibre of the paper and give a sharp or definite outline to the window. The improvement of the second Cohn patent consists in the envelope of his first patent when the window is made in the form of an article of manufacture or symbol of trade, with permanent advertising matter printed on the face of the envelope in juxtaposition to the window.

Everything was old in the envelopes of the Cohn patents, as the defendant contends, except printing a ring around the grease spot, as such rings had been printed around grease spots on paper used for other purposes. The whole controversy, as the defendant contends, so far as the envelope of the first Cohn patent is concerned, is as to whether it involved invention to print a ring around a grease spot.

Facts Conceded and Disputed.

On behalf of the defendant, it is conceded:

1. That the defendant is an incorporation, as alleged in the bill.
2. That the respective letters patent were granted to the said Max M. Cohn, in due form, as alleged in the bill.
3. That the title to the patents was in the complainant at the time the bill was filed and at the date of which the decree was entered.

On behalf of the defendant it is contended that the following facts and conclusions of law are established by the evidence:

4. That the alleged invention claimed in each of the claims of the first and second Cohn patents involved no invention, in view of the state of the art, and nothing beyond the exercise of ordinary mechanical knowledge and skill.
5. That one-piece transparent window envelopes, made from opaque paper and with window spaces rendered transparent by the application of an oily or similar suitable preparation, are shown or described in the Brown 1862 patent, No. 36,399, in all substantial respects like the envelope of the first Cohn patent, except that the Brown envelope had no border printed around the transparent window or space.
6. That the "border" mentioned in the claim of the first Cohn patent, and in the claims of the second Cohn patent sued on, may be either a narrow ring around the transparent win-

dow, or it may extend solid from the window space to the edges of the face of the envelope, as expressed in the specification of the first Cohn patent, in describing Fig. 2, where he says that, “The *entire* face of the envelope around the window is assumed to have been imprinted or colored to give definition to the window opening and obliterate signs of ‘creep’ in the transparency producing preparation”; or, as expressed in the second Cohn patent, in describing the “border” produced by the coloring matter, where he says that, “This coloring matter may be applied *solid over the face* of the envelope.”

7. That one-piece transparent window envelopes, made from transparent paper or stock, and with borders printed around the space left for the window and extending out to the edges of the envelope face, as Cohn says above that his borders may extend, are shown or described in the Busch 1896 English patent, No. 11,876, as testified by defendant’s witnesses and admitted by Cohn.

8. That the printing on the Brown 1862 patented envelope, made from opaque paper with “only a transparent portion, large enough to exhibit the ‘direction’ through it,” as described in the Brown patent, of the border of the envelope described in the Busch 1896 English patent, made from transparent paper, produces the envelope described and claimed in the first Cohn patent sued on, and was merely a mechanical act, required merely the exercise of the knowledge and skill of the trade or calling of the printers’ craft, and nothing of the character of invention.

9. That for many years before the application for the first Cohn patent it was the common and universal practice in this country among the printers of three-color pictures, the printers of lithograph labels, and the printers of general

kinds of work, to print a border around their pictures or work, to give definition to the same and to cover up and conceal ragged, imperfect, or unsightly edges, resulting from the running of the ink or colors, or for other causes, the work done and the results secured by printing and using such border being in all respects similar in character and kind to the work done and the results secured by Cohn in printing the border on the envelope of his first patent.

10. That the printing on the Brown 1862 patented envelope made from opaque paper, with "only a transparent portion, large enough to exhibit the 'direction' through it," as described in the Brown patent, of the border used by the printers of three-color work, lithograph printers, or printers generally, produced the envelope described and claimed in the first Cohn patent, and was merely a mechanical act, and required merely the exercise of the knowledge and skill of the trade or calling of the printers' craft, and nothing of the character of invention.

11. That the use of "borders" around transparent spaces, both in the use of transparent paper or material, and of opaque paper where the transparent spaces are produced by the use of an oily preparation, or where the transparent space is formed by a separate piece of transparent material, are shown or described in the Tudor 1878 reissued patent, No. 7,514; the Leigh 1894 English patent or publication, No. 21,711; the Busch 1896 English patent, No. 11,876; and the Smith & Brown 1901 English patent, No. 25,532.

12. That the printing on the Brown 1862 patented envelope made from opaque material with "only a transparent portion, large enough to exhibit the 'direction' through it," as described in the Brown patent, of the border around the trans-

parent spaces shown or described in the Tudor, Leigh, Busch, and Smith & Brown patents above described, produced the envelope described and claimed in the first Cohn patent, and was merely a mechanical act, and required merely the exercise of the knowledge and skill of the trade or calling of the printers' craft, and nothing of the character of invention.

13. That the first envelopes made by Cohn out of opaque paper, with transparent windows produced by an oily preparation, and with a border printed around the transparent windows, were made in the Spring or Summer of 1904, and subsequent to May 9, 1904, on which date Cohn filed his first application for a patent, as appears not only from the evidence but from the envelopes offered in evidence themselves, which all contain the words "Patent Pending," or "Pat. Applied For," which was possibly true *after* May 9, 1904, but was not true *before* that date.

14. That in January, 1904, one-piece transparent window envelopes were made from opaque paper by Julius Regenstein and others, at Chicago, Illinois, by rendering the window space transparent by the use of an oily preparation, and then printing a border around the space to give definition to the window and to cover and conceal the creeping or bleeding of the oil, which envelopes were full sized and complete reduction to practice of the inventions of the first Cohn patent, and corresponded in each and every respect with the envelopes claimed in the first Cohn patent.

15. That the claims of the second Cohn patent are limited to envelopes containing a transparent window or space which, considered by itself alone and irrespective of the border, is in outline characteristic of some symbol of trade, or article of manufacture, and with permanent advertising matter placed

or printed on the border outside of the transparent window or space.

16. That envelopes with transparent windows in the shape of a trade-mark, article of manufacture, or symbol of trade, are shown and described in the Boldt 1897 English patent, No. 29,956, which patent also says that the transparent windows may have a trade-mark, name or other symbol or device upon the transparent window itself.

17. That to take the envelope of the first Cohn patent, with its transparent window and with its border printed around the window, and make the window in the form or shape of a trade-mark, symbol or device, as described in the Boldt 1897 English patent, and place permanent advertising matter on its border, produces the envelope of the second Cohn patent, and was merely a mechanical act, and required merely the exercise of the knowledge and skill of the trade or calling of the printers' craft, and nothing of the character of invention.

18. That only mechanical knowledge and skill and nothing of the character of invention were required to take the envelope claimed in the first Cohn patent, with its transparent window and border, and change the *form* of the window so as to make it in outline characteristics of some symbol of trade, in view of the Boldt 1897 English patent, and of the practice, from time immemorial, of printing permanent advertising matter on the face of envelopes outside of the space reserved for the address.

19. That the transparent *window* in the defendant's envelope charged to infringe is not in the shape or form of an article of manufacture, and is not in outline characteristic of some symbol of trade, but is simply in size and shape the

regular transparent window of the stock envelope made by the manufacturer of the defendant's envelope.

20. That the defendant's envelope contains neither permanent advertising or printed matter on the border or face of the envelope, as required by the claims of the second Cohn patent sued on, but simply the word "Heinz" on the inside back of the envelope opposite the transparent window or space, so as to be seen therethrough, similar to the use of a word, symbol or device on the transparent window or space, as the Boldt 1897 English patent describes, and the usual return card in the upper left-hand corner—neither of which constitute the permanent advertising matter "appearing on said printed border and related to and in juxtaposition with the outline of said window," as called for in the first claim, nor the "permanent printed matter on the face of the envelope related to and in juxtaposition with the outline of the window and co-operating with said outline to indicate a particular brand of goods," as called for in the second claim.

21. That the defendant's envelope does not infringe the claims of the second Cohn patent sued on.

Assignment of Errors.

The errors assigned on behalf of the appellant at page 671 are, That the court erred—

1. In finding and holding that letters patent No. 835,850 were good and valid in law, and in sustaining the same.

2. In finding and holding that letters patent No. 824,908 were good and valid in law, and in sustaining the same.

3. In holding that the defendant's envelopes were an infringement of said letters patent or either of them, and in ordering an injunction against the defendant.

4. In holding that said letters patents No. 835,850 and No. 824,908 involved novelty and invention, notwithstanding the state of the art as established in the evidence.

5. In not holding that said letters patents No. 835,850 and No. 824,908 were invalid and of no force or effect whatever as lacking novelty and invention, in view of the state of the art as established in the evidence.

6. In not holding that the said letters patent, No. 835,850, were anticipated by the one-piece transparent window envelopes made by Julius Regenstein and others in January, 1904.

7. In holding that Cohn conceived of the invention described and claimed in said letters patent No. 835,850 prior to January, 1904, and before the making of the January, 1904, envelopes by Julius Regenstein and others.

8. In not finding and holding that said letters patent, No. 835,850, were invalid and void and of no force or effect whatever, in view of the common and universal practice in this country, among the printers of three-color pictures and the printers of lithograph labels, and the printers of general kinds of work, of printing a border around their pictures or work to give definition to the same, and to cover up and conceal ragged, imperfect, and unsightly edges resulting from the running of the ink or colors or from other causes.

9. In not finding and holding that said letters patent, No.

835,850, were invalid and void and of no force or effect whatever, in view of the existence in the prior art of one-piece transparent window envelopes without a border around the transparent window, and of the common practice and expedient of printers, of printing a border around pictures and of other kinds of work to cover up and conceal, ragged, imperfect, and unsightly edges, resulting from any cause whatsoever.

10. In not finding and holding that said letters patent, No. 835,850, were invalid and void and of no force or effect whatever, in view of the Busch 1896 English patent, No. 11,876, which had borders printed around the space left for the transparent window.

11. In not finding and holding that said letters patent, No. 835,850, were invalid and void and of no force or effect whatever, in view of the use of borders around desired transparent spaces, produced in opaque paper by an oily preparation, as shown in the various letters patent offered in evidence on behalf of the defendant.

12. In not finding and holding that said letters patent, No. 835,850, were invalid and of no force or effect whatever, on the ground that the printing of the border around the transparent window of the envelope, described and claimed in such patent, was a mere printers' mechanical expedient, that had been practiced for many years in various kinds of printers' work, to cover up and conceal ragged, imperfect and unsightly edges, resulting from any cause whatsoever.

13. In not finding and holding that the envelope described and claimed in said letters patent No. 835,850, was first conceived of by the said Max M. Cohn in the Spring or Summer of 1904, and after the Regenstein 1904 envelope had been manufactured.

14. In not finding and holding that the envelope described and claimed in said letters patent, No. 824,908, was limited and confined to envelopes containing a transparent window or space which, considered by itself alone and irrespective of the border, was in outline characteristic of some symbol of trade or article of manufacture.

15. In not finding and holding that said letters patent, No. 824,908, were invalid and void and of no force or effect whatever, in view of the Boldt 1897 English patent, No. 29,956, offered in evidence by the defendant.

16. In not finding and holding that the envelope described and claimed in said letters patent, No. 824,908, involved only mere mechanical knowledge and skill to make, in view of the fact that envelopes with transparent windows, in various forms, and with borders around the same, were shown and described in the Busch English patent, No. 11,876; the Boldt English patent, No. 29,956, and other patents offered in evidence by the defendant.

17. In not finding and holding that only mechanical knowledge and skill were required to take the envelope described and claimed in said letters patent, No. 835,850, with its transparent window and border, and changing the form of the window so as to make it in outline characteristic of some symbol of trade, in view of the Boldt 1897 English patent, and of the practice, from time immemorial, of printing permanent advertising matter on the face of the envelope outside of the space reserved for the address.

18. In finding and holding that the transparent window in the defendant's envelopes charged to infringe was in outline characteristic of some symbol of trade or article of manufacture, as described and claimed in said letters patent, No.

824,908, and in finding and holding that the defendant's envelopes were an infringement of the claims of said letters patent, No. 824,908.

.

As many of the facts specified in the contentions of the defendant, and many of the errors contained in the above enumeration, depend for their establishment upon considerations of testimony and principles of law applicable to several, we consider that it will conduce to clearness and brevity to consider them together, under appropriate headings, as far as applicable, and so we will proceed to consider them in connection with the patents to which they respectively relate.

The First Cohn Patent is Lacking in Invention in View of The State of the Art.

The learned judge below, in his opinion, beginning at page 32, discusses the defenses of *anticipation* and lack of *novelty*, but appears to have singularly failed to consider what we regard as one of the impregnable defenses in this case—the lack of *invention* in view of the state of the art. The Supreme Court has frequently held that the alleged invention of a patent may be *novel* in the sense of having never been made in the particular form shown or described in the patent, in which case, of course, it is not *anticipated* or precisely met, but that, if it lack *invention* over the state of the art, the patent cannot be sustained.

To refer to a case or two on this point—though there are many that could be cited:

In *Thompson v. Boisselier*, 114 U. S., 11, the Supreme Court said:

“It is not enough that a thing shall be new, in the

sense that in the shape or form in which it is produced it shall not have been before known, and that it shall be useful, but it must, under the Constitution and the Statute, amount to an *invention* or discovery."

The above language is quoted and the principle of law reiterated in *Gardner v. Herz*, 118 U. S., 191, where additional cases are cited; and after quoting the above language from the Thompson-Boisselier case, the Supreme Court, on page 192, said:

"A large number of cases in this court were there referred to, and one especially, where the thing claimed was new, in the sense that it had not been anticipated by any previous invention, and it was shown to have superior utility, yet it was held not to be such an improvement as was entitled to be regarded in the patent law as an invention."

It was not enough, therefore, for the learned judge below to find that the alleged inventions of the Cohn patents were novel and not anticipated, in the sense that the exact envelopes shown and described in the patents had not existed before, unless such envelopes contained *invention* over what existed in the prior art. The defense that we are now insisting upon, and which we think was practically overlooked by the court below, is that there was no *invention* in the envelopes of the Cohn patents, when what Cohn did, over what was known and existed before, is taken into consideration. To show this lack of *invention* we will take up and consider the state of the art as it was fully established in the proofs.

The State of the Art and in What it Consists.

The state of the art may be considered under six general divisions or propositions which may be briefly presented as follows:

First, one-piece window envelopes in every respect like the envelope of the Cohn patent, but without a border around the window, were old in the art.

Second, borders were old and had long been used by the printers of three color pictures, for the same purpose as they were applied and used by Cohn on his one-piece transparent window envelope—to cover up, conceal or obliterate irregular, ragged and unsightly edges on the work enclosed within the borders.

Third, borders were old and had long been used by the printers of lithograph picture labels, for the same purpose as they were applied and used by Cohn on his one-piece transparent window envelope—to cover up, conceal or obliterate irregular, ragged and unsightly edges on the work enclosed within the borders.

Fourth, borders were old and had long been used by printers generally around different kinds of work where the ink ran or spread, for the same purpose as they were applied and used by Cohn on his one-piece transparent window envelope—to cover up, conceal or obliterate irregular, ragged and unsightly edges on the work enclosed within the borders.

Fifth, borders were old and had been described as “printed” on one-piece transparent window envelopes around and outside of the space constituting the transpar-

ent window long before the date of the invention of the first Cohn patent.

Sixth, borders were old and described as printed around transparent spaces created in opaque paper by the application of a grease, varnish or oily preparation, where the transparent spaces were used for various purposes.

We will consider each of the foregoing phases of the state of the art and the evidence in support of the same, in the order enumerated above.

First Division of the Old Art.

The Brown 1862 patent, at page 695, describes one-piece window envelopes made from opaque paper, like those of the Cohn patent, and with the transparent portion produced in the opaque paper in the same way,—by the use of a material that makes the paper transparent where applied and only where applied—but without the border, were old in the prior art. They are fully disclosed in the Brown 1862 patent in evidence. After describing one part of the invention, the Brown specification says (*italics being ours*):

“The other part of my invention consists in an improved envelope, or wrapper, D. The improvement is, to make the envelope or wrapper, transparent, sufficiently to clearly show the cards of address through its face. There may be only a *transparent portion* B, large enough to exhibit the ‘direction’ through it; and this may be made either by *rendering a portion* of the envelope, or wrapper, itself, transparent, by the same means or substance as employed for making tracing paper or any other, in the process of manufacturing the paper or *the envelope*, leaving the remainder of the envelope *opaque*.”

The Brown patent says, “by rendering a portion of the envelope”—not the whole of it, but a *portion*—“trans-

parent, by the same means or substance as employed for making tracing paper or any other" transparent. What "means or substance" are used for making the tracing paper transparent? Oil or oily substances, as everybody knows. The tracing paper in children's picture tracing books used for forty years or more, as its very appearance shows, is rendered transparent by oils or oily preparations. The Century Dictionary, copyrighted in 1890, under the heading of oils, says: "Oiled paper, paper saturated with oil, either to render it transparent and thus fit for *tracing purposes*, or to make it waterproof." Brown speaks to those skilled in the art of making paper and making either the whole or a portion of it transparent and who knew that oily preparations were used in making "tracing" paper, and so he tells them that a *portion* of the envelope, "large enough to exhibit the 'direction' through it," was to be made transparent by using the appropriate "means or substances"—any suitable oily preparation.

The above quotation from the Brown patent clearly describes a one-piece transparent window envelope, made from opaque paper, with a desired transparent space or window in it, but without any border around the transparent portion. We offered in evidence an envelope that corresponds to the description of the Brown patent, and the same will be found in the defendant's typewritten record on file in the case, opposite page 372. The defendant's witness, Mr. Bond, at page 353, testifies that the envelope offered in evidence "embodies the invention of the Brown 1862 patent." The Primary Examiner, the Board of Examiners-in-Chief and the Commissioner of Patents, all considered and conceded that the Brown patent disclosed a one-piece transparent window envelope made from opaque paper like the Cohn envelope, but without the border. Indeed, the attorney for Cohn, in his argument filed with the Board of Examiners-in-Chief, con-

ceded this at page 613, and among other things said (the italics being ours):

“The patent to Brown 36,393 is only cited to show a window which is made transparent by some substance such as is employed for making tracing papers. This we admit is old in an envelope, but it is this very method of making the transparent window which calls into play the border of contrasting color which is applied over and conceals the ragged lines left by reason of the oily matter creeping into the opaque stock of the envelope.

“Although we disclose new and useful advantages for this border and *we have made the Brown type of envelope* a success, so much so that the improved envelope is now being extensively made and sold,” etc.

Here Cohn, through his attorneys, claimed that by the use of the border he had made “*the Brown type of envelope* a commercial success—not some *other* kind of envelope, but the *Brown* type—thus conceding that the *type* of envelope was old and that the Cohn envelope differed from it simply by the application of a border around the window.

The Board of Examiners-in-Chief, in their opinion, after referring to the Busch 1896 English patent, and the Cohn and Shipp 1904 English patent, said, at page 618, in speaking of the Brown patent (the italics being ours):

“It is obvious that by following the directions first stated, an envelope of the same construction as the appellants is produced. The appellant has merely *added a colored border* for the purpose of ornamentation.

“In the patent to Cohn *et al.* is described an unpunctured envelope having a transparent window surrounded by a portion to which dark colored ink has been applied. This is also true of Busch. The border in this case seems to extend to the edge of the envelope but it is nevertheless a contrasting border. Its purpose is, like that in the appellant’s case, to have a transparent window regular in outline and of the shape desired. If the transparent material extends to the edge of the envelope it is neces-

sary to extend the ink covered surface to the edge, whereas if the transparent portion does not extend so far it is not necessary to extend the ink so far. It may then be applied in the shape of a border sufficiently wide to cover the edges of the transparent portion."

Indeed, as already pointed out, Cohn says in both of his patents that the border may extend to the edges of the envelope, his words, in describing Fig. 2, being that, "The entire face of the envelope around the window is assumed to have been imprinted or colored to give definition to the window opening and obliterate signs of creep in the transparency-producing preparation"; and in the second patent that, "This coloring matter may be applied solid over the face of the envelope." The Board of Examiners-in-Chief then proceeded by saying:

"The purpose, function and idea of means seems to be the same in both cases. The rough edges of the transparent portion would be concealed just as well by coating all of the balance of the envelope with dark colored ink, and the only purpose of substituting a narrower border seems to be to get a different artistic effect. There is no mechanical advantage or utility in it. It is a mere matter of design. The claims are lacking in patentable novelty, in view of the references cited."

Furthermore, while the matter was pending before the Primary Examiner, and before it was appealed to the Board of Examiners-in-Chief from the proceedings in which the above quotations were made, Cohn, at page 599, among other things, said:

"We admit that it is a matter of common knowledge to make envelopes of transparent material. We also admit that it is a matter of common knowledge, broadly, to make an envelope [with] a generally opaque body having a transparent window or opening. It is also not new to render paper transparent by treating it with grease, and which proposition is included in the one second above

noted. We therefore agree with the Examiners' holding as to such matters."

In view of the above findings of the Office, and the concessions of Cohn in the proceedings for the obtaining of the first Cohn patent, we submit that it is pretty late in the day, to put it mildly, to claim that the Brown 1862 patent does not disclose a one-piece transparent window envelope or transparent portion formed by an oily preparation—in short, the exact envelope of the Cohn patent, with the exception of the border around the transparent window.

It should be understood, of course, that the Brown 1862 patent discloses *three* kinds of envelopes—one where an opening or aperture is cut out of the envelope to display the address on the enclosure, and without any transparent covering over the opening,—another where an opening or aperture is cut in the envelope and a separate transparent covering piece applied over the opening so as to allow the address on the enclosure to show through—and one where the space or window is made transparent out of the integral opaque paper, just as is done in making the envelope of the first Cohn patent. It is, of course, the last or *third* kind of envelope disclosed in the Brown patent that corresponds with the envelope of the first Cohn patent, with the exception of the border around the transparent space or window.

The complainant, Cohn, in his testimony, sought to distinguish his envelope from the Brown envelope, notwithstanding his concessions in the Patent Office that it was the same thing, with the exception of the border, and mentioned various grounds on which he sought to base such distinction, but a reading of his answer will show that he confused the various kinds of envelopes disclosed in the Brown patent, instead of confining himself to the particular kind or type that is

germane to the real question involved. Various of his grounds also were frivolous and inconsequential, when we keep our minds on the particular kind of envelope disclosed in the Brown patent that we rely upon as showing that everything was old in the Cohn envelope, in view of the Brown patent, with the exception of the border around the window.

In X-Q. 159, at page 186 of the Record, we asked him, and he testified as follows:

“X-Q. 159. Let us compare the defendant’s exhibit envelope illustrating the Brown 1862 patent offered at page 372 of the D. R. and the envelope described in the Brown patent, and see how far they contain matter in common. First, they are both envelopes; second, both envelopes are made from opaque stock; third, both envelopes have transparent spaces or windows in their fronts or faces; fourth, both envelopes have these transparent spaces formed by some means or substances that are adapted to render paper transparent where the same is applied; fifth, both envelopes have the transparent windows of a size and shape to permit the address on the enclosure for which they were made to show through the windows; sixth, both envelopes have the remainder of the face or front opaque; and, seventh, both envelopes are one piece, transparent window envelopes. Are not the various features mentioned above common to the defendant’s exhibit under consideration and to the envelope disclosed in the Brown 1862 patent?”

The above question was intended, by comparison, to show that the exhibit offered by the defendant to illustrate one of the kinds of envelopes disclosed in the Brown patent was a correct illustration of the same, and, as the defendant’s expert, Mr. Bond, had testified, “embodies the invention of the Brown 1862 patent.” As Cohn, in his answer, took up the various numbered features mentioned in the question, we will quote his answer point by point, with such comment after each point of his answer as may be pertinent to show the inconse-

quential character of some of the distinctions which he attempted to draw. In answering the question, Cohn said:

“No, for the following reasons. First, the envelope used for illustrating the Brown 1862 patent is an envelope, whereas Brown in his specification says, ‘Envelope or wrapper D.’ By referring to diagram D of the Brown drawings you cannot tell whether he had in mind an envelope or a wrapper, there being no distinction in any of the drawings.”

What is the difference between an envelope and a wrapper? An envelope is a wrapper—something to cover up an enclosure. The specification of the Brown patent, at page 695, after describing the address cards which constituted “one part of my invention,” to use the words of the Brown specification, proceeds by saying that “The other part of my invention consists in an improved envelope of wrapper D,” and the drawings show the envelope or wrapper marked with the letter D. The specification repeatedly speaks of the “envelope or wrapper,” and frequently uses the term “envelope” alone, without the synonym “wrapper” or other equivalent word; and both of the claims of the patent use the term “envelopes” alone. The drawings show the conventional illustration of envelopes, but whether Brown calls them envelopes or wrappers is a matter of no importance, and, consequently, the attempted distinction of Cohn, in the portion of his answer quoted, between envelopes and wrappers, amounts to nothing. Brown shows and describes an *envelope*, and its pertinence and character are in no way modified by using the synonymous words, “envelopes or wrappers,” to describe what he is talking about. Hence, the Brown patent describes and the envelope illustrating it shows, envelopes as inquired about in the question, and the answer should have admitted the fact. Cohn then proceeded:

“Second, the so-called Brown exhibit, opp. page 372

D. R., is made from opaque stock. Brown's may or may not be made from opaque stock. His specifications call for both and his drawings describe neither."

Cohn here says that the Brown envelope may or may not be made from opaque stock, and that his specifications call for both. If this be so, then clearly there is a disclosure of the one—the envelope made from opaque stock, as asked about in the question,—and Cohn should have plainly admitted the fact instead of saying, in effect, that while the Brown envelope was made from opaque stock the specification also described *other* kinds. Cohn then proceeded:

"Third, the so-called Brown exhibit has a transparent space or window in its face, while the Brown patent may have a space or hole, covered or uncovered by transparent material, the drawings and specifications in the Brown patent being silent as to the method of construction."

This part of Cohn's answer only mentions the first and second styles of envelopes described by Brown, and omits the statement in the Brown specification that "There may be only a transparent portion B, large enough to exhibit the 'direction' through it; and this may be made either by rendering a portion of the envelope, or wrapper, itself transparent." His answer in this respect, therefore, fails to respond to the third mentioned similarity between the Brown envelope and the defendant's exhibit illustrating it, which asked whether "both envelopes have transparent spaces or windows in their fronts or faces," and did not ask him about the first and second types of envelopes described by Brown, in which a hole or aperture may be cut and left unclosed, or cut and closed with transparent material. The specification of the Brown patent, however, shows what the fact is, and what the answer should have been. Cohn should have answered with an un-

qualified affirmative, according to the facts inquired about. Cohn then proceeded:

“Fourth, the so-called Brown exhibit has been rendered transparent by the use of an oily preparation. The Brown patent mentions no such method.”

The fourth particular mentioned in the question was as to whether “Both envelopes have these transparent spaces formed by some means or substances that are adapted to render paper transparent where the same is applied.” Nothing was said in the question about an oily preparation or what the constituents of the “means or substances” were, so long as they were “adapted to render paper transparent where the same is applied.” The Brown specification says that the transparent portion “may be made either by rendering a portion of the envelope, or wrapper, itself transparent, by the same means or substances as employed for making tracing paper or any other,” transparent. Brown was speaking to those familiar with paper and the “means or substances” by which the paper, or a *portion* of the paper, could be made transparent, without attempting to define what particular means or substances should be used. In like manner, the first Cohn patent defines no special means or substances, but simply says to apply to one side of the paper “a preparation which has the property of rendering transparent the portion to which it is applied,” leaving the constructor of the envelope at liberty to employ *any* known preparation he might desire, so long as it has “the property of rendering transparent” the portion of paper to which it is applied. Notwithstanding this similarity in the Brown and Cohn patents, of non-definition of the *particular* means or substances that should be employed, it is plain, we think, that the Brown patent covers *any* oily or greasy preparation, as such preparations, long before the application for the Cohn patent, were employed for making

“tracing paper,” as shown from our quotation from the Century Dictionary of the Edition of 1900, not to refer to the common knowledge, which everybody has possessed ever since paper has been made, that paper could be made transparent by the application of a greasy or oily preparation to it, or to any desired portion of it. Cohn then proceeded:

“Fifth, the Brown so-called exhibit has a transparent window of a size and shape to permit the address on the enclosure to show through, while the Brown patent only calls for a small, oval-shaped opening to permit a finely printed card to show through, according to the drawings shown.”

This portion of the answer draws a fictitious distinction, as well as incorrectly states the fact. The drawings of the Brown patent show a desired window for the address to be seen and read, and the specification says that there may be “a transparent portion B, *large enough* to exhibit the ‘direction’ through it.” The Brown patent left the *size* of the window to the constructor of his envelopes, and in that respect he did precisely as Cohn did in his first patent, where he specified no *form or size* for the transparent window, but simply said that he applied the transparency-producing preparation, so that “it may cover a larger or a lesser space, according to the *desired* size of the transparency or window.” The question merely asked him whether the envelope of the Brown patent and the defendant’s exhibit illustrating it did not both have the transparent windows “of a size and shape to permit the address on the enclosure for which they were made to show through the windows.” Cohn’s definition is frivolous and inconsequential. He should have answered the question by a direct affirmative. Cohn then proceeded:

“Sixth, the so-called Brown exhibit has the remainder of the face or front opaque, while the Brown patent may be either transparent or opaque, the specifications calling

for either construction, and it is impossible to tell from the drawings whether they were intended to be opaque or transparent."

The question asked Cohn whether the envelope of the Brown patent and the defendant's exhibit illustrating it did not both have the face or front of the envelope outside of the window opaque. He admits that the envelope of the Brown patent "may be either transparent or opaque," which, of course, includes the opaque form about which he was asked. The specification of the Brown patent, after saying that the envelope may have a portion made transparent, says, "leaving the remainder of the envelope opaque." He should have answered the question with a direct affirmative. Cohn then proceeded:

"Seventh, the so-called Brown exhibit is a one-piece transparent window envelope, while the envelope described in the Brown patent may be either a one or two-piece envelope; it being impossible to tell from the drawings whether the same is a one or two-piece envelope."

The question asked Cohn whether the envelope of the Brown patent and the defendant's exhibit illustrating it were not both "one-piece transparent window envelopes"; and in saying that the Brown envelope "may be *either* a one or two-piece envelope," Cohn necessarily assented to the conditions of the question. The specification of the Brown patent describes a one-piece transparent window envelope, as well as a two-piece envelope, and Cohn should have answered the question by a direct affirmative.

We have quoted the entire answer of Cohn to our question, and it will be apparent that the envelope of the Brown patent and the defendant's exhibit envelope illustrating it both contain every single one of the seven common points of construction specified in the question, so that we say that defendant's

expert, Mr. Bond, was exactly correct and right when he testified that the illustrative envelope “embodies the invention of the Brown 1862 patent.” We also insist that an analysis of Cohn’s answer to our cross-question 159 fully and exactly corroborates Mr. Bond, and that the exhibit envelope offered in evidence by the defendant to illustrate the envelope of the Brown 1862 patent fully and correctly does so.

We have dwelt on the construction of the pertinent Brown 1862 patented envelope,—the particular one of the *three* kinds that the patent discloses—so that there can be no question that the Brown patent does disclose a *one-piece transparent window envelope made from opaque stock*, with the transparent portion made by applying *some* oily material that would render the desired space or window transparent—exactly like the one-piece transparent window envelope of the first Cohn patent, with the exception of the border which Cohn printed around the window. We may have been tedious in our analysis and presentation of this contention, but we desired to establish beyond question that Cohn, in his *admissions* in the Patent Office in prosecuting his application, and the *officials* of the Patent Office in considering it, and the *witnesses* in discussing it, all were right in their understanding of the envelope disclosed in the Brown 1862 patent, because we take such envelope as a *starting point* in considering what Cohn did and what addition he made to the Brown envelope, in considering whether what he did involved the exercise of invention or amounted to anything more than the exercise of mechanical knowledge and skill.

Having shown, as above, that the envelope of the first Cohn patent was old *in every respect* except a border around the desired portion or space constituting the window, we will now take up and show that the use of borders around desired por-

tions or spaces of paper to give definition to the same and to cover up and conceal irregular, ragged or unsightly edges, just like the Cohn border, was an old and common practice in the various branches of the printers' art, and had been used for such purposes by printers of different work for many years before Cohn printed the borders on the envelope of his first patent. This involves a consideration of the second and following phases of the state of the art as detailed in our enumeration of what was old and well known, and so we proceed to consider them seriatim, as follows:

Second Division of the Old Art.

It appears from the evidence that it had been a common practice and expedient among three-color picture printers, and printers of lithograph labels, and printers generally, for many years, to print borders around the different kinds of work that they were doing, in order to give definition to the work and to cover up defects or imperfections in the edges of the work, caused by the overlapping of the colors or the running or spreading of the ink, wherever they desired to give the matter enclosed within a border a finished or ornamental appearance, just as Cohn printed the border on the envelope of his first patent, and for the same purpose.

Mr. Regenstein, who for many years had been assistant manager of the American Colortype Company, whose business was that of printing three-color pictures, on page 280, describes the method of printing such pictures, and from his testimony it appears that in three-color printing the paper is run through the press and one color printed on it. After the ink for this color has dried, the paper is again run through the press and printed with another color. After this second impression has dried, the paper is again run through the press and the third color printed. Owing to the imperfect or care-

less registration of the plates for printing the three colors, it often happens that the colors around the edges or margins of the pictures appear ragged and unsightly. To conceal this irregular and ragged appearance, and to give definition to the picture, a border was printed around so as to cover, conceal or obliterate the ragged and unsightly appearance presented at the edges. Examples of three-color pictures, both with borders and without borders, are shown in the Osborne 1900 art calendar in evidence, which fully serve to illustrate the use of borders with three-color pictures.

On page 280 we asked Mr. Regenstein and he testified as follows:

“Q. 91. Give us briefly a statement as to how three-color work is printed. I am only asking as to the printing end of the operation, and am not specially asking about the preparation of the plates to secure three-color effects.

“A. Three-color printing is done or printed from three half-tone plates or duplicates of such half-tone plates. The first impression is made from the plate with yellow ink; after the yellow impression is made, in some cases within four hours, and in other cases within twelve hours, the next plate is printed with red ink over the yellow; then the sheet is left unprinted for twelve hours and then finished up by printing the third plate with blue ink over the yellow and red.

“Q. 92. Then, as I understand you, the paper is passed three times through the press?

“A. That is correct.

“Q. 93. In case there is not a perfect registration in running the paper through the press for the different colors, or in case the plates vary in size, what condition is the margin or edge of the picture or whatever the three-color work represents, left in?

“A. In case the three plates are not absolutely of one size, or that the feeding of the printing press is done poorly, or in cases where the paper, on account of atmospheric conditions, changes its size, the colors used will overlap on the edges of the picture.

"Q. 94. You may state whether or not that overlapping or irregular registration of the colors at the edges is a matter of indifference or an objectionable thing.

"A. It is objectionable.

"Q. 95. What, if anything, was done in the three-color printing, where, owing to the causes you have mentioned, the edges or margins of the picture were left in an unsatisfactory or objectionable condition, to remove or cover up or conceal the irregularities of the picture?

"A. Where the customer is particular and is willing to pay the price in order to make it a first class job, a border is printed around such imperfect three-color picture, and, invariably, this border is made deliberately of such a size that part of the border will cover the spreading or bleeding of the three colors.

"Q. 96. How long has that, to your knowledge, been the practice in three-color printing?

"A. To my personal knowledge this has been done for the last twenty years, and I believe I can say that this idea of printing borders to cover up imperfections in printing was known to the old wood engravers two hundred years ago.

"Q. 97. Of what utility was this border that was printed on three-color pictures beyond covering up and concealing and giving a definite outline?

"A. The purpose is a useful and ornamental one.

"Q. 98. In what way did the border on color pictures serve the purpose that the border serves on these one-piece transparent window envelopes?

"A. For the same purpose stated before—useful and ornamental.

"Q. 99. In what way, in the case both of the three-color pictures and these one-piece transparent window envelopes, is the border useful and ornamental?

"A. In one case, the one-piece envelope, the oil is creeping, bleeding, and overlapping, and in the other case the colored inks are creeping, bleeding, and overlapping.

"Q. 100. In both cases, the objection to the creeping, bleeding, or overlapping, is removed by the use of the border, is it?

"A. In the case of the three-color work, the creeping, bleeding, and overlapping, is removed, but not in all cases,

as far as the one-piece transparent window is concerned.

"Q. 101. What difference is there in the purpose or object for which the border is used, in the three-colored pictures and in the one-piece transparent window envelopes?

"A. None whatsoever.

"Q. 102. In both cases, as I understand, it is to cover up and conceal what might otherwise be an unsightly or objectionable margin; is that correct?

"A. That is correct.

"Q. 103. Three-color work is done by printing presses and printing operations, is it?

"A. It is.

"Q. 104. Is that also true in applying the border or ring around the transparent portion of these envelopes?

"A. That is true.

"Q. 105. And in both cases the border is formed with some kind of an ink, is it?

"A. The border is printed with ink.

"Q. 106. If you have present here any samples of three-color work that will illustrate or show the use of the border, as you have described, please produce the same.

"A. I have.

"Q. 107. This book which you have handed me is entitled on the outside of the front cover: 'Osborne Art Calendars for 1900,' and on the first page I find at the top 'Annual Catalogue, 1900,' and at the bottom of the page I find 'Copyright, 1899, The Osborne Company, 253 Broadway, New York.' What do you know about the publication of this book or calendar?

"A. This book was published in 1899 by the Osborne Company, of New York."

"Q. 110. If you know, please tell us how long the Osborne Company has been publishing art calendars similar to the one we are discussing.

"A. I cannot state definitely, but I believe about fifteen years.

"Q. 111. Please point out some representative picture in this book or Art Calendar that will illustrate the use of a border for covering up and concealing imperfect or objectionable margins, and giving definite outline or definition to the picture; and also some picture that will il-

illustrate the objectionable margins of the pictures, which have been left exposed or uncovered by the non-application of a border to cover them.

"A. A specimen in which the plates overlap appears in the plate No. 4654 opposite page 16; and a plate on which the olive green tint border is printed over the margin appears on page 38, Continental Building & Loan Association Calendar.

"Q. 112. You have pointed out two illustrations in this Osborne Art Calendar for 1900, opposite page 16 and on page 38, to illustrate the running or overlapping of the colors at the edges or margins of the picture, and the covering and obliteration of such ragged or objectionable edges, by printing a border around and over the same. In selecting these two illustrations, have you meant that they were the only illustrations of such work in the book?

"A. In this book are a number of prints or subjects representing both kinds.

"Q. 113. I notice in this picture on page 38 that the olive green tint, if that is a correct description of it, appears darker in a narrow strip or border around the colored portion of the picture. Why is there this difference in appearance of the tints, if you know?

"A. This line in question is darker than the balance of the border on account of printing the tint over the three colors."

"Q. 119. How generally has it been the practice in three-color printing, to use borders printed around the margin of three-color pictures, to cover up or conceal irregularities or objectionable appearances in the edges, due to imperfect registration or other causes?

"A. It is the universal practice.

"Q. 120. And for how long a time has such been the practice, to your personal knowledge?

"A. To my personal knowledge, it is the practice, so far as three-color printing is concerned, for the last sixteen years, and, as far as color printing from plates, which are not three-color plates, is concerned, for the last twenty years.

"Q. 121. I notice in this book, on page 7, a cut numbered 4514, 'Tales of Chivalry'; another cut on page 20, numbered 2024, 'The Bride and the Fortune Teller'; and another cut on page 32, numbered 2603, 'A Florentine

Girl'; which appear to have a gilt or golden colored border. What is that color termed in the art?

"A. Gold border.

"Q. 122. Is it printed on?

"A. It is.

"Q. 123. What is the object of that printed gold border, such as I have called your attention to?

"A. It is done to beautify the job.

"Q. 124. In beautifying the job, what, if any, effect, does it have on the concealing or covering up of imperfections or objections in the border of the picture?

"A. The gold band or border around the colored print is made deliberately wider, in order to cover up the bleeding of the three-color work, and the ornamental feature of the design beautifies the job.

"Q. 125. I think you spoke yesterday of some cases where, through using a border too narrow, the imperfection in the edge or margin of the picture or other work, was not properly covered. I will ask you to look at this picture on page 23, 'The Florentine Girl,' and tell us whether it illustrates such careless or imperfect work.

"A. The subject, 'A Florentine Girl,' illustrates distinctly careless plate making. The mistake was made by the engravers, who made the oval gold plate.

"Q. 126. I call your attention to the picture on page 8 of this book, numbered 4504, 'A Connoisseur,' and the plates on page 12, numbered 4113, 'Knickerbocker Times,' and numbered 4154, 'An Old Road in Virginia—Sunset,' and the plate on page 36, numbered 6024, 'Under the Willows,' not to mention other plates or pictures, and ask you whether they afford illustrations of objectionable edges or margins in the pictures, due to the overlapping or running of the colors, where, to save expense or for other causes, no border was printed on.

"A. They do."

Gustaf Olson, who had worked some sixteen years for the American Colortype Company, on page 374, after describing his work as an engraver, was asked and testified:

"Q. 11. What, if anything, was done to give the margin or edges of the pictures a finished or ornamental appearance?

"A. We must necessarily engrave a plate that will constitute a line covering over any defects that are left in between edges or borders.

"Q. 12. Did you make such plates in your work as an engraver?

"A. Yes; often.

"Q. 13. How long have you made plates for printing a border or ring around and over the edges of colored pictures, to cover up defects, such as you have mentioned?

"A. Off and on for seventeen or eighteen years; as I was a wood engraver before working for this company.

"Q. 14. Look at this book which I now show you, which has been offered in evidence as 'Defendant's Exhibit Osborne Art Calendar for 1900,' and state how long you have known of Osborne Art Calendars showing pictures of the general character of those contained in this book shown you.

"A. Sixteen years back, I have seen work of this kind; and Osborne work about ten years.

"Q. 15. Please indicate some pictures in this Osborne Art Calendar shown you, which show or illustrate borders around the pictures, such as you say you have made, if you find any such pictures.

"A. I call your attention to the picture No. 4453, 'When the Frost is on the Pumpkin and the Fodder's in the Shock.' This picture shows a green border printed over and around the edges of the color reproduction. This leaves an unfinished effect, as will be noticed by a dark rim showing between the color illustration and border.

"Q. 16. What do you mean by saying, 'This leaves an unfinished effect'?

"A. It shows where color reproduction and tint join together in one edge unsuccessfully in this case; thereby leaving a dark green edge. This condition is overcome on page 20 in the same book in the plate No. 2024, 'The Bride and the Fortune Teller,' by printing a gold border, and thereby eliminating this dark green edge, which otherwise shows, by overlapping of colors. Also page 7, plate No. 4514, 'Tales of Chivalry.' This shows a printed colortype with gold border. This gold border is covering over edges, which would otherwise show in yellow, red or blue. There are also other illustrations in the book which demonstrate the same.

“Q. 17. What is the purpose or object of the ring or border around the pictures, such as you have called attention to and others in this book?

“A. Primarily, to cover defects; secondarily, to increase the beauty and value in some cases.

“Q. 18. I ask you to look at this book and point out two or three illustrations of pictures unprovided with borders, which illustrate the facts that you have reference to.

“A. Page 12, plate 4154, ‘An Old Road in Virginia—Sunset,’ shows a red and yellow discoloration on the bottom of the left-hand side of the picture. Plate 4654, ‘Among the Lillies,’ opposite page 16, the bottom right-hand side and top, show bad discolorations, due to the plates not being properly cut. Page 15, plate 4634, ‘A Venetian Girl,’ the right-hand side of the plate shows red and yellow extending below the blue, consequently giving a discoloration. The top and left-hand side also show ragged edges.

“Q. 19. How long do you say that you, yourself, have made plates for the printing of rings or borders around and over the edges or margins of the pictures, to cover up or conceal defects and to add a finished or ornamental appearance to the picture?

“A. About seventeen years.

“Q. 20. Did you ever make such plates for other kinds of pictures than color pictures?

“A. Yes.

“Q. 21. What kinds?

“A. Before I worked in color work, we often made what is called two-tone, as showing a green and orange, or red and blue, and when pictures would show bad edges, we were obliged to print borders around and over those edges.

“Q. 22. About how many years ago was that?

“A. About sixteen or seventeen years, and often in the intervals since then.

“Q. 23. What was the object or purpose of the borders around these green and orange, or red and blue pictures?

“A. They were to cover up defects.”

Emil A. LeGros, vice-president of the Franklin Company,

—an engraving and printing company—of Chicago, on page 406, was asked and testified:

“Q. 8. I show you a book that has been offered in evidence as ‘Osborne Art Calendar for 1900,’ and ask you to look at it and state, if you can, about how long you have been acquainted with the Osborne Art Calendars similar to the one shown you.

“A. I have been familiar with work of this character for about twelve years.”

In view of the foregoing, reinforced as it is by the Osborne Art Calendar in evidence, showing illustrations of three-color pictures, some of which are unprovided with borders, and in which irregular and ragged edges appear, and some of which are provided with borders covering up and concealing the ragged and irregular edges caused by imperfect registration of the plates, or the running of the colored inks, it must be considered as established and settled beyond question that it was old and common in the printing of three-color pictures to print a border around the picture to cover up, obliterate or conceal the ragged and unsightly edges resulting from different causes, and to give definition to the picture enclosed within the border, and that such had been the common practice of three-color printers for many years before the application for the first Cohn patent. Especially must this be considered as established and settled, in view of the fact that there is not a word of testimony in the record questioning or contradicting the correctness of the testimony of defendant's witnesses, or the authenticity of the Osborne Art Calendar for 1900, or of the existence and employment of the practice of printing borders around three-color work for the same purpose as Cohn printed the border around the transparent window of the envelope of his first patent.

The printing of borders around three-color pictures, for the same purpose as Cohn printed the border around the window or address space of the envelopes of his first patent, must, therefore, be considered as established and settled as a part of the prior art as it existed many years before the Cohn invention.

Third Division of the Old Art.

Furthermore, it was customary for many years prior to the invention of the first Cohn patent to print borders of bronze, gold, or other colored inks, around the colored lithographs used for making labels such as are applied to bottles, cans, and similar receptacles, in which perfumery, foods, and other articles, are contained, in order to define the work and cover up imperfections in the edges or margins and give them an ornamental and finished appearance. Illustrations of such lithograph printing were produced by the witness Sherwood, and were inserted at typewritten page 194 of the Defendant's Record as filed in the court below.

Alexander B. Sherwood, president of the Sherwood Lithograph Company, of Chicago, who had been in the business thirty odd years, at page 399 was asked and testified as follows:

“Q. 4. In doing lithographic printing, what is the custom or practice where the picture or design printed has defects or is objectionable in appearance around the edges or margins?

“A. I understand your question means the outer margin of the picture or design. It is always usual or customary to obliterate any of these ragged margins or inequalities, by covering with a suitable solid border to give or make a perfect printing edge for the whole design.

“Q. 5. How long has it been customary from your knowledge of the lithographic art to print a border around the outer edges or margins, as you have just explained?

“A. Ever since I have been identified with or have had knowledge of the business—thirty-four years.”

“Q. 11. How long, to your knowledge, has it been the custom or practice in the lithographic art, to make or apply the borders, as you have explained?”

“A. Always, for I know of no other method.

“Q. 12. What is the purpose or object of applying a border around a picture or design, as you have explained?”

“A. There are several; the first and primary object being that it covers up the inaccuracies of the register of colors where they are brought out to the edges of the design; second, it is often economical, rather than to take up the artist’s time or the transferrer’s time, or the plate maker’s time, in trying to do it by the other method, which would be one full of technical hard possibilities; third, it adds perhaps to the artistic appearance of the design. There are other minor reasons, perhaps, but these are the principal ones.

“Q. 13. I notice, on a part of this sheet, two designs with the words ‘Holman’s Perfume, Holman, Chicago,’ printed on them which do not have a border printed around them. Please look at these two particular designs, and state whether or not they illustrate the unfinished appearance around the outer edge or margin that you have mentioned.

“A. They do, sir, very well.”

There is not a word of testimony in the record questioning or disputing the testimony of Mr. Sherwood, as to the use of borders as described by him in the printing of lithographic pictures or labels, and therefore no foundation for questioning the absolute truth of his statements. He was a man of long experience in the art, and occupied a prominent position as the president of a large lithographing and printing company.

It must be taken as established and settled, therefore, that it was the old and common practice, in the printing of lithograph pictures or labels, existing for many years before the date of the Cohn invention, to print borders around such pictured labels to cover up and conceal or obliterate any ragged,

irregular, unsightly, or unfinished appearance, at the margins or edges of the work, the same as the border printed by Cohn around the edge or margin of the space or window of the envelope of the first Cohn patent. This was the state of the art as to this kind of printing for many years before Cohn entered the field.

Fourth Division of the Old Art.

Furthermore, it had been customary for many years before the Cohn invention for printers generally to print a border around different kinds of work where the ink would run or spread, in order to define the work and cover up and conceal imperfections and give the work a finished and desirable appearance. Illustrations of the kind of borders used by printers generally will be found in the deposition of Mr. Regenstein, at typewritten page 50 of the Defendant's Record, on file in the court below. The use of the ordinary printers' border now under consideration is shown by the depositions of many witnesses.

On page 291 of the Record, Mr. Regenstein was asked and testified as follows:

"Q. 127. Do you know what the practice has been in the printing art, distinct from the three-color art particularly, as to the use of means of any kind for covering up or concealing objectionable edges or margins, in the work being done?

"A. To my knowledge, the printing of borders and tints over overlapping or bleeding colors—this fact has been known to me for the last twenty years, and is common, so far as all color printing on printing presses is concerned, from printing plates; also color printing on lithographic presses, from stones, and other materials used.

"Q. 128. If you have made any samples to illustrate the printing of borders in the printing art, as referred to in your last answer, please produce them.

“A. The specimens which I hold in my hand were printed under my direction early this week.

“Q. 129. What do these two samples that you have produced illustrate or represent?

“A. These samples represent that, where an undersized paper is used, and the ink used is not sufficiently stiff, there is a likelihood that the edges of the print will appear unclean and ragged. In order to perfect the job, the printing of the border with stiff ink will do away with such imperfections.

“Q. 130. How long, to your knowledge, has it been the practice in the printing art to print borders to cover up imperfections in the edges of the work, as shown in these samples that you have produced?

“A. I have had such knowledge for the last twenty years.

“Q. 131. What kind of paper or quality of paper was the printing done on, in these samples that you have produced?

“A. The printing is done on an undersized paper, used by the Saturday Evening Post on its cover.

“Q. 132. If you made a batch of your one-piece transparent window envelopes without a border around the window what would a printer naturally do, in the exercise of his knowledge and skill in the printing art, to give a more finished or desirable appearance to the window, upon observing that the oil had run or crept into the paper around the margins or edges?

“A. A printer would print opaque ink over such imperfections. . . .

“Q. 133. In printing a border around the window, what if anything would he be doing different from or contrary to what he had been accustomed to do for the past twenty years, to your knowledge?

“A. Any printer would print a border of opaque ink—the thing he always does when he wants to cover imperfections.

“Q. 134. Is that a part of the knowledge and experience and expedients of the printers' art?

“A. It is.

“Q. 135. And has been, to your knowledge, for how many years?

“A. To my knowledge for twenty years.

"Q. 136. You yesterday identified some old one-piece transparent window envelopes as having been made as early as January, 1904, which showed a border printed around the transparent windows. Why did you not apply for a patent on that border, or the window of the envelope provided with it, if you did not?

A. I did not apply for a patent, because it seemed to me ridiculous to ask for a patent on a thing or operation which I and others had done and made for years, and I felt, if I should come to you and the Patent Office for such a patent, that you would give me the laugh.

"Q. 137. Did you see anything in what you had done in applying the border that you regarded as invention?

"A. I did not, since I had done the same thing which I was doing right along.

"Q. 138. When you saw that the oil ran or bled, into the paper, how long did it take you to know what to do to remove the difficulty?

"A. The time is so short that I cannot state the same, since it was simply a thought.

"Q. 139. Did you do anything more than apply the knowledge you had of the printing art, to the situation?

"A. I did not."

"Q. 142. How far, if at all, has your business for, say, the last twenty years, brought you in contact with printers and the printing art generally?

"A. For four years my business was the business of a photo-engraver making all kinds of printing plates. In addition to this business, I, in 1894, went into the business of making and printing three-color plates. Three gentlemen and myself started this art of three-color printing in this country in 1894. I supervised and criticized the work and was considered one of the foremost critics and experts on fine plate printing. Since 1905, I am actively engaged in the printing and manufacturing of envelopes, and late in 1903 and in 1904, in connection with my business as a color printer, I manufactured and experimented in the matter of Transo envelopes.

"Q. 143. Did these various businesses bring you in contact with printers and printers' art, so that you became acquainted with methods and practices of the same?

"A. They did.

"Q. 144. In the printing of your one-piece transparent

window envelopes, does the application of the border prevent the creeping or running of the oil, or simply cover up such creeping, as far as the border extends?

"A. The existence of the border does not prevent the creeping, and in many cases the oil will creep over or further than the border is indicated."

Gustaf Olson, an engraver by trade, on page 383, was asked and testified as follows:

"Q. 51. Prior to making the plates for the rings or borders for the envelope paper, as you have explained, had you seen work where the ink ran or spread at the borders?

"A. It does so in most every case where a solid plate is used. I have seen this as far back as I can remember being in business.

"Q. 52. In such cases as you have just mentioned, what was done, if anything, to cover up the running and spreading of the ink at the borders or edges?

"A. In the first place, the printer would thicken up his ink or use a different kind of ink to prevent this spreading or he would run something around the border or edge to hide this defect.

"Q. 53. Did you ever make any plates for the printing of a ring or border around the edges, to cover up the running or spreading of the ink as you have just mentioned?

A. Yes, just as often as the printer would decide that by printing a border he could eliminate the ragged appearance of the edges of the picture, I would have to make a plate for him.

"Q. 54. How long ago have you made plates for printing a border around work, where the ink ran or spread, so as to present ragged or unsightly edges or margins?

"A. About sixteen or seventeen years ago.

"Q. 55. How common a practice was it, to your knowledge, in the printers' art, to print rings or borders around different kinds of work, where the ink ran or spread, to cover up defects or unsightly appearances in the edges or margins of the work?

"A. It is so common that everybody in the printing establishment would be expected to know it.

"Q. 56. Was it a part of the common knowledge and practice of the printers' art?

"A. Yes."

Alexander B. Sherwood, president of the Sherwood Engraving Company, of Chicago, with thirty years' experience in the printers' art, on page 402, was asked and testified:

"Q. 14. Have you any knowledge or use of borders in the printing art generally, or distinct from the lithographic work?

"A. Yes, sir. The method in each kind of business is practically the same, and the result obtained, so far as that particular feature goes, is the same.

"Q. 15. How long have you known of the use of borders by printers, for either covering up unsightly edges or margins on the work being done, or for giving definition or sharpness of outline to the work included in the border, or for other purposes?

"A. It has always been the practical and common method of handling such work; to my knowledge for thirty-four years.

"Q. 16. If you had been printing a work or design or picture of any kind, for, say, the last thirty years, and you found that the ink or colors or whatever was used ran or spread, so as to create an objectionable or unsightly outer edge or margin, what, in the exercise of your knowledge of the lithographing and printing arts, would you have immediately done to cover up or obliterate such objectionable outer edges or margins of the work?

"A. The first thought that would occur to me, both from the economical and practical standpoints, would be to make a border which was sufficiently wide and solid to cover over and obliterate these unsightly edges, either by printing in a stronger color itself than the colors underlying, or by finishing with a bronze border, as on the sheet here before me.

"Q. 17. What would you say as to its requiring any invention on your part, or on the part of any other printer, to print a border in such a case?

"A. The question appears ridiculous to me, for the

proposition as you state it is so self-evident to any practical man that there could be no question about his being foolish enough, in view of that being the only way to get over the difficulty, and which is commonly and universally known.

"Q. 18. By 'foolish enough,' you mean simple enough?

"A. Yes, sir."

Emil A. LeGros, vice-president of the Franklin Company, —a large engraving and printing company—on page 404 was asked:

"Q. 2. How long have you been acquainted with the engraving business, and the printing business?

"A. About twenty-one years.

"Q. 3. In the engraving and printing business, what is the practice or custom, when a picture or piece of work of any kind shows defective, ragged, or unsightly edges or margins, to cover up or obliterate or conceal such unsightly or objectionable edges?

"A. It is customary to print a border of some kind around the picture.

"Q. 4. How long have you known of such custom or practice in the engraving or printing arts?

"A. As long as I have been in the business.

"Q. 5. From your knowledge and experience, what would a printer or engraver naturally have done if the work in hand showed a defective or unsightly appearance around the edges?

"A. Print a border around it.

"Q. 6. Has that been the case, to your knowledge, for, say, the last fifteen or twenty years?

"A. It has.

"Q. 7. What have you to say, from your knowledge and experience, as to whether or not the printing of a border around the work would have involved any invention?

"A. I shouldn't think it would be considered an invention, because it has been used in the regular course of business right along."

There is no testimony whatever in the record qualifying or

disputing the testimony of the witnesses as quoted above, so that it stands as established and settled by the evidence that it was a common custom and expedient on the part of printers generally, for many years before the date of the invention of the first Cohn patent, to print a border around various kinds of work to cover up, obliterate or conceal ragged, irregular, or unsightly edges caused by the spreading or running of the ink or whatever was used for the printing. Indeed, it would seem that no evidence, as to the custom of printers in this regard, was needed, as we have no doubt all seen such borders as long as we can remember. But, however, this may be, it is established by the evidence on the part of the defendant, and unquestioned and undisputed by any evidence on the part of the complainant.

Fifth Division of the Old Art.

Furthermore, borders were printed around the transparent windows of one-piece envelopes long prior to the date of the invention of the first Cohn patent. The Busch 1896 English patent, at page 716 of the Record, describes a one-piece window envelope with a border printed around the window or transparent portion or section. The specification of the Busch patent says (the italics being ours):

“This invention relates to postal envelopes which differ from others by the fact that a *portion* or the whole of the envelope is transparent, so that the address of the letter may be read through the envelope, and need not, therefore, be written or printed on the same. . . .

“In some cases the front of the envelope is made of transparent material, while the back is opaque, or *vice-versa*; or a *portion* of the front may be transparent, while the rest of the envelope is opaque, or the back and a *portion of the front* may be transparent.

“The desired contrast or difference may be produced either by choosing two different kinds of paper, or by

printing with opaque coloring matter applied to a portion of the envelope."

It appears from the above that the Busch specification plainly discloses, among other things, a one-piece window envelope, in which a *portion* of the front forming the window or space for the address to show through, is to be transparent, while the remaining portion of the front is to be rendered opaque by printing an opaque coloring matter on the paper, thus constituting a border. It appears that the border in the envelope of the Busch patent is to extend from the window or transparent portion to the edges of the envelope, thus covering the entire front of the envelope, except the transparent window or space. As we have already pointed out, the first Cohn patent in suit contemplates this precise arrangement of border. The specification, in describing the drawings, says that "Fig. 2 represents an envelope with a different shaped opening from that of Fig. 1, and in which the *entire face of the envelope around the window* is assumed to have been imprinted or colored to give definition to the window opening and obliterate signs of 'creep' in the transparency-producing preparation." And, again, in line 46 of the first column, after describing the application of the transparency-producing preparation, the specification says that, "The *remaining portion, or a part of the remaining portion, of the blank which forms the face of the finished envelope A* is then imprinted with a suitable opaque coloring matter."

We introduced three illustrative envelopes showing the invention described and disclosed in the Busch patent, and they were offered in evidence at page 400 of the Defendant's Typewritten Record filed in the court below. Mr. Bond, the defendant's expert, on page 576 of the Record, after describing the three illustrative envelopes, was asked and testified:

"Q. 5. How far do you consider that the three envel-

opes produced by you and discussed above are fair, real and actual embodiments and exemplifications of the envelopes shown and described in this English Busch 1896 patent?

“A. All three of the envelopes are fair, real and actual representations of envelopes which would be made by following the directions for making envelopes, found in this Busch patent.

“Q. 6. I notice in the second and third envelopes produced by you that the transparent portion or window of the envelope is somewhat oval in shape. Do you consider that in any way a departure from the description of the Busch patent?

“A. I do not. It is merely a matter of selecting the shape of the transparent portion, and there is nothing in the Busch patent limiting the shape of the transparent portion to any particular form.

“Q. 7. How far does the oval-shaped window in these two Busch envelopes correspond to the shape of the transparent windows of the Brown 1862 patent?

“A. They are substantially the same as the windows of the transparent portions of the envelopes of the Brown 1862 patent.”

The correctness of these illustrative envelopes, as embodying the inventions described in the Busch patent, is, we think, literally admitted by Cohn in his testimony, at page 188, where we asked him about one of the complainant's exhibits marked R, and where he testified as follows:

“X-Q. 161. The specification of the Busch British 1896 patent among other things says that, ‘A portion of the front may be transparent, while the rest of the envelope is opaque.’ This is true of the envelope Exhibit R, is it not?

“A. It is.

“X-Q. 162. This is also true of the envelope Defendant's Exhibit Busch 1896 Envelope No. 1, is it not?

“A. It is.

“X-Q. 163. It is also true of the Defendant's Exhibit Busch 1896 Envelope, No. 2, is it not?

“A. It is.

"X-Q. 164. The specification of the Busch patent says that, 'The back and a portion of the front may be transparent. This is true of the Defendant's Exhibit Busch 1896 Envelope No. 3, is it not?

"A. It is."

The correctness of the illustrative envelopes, as exemplifications of the envelopes disclosed and described in the Busch patent, being thus established by the testimony of both parties, they may be considered as physical embodiments of the envelopes of the Busch patent and treated accordingly.

The only difference between the envelope of the first Cohn patent and the envelope of the Busch 1896 English patent is, that Cohn makes only a part of his paper transparent, before applying a border around such part, while Busch made his entire blank transparent, or, what is the same thing, took transparent paper for his stock to begin with, and then printed his border over such portion as he did not desire to leave exposed or transparent. He then printed his border of coloring matter so as to give definition to the window, and cover or obscure the remainder of the face of the envelope by extending the border from the edges of the window to the edges of the envelope, as Cohn says *his* border may be extended. This forms precisely the kind of a border that Cohn contemplated and described as falling within the scope and limits of his invention.

The border that Busch printed on is printed or superposed on top of such portion of the envelope as he desired to cover up or obscure, and the Cohn border is printed or superposed on top of such portion of the envelope as *he* desired to cover up or obscure, and is, and necessarily must be, in order to serve its purpose, printed over the outer margin or edge of the transparent window itself, and so thereby covered up and

obscured the portion of the transparent space which he desired to conceal—the outer edge or portion that had the ragged appearance. Both Cohn and Busch, therefore, print or apply the coloring matter over the *transparent* paper—differing only as to the *amount* covered. Whether Busch himself applied the transparency-producing preparation, or some one else applied it before he began his work, is immaterial. Whether Cohn applies the transparency-producing preparation himself, or takes the paper to which it has already been applied, is likewise immaterial. Both use material that has the window or address space somehow or other made transparent, either during its manufacture or afterwards. Busch says that the desired contrast between the window and the balance of the envelope may be produced “by printing with opaque coloring matter applied to a portion of the envelope.” Note that the coloring matter—the border—is applied by “printing,” and that it is applied only to a “portion” of the envelope, just as in the Cohn envelope.

Sixth Division of the Old Art.

Furthermore borders were printed around transparent spaces made in opaque paper by the application of an oily preparation, for various purposes, long prior to the alleged invention of the first Cohn patent, as shown by a number of patents offered in evidence that were not referred to or considered in the prosecution of the Cohn application in the Patent Office. This will be apparent on reference to the patents themselves.

THE TUDOR 1878 PATENT, at page 698, relates to the making of imitation stained glass windows on paper, and consists in printing lines in heavy opaque ink on the paper selected, and then applying the transparency-producing preparation to the spaces or sections included within such heavy lines. These

heavy printed lines represent the "leading" which was used in stained glass windows between the pieces of glass. As a matter of fact, they form a *border* around each transparent section or portion of the paper and give it definition, and *necessarily* serve to cover up and conceal any spreading or bleeding of the oil used in making the sections transparent. In this way they perform the function and do the work of the borders in the Cohn envelope. The Tudor specification, among other things, says:

"The nature of my invention consists in paper having opaque lines printed, painted, or stained thereon, resembling the outlines of leaden sash doors usually employed in the construction of stained glass windows, and transparent coloring applied by printing, staining or painting the spaces between the opaque lines. This paper is easily transported and readily applied to window panes; and when oiled or coated and filled in the pores with resinous substances, as by varnishing it, it becomes in the colored portions more or less transparent, and presents the pleasing effect of stained glass of usual construction.

"Plain paper, such as lithographic or writing paper, may be used. Paper more transparent is preferable. The opaque lines and coloring may be applied on one or both sides of the paper."

The fact that the Tudor paper contains many transparent portions or sections is immaterial. There is a border around *each* transparent portion, and it is obvious that, when the transparent coloring is applied to render the spaces or figures transparent, particularly when such preparation is applied by *staining*, as the specification says may be the case, the transparency-producing material will flow into and permeate the fibres or tissues of the paper and present ragged and unfinished edges around the spaces, were it not for the opaque border lines printed around each of the spaces, which cannot but serve the purpose of covering up and concealing such ragged appearance and giving definition to the figure or space

enclosed within the lines. We thus have, in the Tudor patent, opaque paper with predetermined spaces rendered transparent by some oily preparation, and with heavy lines around each of the spaces. Any one of the spaces may be considered as corresponding to the transparent space or window in the paper of the Cohn envelope, and its border as corresponding to the border of the Cohn envelope.

In view of this Tudor patent, there was nothing new, therefore, in making paper transparent by the application of an oily preparation in the *desired* space or spaces, and printing *a heavy border around* such space or spaces, and which inherently and in the very nature of things *must* operate to cover up and conceal any ragged or unfinished appearance in the edges of the spaces caused by any flowing, spreading, or bleeding of the oily preparation through the fibres and tissues of the paper.

THE HOLE 1894 BRITISH PATENT is for a coin bag made up of paper or other material provided with holes or perforations, through which the coin may be seen, and with a heavy colored border printed on the paper outside of the holes, so as to distinguish and give definition to the same. The Hole specification, on page 706, after describing coin bags made of paper or other material, says:

“With bags so constructed it will be unnecessary to open them to ascertain the nature of their contents as this can be easily and quickly done by reason of the perforations, aided if necessary by black or other coloured lines on the exterior of the bags which would form a relief to the colour of the coins it contains.”

The drawing of the Hole patent appears at page 708, and a mere glance at it shows that it discloses the use of colored or tinted borders around a desired space to give definition to

the same. Of course, such borders would obliterate, cover up or conceal any imperfections, defects or undesirable appearances in the paper over which they were superposed, the same as the border does in the first Cohn patent.

THE LEIGH 1894 BRITISH PUBLICATION shows what may be termed a fashion display device for setting off the appearance of dress materials. It shows how a given dress material will look when made up and worn. The invention consists in a sheet of any desired material in which the outline of the human figure, either in whole or to the extent desired, is delineated in transparent material, while the surface or face of the sheet outside of the figure is covered by a black or other colored border. The nature of the invention will be readily understood by inspecting the drawings at page 713. The specification of the Leigh publication—for, at page 461, it was proved into the case as a publication rather than as a patent—at page 711 says:

“It has already been explained that my invention requires that portions *c* of the sheet, that is as much of the latter as is within the outline *a* shall be transparent. If celluloid is the material of the sheet, then the necessary transparency is already there. If, on the other hand, the material of the sheet is opaque normally such within portions *c* must be made transparent, or of transparent material, care being taken when the opaque portion and the transparent portions are of distinct materials, that they are evenly and well joined along the said outline *a*.”

The specification on the same page says:

“It—the material—must be naturally transparent or at any rate capable of being made transparent.”

It appears, therefore, from an examination of the Leigh publication that it was old to take a sheet of proper kind and make a desired *portion* transparent, and to print a border

around the transparent portion of black or other colored ink or material to give definition to the transparent space, and such colored border necessarily must have the effect of obliterating, covering up or concealing any defect or unsightly appearance in the sheet beneath the border. The specification, in speaking of the border, says that "Its function is to cover up the material of the cloth undergoing exhibition and inspection, for an area outside the said outline *a* sufficiently extensive in all directions to prevent the cloth outside the outline obtruding itself into the customer's field of view," that is, to cover up and conceal anything which it is desired shall not be seen.

THE SMITH & BROWN 1901 BRITISH PATENT describes a method of making transparent tablets, posters, labels, and similar devices for advertising purposes, and the specification, at page 722, describes the invention as consisting in the making of certain portions of the paper transparent by a suitable material and printing or otherwise applying inks or colors around the same which thus constitutes a border around the transparent portions.

"The printing or application of such black ink or colour, or inks and colours, is for the specific purpose of rendering opaque and dense certain and predetermined parts of the said advertisement or public notice when the said advertisement or public notice is placed before artificial light and also to enable us by means of spirit varnish to make transparent other certain and predetermined parts of the aforesaid advertisement, or public notice, which parts are exposed or left unprotected by the absence of the black ink, or colour or inks and colours, which are not printed or applied on the aforesaid certain and predetermined transparent parts of the reverse or negative surface of the aforesaid paper, to that surface on which the advertisement or public notice is printed and displayed.

"We apply spirit varnish of ordinary commercial manufacture to certain and predetermined parts on the

reverse or negative surface of paper to that surface on which is printed or displayed advertising matter, which certain and predetermined parts we purposely leave bare or unprotected by reason of not printing or applying black ink or colour or inks and colour on the said parts.

“The application of spirit varnish is for the specific purpose of rendering transparent only such parts of the advertising matter as we desire and intend to show and become brilliant when the said paper on which is printed or displayed advertising matter is placed before artificial light.”

The foregoing quotation shows that the Smith & Brown 1901 British patent discloses a sheet of paper with certain and predetermined parts made transparent by the application of varnish which, of course, is an oily preparation, and printing the surface of the paper outside of the spaces so rendered transparent with a black or other colored ink, thus forming a border around the transparent spaces, the printing of such border necessarily and inherently must have the effect of obliterating, covering up or concealing any running or bleeding of the varnish or oily preparation into the tissues of the fibres of the paper, the same as the border around the transparent window of the envelope of the first Cohn patent.

Neither the Tudor, Hole, Leigh, and Smith & Brown patents or publications was before the Examiners in the Patent Office, so far as the proceedings disclose. They show that it was old in various arts to take paper and render certain desired and predetermined parts of it transparent by the application of an oily preparation, thus forming transparent windows or spaces and printing or otherwise applying inks or coloring matter around the transparent windows, thus forming borders which application of inks necessarily had, and must have had, the effect of giving definition to the windows or spaces, and of covering up and

concealing or obliterating any running or bleeding of the oily preparation in the fibres or tissues of the paper. They fully meet the contention of Cohn's attorney in his argument before the Examiners-in-Chief, at page 611, where, in speaking of the Cohn invention, he says:

“The novelty of this invention is in providing a colored or tinted border surrounding a window portion which has been made transparent by some preparation which, because of its oily character, will creep into the surrounding opaque stock and give a ragged and unsightly outline to the transparent window, and I submit that neither of the references cited has any bearing upon such a feature, or offers any suggestion of the same.”

The above argument could not have been presented had the above references been discovered and cited by the Examiner, showing transparent portions, spaces, or windows in opaque paper produced by the application of oily preparations, which inherently and from their nature must have spread and bled and formed rough and ragged edges, with borders of ink or other colors printed around them, which necessarily operated to cover up or conceal the unsightly edges and give definition to the windows, and a finished and ornamental appearance to the work. They show that the very idea and feature, which counsel emphasized in his argument in the Patent Office, was fully disclosed in patents long prior in date to the Cohn application, so that the public was in full possession of every idea that Cohn relies on to support the claim of novelty, utility, and invention in the envelope of his first patent.

Recapitulation of the Various Uses of Borders.

To recapitulate the state of the art, we find that it is established and settled by the evidence that a one-piece transparent window envelope made from opaque paper like those described and claimed in the first Cohn patent, but without a border around the transparent windows, was described and disclosed to the world long prior to the date of the Cohn invention, as shown by the Brown 1862 patent; that it was old to print borders around three-color pictures, lithograph labels, and various kinds of printers' work generally, as shown in the Osborne 1900 art calendar, and testified to by a number of witnesses on the part of the defendant, whose testimony stands unquestioned and undisputed by a word of testimony on the part of the complainant; that it was old to print a border around a one-piece transparent window envelope made of transparent stock with the border covering the face of the envelope outside of the transparent window, as disclosed in the Busch 1896 patent; and that it was old to print borders around various transparent spaces made in opaque paper by the application of an oily preparation to the desired spaces and around holes or perforations in paper to give definition and distinctness to the same, as disclosed in the Tudor 1878 patent, the Hole 1894 British patent, the Leigh 1894 British publication, and the Smith & Browne 1901 British patent.

Contentions Based on the State of the Art.

In view of the fact, established and settled by the testimony of many witnesses on the part of the defendant, and not questioned or disputed by any testimony on the part of the complainant, that borders had, long prior to the invention of the first Cohn patent, been printed around the edges of three-color pictures, of lithograph colored labels, and of different

kinds of printers' work generally to cover up and conceal uneven, ragged or unsightly edges or margins, caused by the running and spreading of the colors or inks, or other causes, and that borders had been printed around the edges of various spaces in opaque paper rendered transparent by the application of an oily preparation for various purposes, which borders necessarily and inherently had the effect of obliterating, covering up or concealing any ragged, irregular and undesirable appearances in the edges of the transparent spaces caused by the running of the oily preparation, as well as to give definition and sharpness of outline to the matter included within the border, and a more ornamental and finished appearance to the work, we contend that no invention was involved in printing such a border on an envelope to cover up the spreading or running of the oil in making the transparent window in the envelope of the first Cohn patent, and to give definition to the enclosed space, and give it a more finished and ornamental appearance. The printing of borders on the envelopes of the first Cohn patent is an operation that falls within the printers' art. The work is done by printers. It is done on printing presses. An ink is used to print the borders. The whole operation is a part of the printers' art. The printing of the border to cover up or conceal the spreading or running of the ink or oil is precisely for the same purpose as the printing done to cover up or conceal the running or spreading of the inks or colors in the various instances of the use of borders established in the evidence. Not only are the uses analogous, but they are the same. A border that would cover up imperfections in the one case will cover up imperfections in the other. The method of applying the border in all these cases is the same and the function which the border performs is the same. The uses, objects, utilities, and advantages are the same.

The complainant Cohn on cross-examination admitted that the purposes, objects and advantages resulting from the printing of borders around pictures and other kinds of work, mentioned by the witnesses on the part of the defendant, were exactly the same as in the printing of the borders around the transparent windows of one-piece envelopes. We asked him a question framed—as to its last portion which we italicize—in the exact words of the witness Olson, in answering question 17, already quoted, as to the object of the border on his patented envelopes, and he stated that the same purposes and advantages existed in the printing of the border on envelopes that defendant's witnesses had assigned for the use of borders on pictures and other kinds of work. At page 183, we asked Cohn and he testified:

“X-Q. 156. In answering Q. 70, you say that you consider, the ring or border as of the utmost importance. The reasons for your opinion are because the presence of the border gives definition to the enclosed transparent space, covers up and conceals any objectionable or unsightly appearance caused by the irregular or ragged outlines resulting from the running or spreading of the transparency-producing preparation, and gives a more finished, or ornamental appearance to the job, or to express the matter more briefly, *the border is primarily to cover defects, and secondarily it enhances the beauty and value in some cases.* Is not this a brief summary of the objects, uses, and purposes of the border mentioned in the claim of the first patent sued on?

“A. It is.”

From the above, it is plain that all of the witnesses on both sides agree that the uses, objects and utilities of the border when surrounding a three-color picture, lithograph labels or printers' work generally, and when surrounding the transparent portion of a one-piece window envelope, are the same in every respect. At the most, therefore, and for the present

disregarding the prior patents, all that Cohn did was to print an old border around a desired piece or portion of a paper to cover up or conceal undesirable or unsightly appearances in its margin or outline, which, of course, would necessarily give definition or definiteness to the portion of the paper included within the border, just as others had been doing for years on many other kinds of work.

But for the present disregarding the use of borders on three-color pictures, lithograph labels, printers' art generally, and the borders shown in the Tudor, Hole, Leigh, and Smith & Browne patents, we think that, in view of the Brown 1862 and the Busch 1896 patents, alone, it is plain that no invention was involved on the part of Cohn. The Brown 1862 patent presented him with an envelope made of opaque material, with a portion or window made transparent. The Busch 1896 patent presented him with an envelope of transparent material, made from stock that was originally opaque, with a border printed around the transparent portion or window. They are both envelopes. The Brown envelope was without a border, and the Busch contained a border. All that Cohn did, and all that he could do, was to transfer the border from the one envelope to the other. It is precisely as though he had a Brown envelope in his hand and stood in the presence of a printer working at his press and printing borders on the Busch envelope. At the proper moment he inserts his Brown envelope into the press and prints the Busch border on it, without changing the press or ink, or method of operation. He now has the envelope of the first patent, without any change, subtraction or addition. It is plain, under the decisions of the courts in similar cases, that he has performed nothing but a mechanical act, and has not drawn upon nor employed the creative and originaive faculties, which are essential to an inventive act. He hardly exercised his rea-

soning faculties. What he did was an act of *imitation*. He printed the border around the window of the Brown 1862 envelope in the *same way* that he saw the printer doing in making the Busch 1896 envelopes. He simply followed the instructions and directions of the Brown and Busch specifications, with which the law conclusively assumes that he was fully acquainted.

The Brown and Busch patents may be regarded as letters directed to Cohn personally, as, indeed, they are open letters directed to everybody in the world interested in the making of envelopes; but we may regard them as letters directed from Brown and Busch to Cohn personally. The Brown letter instructs Cohn as to how to take a piece of opaque paper and make an envelope with a transparent window in it, and the Busch letters instructs him how he can make a border around the window. It tells him in express terms that he can make the border by printing with opaque coloring matter. He makes the envelope as Brown tells him and prints the border as Busch tells him. He has simply followed directions and instructions. As to these matters, we refer particularly to the deposition of the defendant's expert, Mr. Bond, extending from page 579 to page 582. In answering question 16 on page 580, Mr. Bond says that "The envelope of the first Cohn patent would result from taking the envelope of the Brown patent and printing thereon opaque matter as instructed by the Busch patent." In answering question 18 on page 582, he says that "No invention, in my opinion, was required to apply the instructions of the Busch patent as to making the face of the envelope outside of a transparent section opaque, and using such instructions in connection with the envelope of the Brown 1862 patent" We think it is plain that all Cohn did was to follow the instructions of the letter which Brown wrote to him in 1862 and the letter which Busch

wrote to him in 1896. They told him everything that he needed to do and how to do it. *The following of instructions* can never constitute invention. We think that the lack of invention is plain to demonstration.

The law is and for many years has been settled that the mere double use of a machine, device, idea, or invention, cannot be the subject of a patent. It is no invention to apply a well-known thing or idea to a new use. As Judge Story illustrated in an early case, there is no invention in taking a spoon that has been used for eating soup and use it in eating beans. As said by the Supreme Court in *Potts v. Creager*, 155 U. S., 606, it is no invention to take a mill for grinding coffee and use it for grinding spices. In like manner, whoever first employed a border for covering up and concealing ragged and unsightly edges in one kind of work made it free and open for use in all kinds of work where it would subserve the same purpose, so that it could never thereafter be the subject of a patent. The purpose for which Cohn says he uses the border, even if it be on different articles from those on which borders had been used before, would be insufficient to impart patentability to the envelope of the first Cohn patent.

In *Roberts v. Ryer*, 91 U. S., 157, the Supreme Court said:

“It is no new invention to use an old machine for a new purpose. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not.”

In *Pennsylvania v. Locomotive Truck Co.*, 110 U. S., 494, the Supreme Court, after reviewing the decisions, said:

“The application of an old process or machine to a similar or analogous subject, with no change in the

manner of application and no results substantially distinct in its nature, will not sustain a patent, even if the new form of result had not before been contemplated."

In *Blake v. San Francisco*, 113 U. S., 682, after quoting from the *Locomotive* case above, the Supreme Court, the italics being ours, said:

"It follows from this principle that where the public has acquired in any way the right to use a machine or device for a particular purpose, it has the right to use it for all the like purposes to which it can be applied, and no one can take out a patent to cover the application of the device to a similar purpose. . . . If the result claimed as new is the same in character as the original result, it will not be deemed a new result for this purpose. For instance, an automatic relief valve, used to relieve the pressure of *steam*, produces no new result in character when used to relieve the pressure of *water*, unless some further effect besides the mere relief of pressure is obtained. This qualification, therefore, will not affect the present case, because no new result in character is accomplished by the supposed invention of the plaintiff. Besides, it appears from the evidence that before Bailey's patent was applied for, relief valves were in common use, both on land and at sea. . . . It is no answer to this to assert that the application of a relief valve to a portable steam *fire-engine* is the invention of a new combination. There was no invention; the combination was already in public use on *steamships*. The application of the valve to a *similar* use on land was not a new combination or a new invention."

In *Lovell Manufacturing Co. v. Cary*, 147 U. S., 634, the Supreme Court, the italics being ours, said:

"The public cannot be deprived of an old process because some one has discovered that it is capable of producing a better result, or has a *wider range* of use than was before known. In *Smith v. Nichols*, 21 Wall., 112, it was held that a mere carrying forward, or new

or more extended application, of the original thought, a change only in form, proportions, or degree, the substitution of equivalents, doing substantially the same thing in the same way, by substantially the same means, with better results, was not such invention as would sustain a patent; and in *Roberts v. Ryer*, 91 U. S., 150, it was held that it was no new invention to use an old machine for a new purpose, and that the inventor of a machine was entitled to the benefit of all the uses to which it could be put, no matter whether he had conceived the idea of the use or not."

Not only was the use of a border on the envelope of the first Cohn patent, to define the window space and to cover up and conceal the spreading or creeping of the oil, merely a *double use* of the border in the same way and for the same purpose that it had been employed by three-color printers, lithograph-printers, and in the printing art generally, but it was a matter that naturally fell *within the line* of knowledge and work that a printer is habitually doing. The moment the necessity or desirability of a border appeared to a printer, he would, from his knowledge and experience, know exactly the remedy to apply. But it is not invention to exercise the skill and knowledge that pertains to one's trade, business, or profession. That is something that is to be expected and is entirely different from the origination of new ideas involved in the inventive act. In reference to the exercise of the knowledge and skill of one's trade or calling, the Supreme and Circuit Courts have repeatedly expressed themselves.

In *Pearce v. Mulford*, 102 U. S., 112, 118, the Supreme Court said:

"All improvement is not invention, and entitled to protection as such. Thus to entitle it, it must be the product of some exercise of the inventive faculties, and it must involve something more than what is obvious to persons skilled in the art to which it relates."

In *Vinton v. Hamilton*, 104 U. S., 492, the Supreme Court, the italics being ours, said:

"Neither a *cupola* nor a cinder notch is new. The use of a cinder notch for drawing off cinders from a *blast* furnace is as old as blast furnaces themselves. The function which the cinder notch performs in the process covered by Vinton's invention is precisely the same for which it is used in a blast furnace. In smelting slag in a *cupola* furnace it was found that the molten cinder accumulated and floated on the top of the molten iron. The application to a *cupola* furnace, for the purpose of drawing off cinder, of the cinder notch in the *blast* furnaces to accomplish the same end, would occur to any practical man. When applied to a *cupola* furnace the same function was performed in the same way by the same means. In making this application there was no invention. *Pearce v. Mulford*, 102 U. S., 112. We are of opinion, therefore, that the application of a cinder notch to a *cupola* furnace for the purpose designated is neither patentable nor new, and that all the other parts of the process and the appliances covered by Vinton's patent were old and well known long before the date of his alleged invention and the patent therefor."

In *Atlantic Works v. Brady*, 107 U. S., 200, the Supreme Court said:

"The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privilege tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the

country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to law suits and vexatious accountings for profits made in good faith."

In *Hollister v. Benedict Mfg. Co.*, 113 U. S., 59, 73, the Supreme Court, the italics being ours, said:

"As soon as the mischief became apparent, and the remedy was seriously and systematically studied by those competent to deal with the subject, the present regulation was promptly suggested and adopted, just as a skilled mechanic, witnessing the performance of a machine, inadequate, by reason of some defect, to accomplish the object for which it had been designed, by the application of his common knowledge and experience, perceives the reason of the failure, and supplies what is obviously wanting. It is but the display of the *expected skill of the calling*, and involves only the exercise of the ordinary faculties of *reasoning* upon the materials supplied by a special knowledge, and the facility of manipulation which results from its habitual and intelligent practice, and is in no sense the *creative* work of that inventive faculty which it is the purpose of the constitution and the patent laws to encourage and reward."

In *Thompson v. Boisselier*, 114 U. S., 1, 11, the Supreme Court, the italics being ours, said:

"It is not enough that a thing shall be new, in the sense that in the shape or form in which it is produced it shall not have been before known, and that it shall be useful, but it must, under the constitution and the statute, amount to an invention or discovery."

"To refer only to some more recent cases, adjudged since these suits were decided below, this principle was applied in *Vinton v. Hamilton*, 104 U. S., 485, where a cupola-furnace being old, and a cinder-notch being old, and the use of a cinder-notch to draw off cinders from a blast-furnace being old, and the cinder-notch, in drawing off the cinders from the cupola-furnace, performs

the same function as in the blast-furnace, it was held that the application of the cinder-notch to the cupola-furnace would occur to any practical man, and that there was nothing patentable in such application.

“In *Hall v. Macneale*, 107 U. S., 90, a cored conical bolt, in a safe, with a screw-thread on it, having existed before, and also a solid conical bolt, it was held to be no invention to add the screw-thread to the solid conical bolt.

“In *Atlantic Works v. Brady*, 107 U. S., 192, 200, it was said, that it is not the object of the patent laws to grant a monopoly for every trifling device which would naturally and spontaneously occur to any skilled mechanic or operator, in the ordinary progress of manufactures.”

In *Thatcher Heating Co. v. Burtis*, 121 U. S., 286, 294, the Supreme Court said:

“It is admitted that what Thatcher did, and all that he did, was to transfer this well known fuel magazine from its use in an out-standing base-burning stove to a fire-place heater, equally well known and in common use as to its arrangement, construction, position and mode of operation. When this fuel magazine was thus *transferred from one kind of stove to another*, in its new situation it performed precisely the same function with respect to the fuel and the fire, as it had always been accustomed to perform in its old place, and the fire-place heater into which it was thus newly placed, so far as the generation and transmission of heat and heated air are concerned, operated precisely as it had habitually done before.”

In *Root v. Sontag*, 47 Fed., 311, Judge Hawley, of California, said:

“From this reference to the drawings, specifications, and claims in the patent it appears that on the end of the shuttle body a flat plate was formerly attached by means of a screw or bolt, driven or screwed into the end of the shuttle body; that the constant movement of the shuttle was liable to cause the wood to split, and the plates to become loose. The improvement in this respect

is made by extending the screw through the end of the shuttle, and placing a nut on the end of the bolt of the screw. It must be admitted that this is an improvement upon the former methods in common use, in this; that it holds the plate or tip more securely to the end of the shuttle, and prevents the wood from splitting as frequently as it otherwise would. But does this improvement involve any mechanical skill? Can the improvement, as made, be called invention? The use of a bolt with a nut screwed on the end of it for the purpose of holding or fastening things together is not only well known to mechanics, but is a matter within the general knowledge of the public. When from any cause, it was discovered that the tip on the end of the shuttles would frequently become loose, or the wood split, what would be more natural than to suggest the driving of the bolt through the end of the shuttle, and placing a nut on the end of the bolt, and screw it up tightly? The shuttle, as thus constructed, performs no new function. It operates precisely as it did before the improvement was made. The improvement is superior to the old methods in the mechanical structure of the shuttles, but is not, in my opinion, of such a character as required inventive skill."

In *Haughey v. Lee*, 48 Fed., 384, Judge Butler, of Pennsylvania, said:

"In view of the other devices shown—about whose existence there is no question—it seems clear that the slight change in form which the plaintiff made did not require invention. He simply altered the 'striker' from a horizontal to a perpendicular position. He found it standing out laterally, and loosened it so as to hang. This was all. Surely no invention was required to do it. Any mechanic to whose line the work belonged, or indeed any handy person, though not a mechanic, could do this. The idea or conception that this change might be beneficial, was not patentable. The question is simply, was invention required to make the change? In my judgment it was not. The kicking device exhibited a method of doing it. This device indeed required nothing but shortening the chain to make it correspond in every essential respect with the plaintiff's. Applying this to a horse in

motion, instead of one standing in his stall is not even a new use. If new it would be analogous to the old. Patents are constantly overturned for want of invention, where its absence is not so clear. The later volumes of reports are full of such cases; eight are contained in the last issue—132 U. S. It is sufficient to cite a few of them. *Hollister v. Manufacturing Co.*, 113 U. S., 59, 5 Sup. Ct. Rep., 717; *Thompson v. Boisselier*, 114 U. S. 1, 5 Sup. Ct. Rep. 1042; *Pennsylvania R. Co. v. Locomotive Engine Safety Truck Co.*, 110 U. S. 490, 4 Sup. Ct. Rep. 220; *Bussey v. Manufacturing Co.*, 110 U. S. 131, 4 Sup. Ct. Rep. 38; *Gardner v. Herz*, 118 U. S. 180, 6 Sup. Ct. Rep. 1027; *Weir v. Morden*, 125 U. S. 98, 8 Sup. Ct. Rep. 869; *Holland v. Shipley*, 127 U. S. 396, 8 Sup. Ct. Rep. 1089; *Aron v. Railway Co.*, 132 U. S. 84, 10 Sup. Ct. Rep. 24; *Day v. Railway Co.*, 132 U. S. 98, 10 Sup. Ct. Rep. 11; *Roemer v. Bernheim Co.*, 132 U. S. 161, 10 Sup. Ct. Rep. 45."

In *Kilbourne v. Bingham Co.*, 50 Fed., 699, Judges Jackson and Swan, in the Circuit Court of Appeals for the Sixth Circuit, said:

"The appreciation and utilization of the efficiency of old methods, means, and material for the manufacture of domestic, mechanical, and agricultural wares 'does not spring from that intuitive faculty of the mind put forth in the search for new results or new methods creating what had not before existed or bringing to light what lay hidden from vision; but, on the other hand, is the suggestion of that common experience which arose spontaneously, and by a necessity of human reasoning, in the minds of those who had become acquainted with the circumstances with which they had to deal.' *Hollister v. Manufacturing Co.*, 113 U. S. 72, 5 Sup. Ct. Rep. 717.

"It is not enough that the new manufacture, because of the fitness of the material to the purposes of the article, has obviated innumerable objections inherent in prior manufactures and superseded them in the trade. It must possess an advantage and novelty in form or construction beyond the ability of a mechanic of ordinary skill and intelligence, or be the resultant of means or methods devised by the maker. 'The law,' says Judge

Woodruff in *Smith v. Ellicott*, 9 Blatchf. 403, 'gives no monopoly to industry, to wise judgment or to mere mechanical skill in the use of known means, nor to the product of either, if it be not new. These are within the proper field of competition, and open to all. In general, they will in that competition be justly appreciated, and will command their proper remuneration if usefully employed. It is invention of what is new, and not comparative superiority or greater excellence in what was before known, which the law protects, and it is that alone which is secured by patent'."

We have quoted from the above cases simply as samples of the innumerable decisions that fill the reports where the courts have invalidated patents on the ground that they were lacking in the quality or ingredient of invention. To be valid, a patent must be for a device, process, method, or idea, containing three essential and indispensable characteristics; it must be new; it must be useful; and it must involve *invention*, which latter characteristic the Supreme Court, in the *Hollister-Benedict* case, says is the "creative work" of the inventive or originating faculties. The envelope of the first Cohn patent is certainly lacking in the third characteristic or ingredient essential to make it a patentable subject, to say nothing of the others.

When Cohn made the envelope of his first patent, he had, in legal contemplation, a complete and detailed knowledge of everything which had been done by others bearing on the subject. Whether he had actual knowledge or not, we need not stop to inquire, as the fact of actual knowledge is wholly immaterial. The law conclusively and indisputably presumes that he had knowledge, and charges him with the consequences of such knowledge. Not only this, but he is to be considered and judged precisely *as if he had been present in person* when all of the prior pertinent works were being done, had stood by and observed how they were done, and had the re-

sults of their work in his presence and spread out for his visual inspection. We will quote from two or three cases as to this legal presumption.

In *Crompton v. Knowles*, 7 Fed., 203, Judge Lowell, of Massachusetts, in 1881, said:

“It is a presumption of law that all mechanics interested in upholding or defeating a patent were fully acquainted with the state of their art when they took out their patent, or when they built their machine. This presumption is founded upon a policy like that which imputes to all persons charged with crime a knowledge of the law. It is necessary to the safe administration of justice. Each party may then be assumed to have borrowed from the other whatever was actually first invented and used by that other.”

In *Allen v. Steele*, 64 Fed., 796, Judge Buffington, of Pennsylvania, after quoting from Judge Lowell, as above, said:

“We are of decided opinion that the substance of Allen’s device was so anticipated in Shippen’s that to devise and construct the former, with the latter before one’s eyes—which, in contemplation of law, we must assume Mr. Allen had—was the work of an adaptive mechanic, and not the province of an inventor. All the improvements claimed were, as compared with Shippen’s device, within the category of degree.”

In *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S., 493, the Supreme Court said:

“Having all these various devices before him, and whatever the facts may have been, he is chargeable with a knowledge of all pre-existing devices, did it involve an exercise of the inventive faculty to employ this same combination in a wind-mill for the purpose of converting a rotary into a reciprocating motion. . . . In determining the question of invention, we must presume the patentee was fully informed of everything which preceded him, whether such were the actual facts or not.”

To similar purport are *Loom Co. v. Higgins*, 105 U. S., 585; *Bates Refrigerator Co. v. Gillett*, 31 Fed., 816; *National Car Brake Shoe Co. v. Terre Haute Car Co.*, 19 Fed., 520; *Boyden v. Burke*, 14 How., 582, and other cases.

In view of the settled principle of law that one who claims to have made an invention is to be considered and judged as having an actual knowledge of everything which preceded him, including the methods and processes employed in their making, and in making his own invention as working in the actual physical presence of the accumulated devices of the preceding art, and of everything having a bearing on the nature, quality, and character of his act, we must consider Cohn in getting up the envelope of his first patent as being fully acquainted with and familiar with the use of borders by three-color picture printers, lithograph label printers, and printers generally, and the use of borders on one-piece transparent window envelopes, as described in the Busch 1896 British patent, and as having seen them applied, and as having them present before his physical eye. We are thus able to analyze and weigh his act. He puts on an oily preparation to make a portion of his paper or blank transparent. He observes the oily preparation penetrate into and permeate the tissue and fibre of his paper. He sees that the oil spreads or creeps beyond the boundaries of the predetermined space, so as to present a ragged or unsightly or undesirable edge or margin. He looks at the three-color pictures, where one of the colors for some reason overlaps or spreads beyond the others. He sees that to cover up or remedy the unsightly or undesirable edge or margin a border has been printed around and over the edge, and that it thus gives definition to the picture and covers up and conceals the unfinished or undesirable appearance of the edges. He looks at the lithograph labels and he sees that a bor-

der has been printed around and over their margins or edges, and that it thus gives sharpness of outline or definition to the matter contained within the border, and obliterates or covers up any ragged or unsightly appearance in the edges, caused by the spreading or misplacement of the ink. He looks at the examples of printers' work, where a border has been printed around any desired work or matter, and that it thus gives sharpness or definition or outline to the matter contained within and covers up and conceals any spreading or running of the ink. He looks at the envelope described in the Busch 1896 patent, and sees that he prints a border over its face outside of and around the window space, and that it thus covers the non-address space of the envelope and gives definition to the window space. And in legal contemplation he *sees* all these men *at their work* understands *what* they are doing, *how* they do it, and *why* they do it. He sees, as a matter of necessary reasoning—for such must have been the largest extent of the mental operation—that a similar border printed around the transparent portion or window of his envelope blank will serve his purpose, will give definition to the window, will cover up and conceal any bleeding or running of the oil, and will in short, exactly serve his purpose and do the work and give the finished results that he sees are desirable. He therefore, prints a border around the window of *his* envelope. He has originated nothing. He has added nothing to the knowledge of the world. He has contributed nothing to the printing art. No new or original idea has been evolved. He has simply *appropriated* and applied the *old expedient* used for a generation for precisely the same or similar purposes, with no change in the *manner* of application of the border, and no *results* substantially *different* from what had been secured by the use of borders before. We can well say of his act what the Supreme Court said

in the case of *Lovell Mfg. Co. v. Cary*, 147 U. S., 636, where, in discussing the case before them, they said:

“The present case is covered by the cases of *Vinton v. Hamilton*, 104 U. S. 485; *Stow v. Chicago*, 104 U. S. 547; *Locomotive Truck* case, 110 U. S. 490; *Blake v. San Francisco*, 113 U. S. 679; *Thompson v. Boisselier*, 114 U. S. 1; *Miller v. Foree*, 116 U. S. 22; *Dreyfus v. Searle*, 124 U. S. 60; *Brown v. District of Columbia*, 130 U. S. 87; *Aron v. Manhattan Railway*, 132 U. S. 84; *Watson v. Cincinnati, Indianapolis &c. Railway*, 132 U. S. 161; *Marchand v. Emken*, 132 U. S. 195; *Royer v. Roth*, 132 U. S. 201; *Hill v. Wooster*, 132 U. S. 693, 701; *Burt v. Ivory*, 133 U. S. 349; *Howe Machine Co. v. National Needle Co.*, 134 U. S. 388; *Florsheim v. Schilling*, 137 U. S. 64; *Consolidated Roller Mill Co. v. Walker*, 138 U. S. 124; *Ansonia Co. v. Electrical Supply Co.*, 144 U. S. 11; *Ryan v. Hard*, 145 U. S. 241. The principle deducible from those cases is that it is *not a patentable invention to apply old and well known devices and processes to new uses*, in other and analogous arts. The decision in *Ansonia Co. v. Electrical Supply Co.*, *supra*, is very pertinent. In the opinion in that case, the cases were reviewed which established that the application of an old *process* or machine to a similar or analogous subject, with no change in the *manner* of application, and no results substantially *distinct* in its nature, will not sustain a patent, even if the new form of result had not before been contemplated.”

To apply the principle of the above decision to the case in hand, it involved no invention for Cohn to take the border used on three-color pictures, on lithograph labels, on the Busch 1896 envelope, and in the printing art generally, and apply it to his envelopes where it performed the same work—surrounded a desired section or portion of work—secured the same results—gave definition to the work included within the border, and covered up and concealed imperfections around the outer edges or margins—in the same way—by the printing and superposition of an opaque coloring matter over the portion desired to be concealed. Par-

ticularly is this so when Cohn neither originated, created, nor made use of any new idea, but simply bodily *appropriated* an idea and a process that had been used for many years in similar analogous cases. The instant the need became apparent the remedy used for similar cases suggested itself. The combination that resulted was the old combination, so far as the essentials are concerned. Both in Cohn and in the old art, paper furnished the foundation for the work; both in Cohn and in the old art, a predetermined section or portion of the paper had a preparation applied to it, as ink or colors that ran or spread; both in Cohn and in the old three-color and printers' art, the edges or margins of the predetermined portion were ragged, unsightly, or undesirable in appearance, owing to the spreading or overlapping of the material at the edges or margins of the predetermined space; both in Cohn and in the old art, including the old 1896 Busch patented envelope, opaque coloring matter was printed around the predetermined space to give definition to it and, in most of the cases, to cover up and conceal imperfections or defects in the edges or margins, which produced an unsightly or undesirable appearance; and both in Cohn and in the old art, the resulting effect was to give a more finished or ornamental appearance to the work, without adding anything to its essential utility—the performance of its *function* as an envelope, in Cohn's case. We think it is preposterous to impute any inventive quality or character to the work done by Cohn in printing a border around the window of the envelope of his first patent.

The Question of Invention as Viewed by the Patent Office.

We find, by reference to the proceedings in the Patent Office in the procuring of the first Cohn patent, that there was great difficulty in securing its allowance, on the ground that it was lacking in invention. When the application was filed, November 8, 1904, it contained nine (9) claims, quoted at page

590. The first three claims related to the subject-matter of the present claim as it appears in the patent. The first claim, as originally presented, made no reference to the border, but the second and third claims included it as an element. The second claim, as originally presented, may be quoted as an example:

“2nd. An unpunctured envelope of non-transparent stock, to a portion of which a preparation has been applied to render such portion transparent, and a colored or tinted border surrounding said transparent portion.”

When the claims came to be examined, the Examiner rejected the above claim, together with the first and third, as being substantially anticipated in the Busch British patent of 1896. In the letter written by the Examiner December 22, 1904, at page 593, he said:

“Claims 1, 2 and 3 are rejected as being substantially anticipated in British Patent to Busch 11,876, July 4, 1896, in view of the immemorially old practice of country boys in making paper lanterns of greasing the whole or a part of the paper to render the lantern more translucent. The coloring of the ‘border’ may be regarded as of no patentable significance in the claims in view of either of the British patents to Whitty 2,899, Oct. 6, 1869, and Colby, 1,895, January 31, 1900.”

In reply to this action by the Office, Cohn amended his case January 6, 1905, page 596, by striking out the original claims and inserting two new claims, of which the second was worded as it now appears in the patent. At the same time a sample envelope was filed, and the statement made that “In Figs. 2 and 4 it is assumed that the entire face of the envelope is colored around the window opening; while in Figs. 1 and 3 there is only a border corresponding to the sample inclosed.” This corresponds to the statement in the patent, to which we have already called attention, to the effect that the border is

not to be understood as *merely* a narrow ring around the window but may cover a border that extends *entirely* over the face of the envelope from the edges of the window to the edges of the envelope—the *kind* of a border that Busch described.

In reply to the amendment made as above, the Examiner, February 13, 1905, at page 598, again rejected the claims as lacking in patentable invention. In the letter of rejection, the Examiner said:

“The claims presented by amendment of January 6, 1905, are rejected upon the state of the art of record. It is a matter of common knowledge to make envelopes of transparent material. It is a matter of common knowledge to make envelopes having a transparent portion and an opaque portion. It is a matter of common knowledge to render paper or envelopes transparent by treating such paper or envelopes with paraffine or grease. Applicant’s so-called border does not differ except in design from the balance of the opaque portion of his envelope. There is believed to be nothing whatever patentable in this application.”

In reply to this rejection on the part of the Office, applicant, on February 20, 1905, wrote a letter in which he stated, at page 599, that he admitted “that it is a matter of common knowledge to make envelopes of transparent material”; and also admitted “that it is a matter of common knowledge, broadly, to make an envelope of a generally opaque body having a transparent window or opening”; and also admitted that it was “not new to render paper transparent by treating it with grease,” but in which he insisted that “This border is new, and the Examiner has shown no reference for it.” Applicant insisted, therefore, that his claims were patentable.

To the above argument the Examiner, on March 28, 1905, replied to applicant, saying, at page 602:

“Notwithstanding applicant’s argument the claim is still deemed to be unpatentable over the references of record and for the reasons stated. The claims are therefore each a second time and finally rejected.”

Thereupon, on February 28, 1906—eleven months after the above rejection—an appeal was taken to the Board of Examiners-in-Chief, and the claims considered by the three Examiners constituting such Board. Before the case, however, was sent up to the Board of Examiners-in-Chief, the Examiner, on March 6, 1906, wrote another letter to the applicant, in which he cited the Cohn English patent No. 14,478, of June 27, 1904, and the Brown 1862 patent, No. 36,393. In reply to this letter, the attorney for Cohn, on March 13, 1906, wrote a reply saying, among other things, that the Cohn British patent was a patent to the applicant and was not for the same invention as the one claimed in this application, and that the Brown patent was not cited in rejection, and, therefore, he refused to treat it as a reference. Thereupon the appeal was proceeded with. In such appeals it is the practice for the Examiner to file a written statement with the Board, giving his reasons for his rejection, and on March 22, 1906, the Examiner filed his statement before the Board. In his statement the Examiner sets out what Cohn described in his specification and what he was claiming.

The Examiner, in considering the Cohn and Shipp British patent—the patent which Cohn claimed was his own patent and invention—among other things, at page 608, said:

“It is noted that the British patent to Cohn & Shipp does not set forth how the transparent portion of the envelope is formed. The patent to Brown states that the transparent portion or window in his envelope may

be made by the same means or substance as is employed for making tracing papers, &c. To print a certain border with colored ink or pigment around the transparent portion of Brown's envelope in the same way that Cohn & Shipp print a border around their transparent portion would not involve invention."

In his statement the Examiner, in discussing the Busch British patent, at page 609, said:

"The British patent to Busch above cited discloses an envelope having a transparent window comprising a portion of the front of the envelope surrounded by an opaque border, such border being formed by 'printing with opaque coloring matter.' Thus it is clear that this patent anticipates every letter of Claim 1. Busch does not set forth that he forms his transparent portion by the application of paraffine or the like. Such procedure is clearly set forth by Brown, however. *To print a colored border with opaque coloring matter around the transparent portion of Brown's envelope would not constitute a new invention.*"

Thereupon the attorney for applicant filed an argument before the Examiners-in-Chief, in reply to the Examiner's statement, in which he insisted that "The novelty of this invention is in providing a colored or tinted border surrounding the window portion which has been made transparent by some preparation which, because of its oily character, will creep into the surrounding opaque stock and give a ragged and unsightly outline to the transparent window." The attorney, in his reply to the Examiner's statement, at page 613, also says:

"The British patent to Cohn & Shipp, 14,478, June 27, 1904, is applicant's own invention; it is identical with applicant's other pending case filed May 9, 1904, Serial No. 207,082. It does not disclose, or even remotely suggest, the present invention, for which reason applicant has not mentioned his British patent in the oath to the present case. . . . The British patent to applicant does not use and does not describe a border surrounding

a window which has been made transparent by a preparation which will 'creep' into the opaque stock. The British patent describes an envelope made of substantially transparent stock, the back of the face of which is rendered opaque by some coloring matter, leaving the window uncolored. As there is used no preparation which will 'creep' into the opaque stock, there is no use for the surrounding border to conceal such creeping and give definition to the window opening."

In reference to the Busch English patent, the attorney for applicant, at page 615, among other things, said:

"The remaining reference, British patent to Busch, 11,876 of 1896, has a portion or the whole of the envelope transparent. The front is transparent while the back is opaque, or a portion only of the front may be transparent. The patentee says, 'The desired contrast or difference may be produced either by choosing two different kinds of paper, or by printing with opaque coloring matter applied to a portion of the envelope.' The 'two different kinds' of paper means pasting one part to the other, and the printing with coloring matter must refer to printing on a normally transparent paper."

The Board of Examiners-in-Chief came to the conclusion that there was no invention in the claims. All three of the Examiners-in-Chief concurred in this conclusion. They filed an opinion April 18, 1906, in which they stated their reasons. Among other things, at page 616, they said:

"The alleged invention relates to the class of envelopes in which the address is not written on the envelope itself but on a paper inside of the envelope and is read through the transparent surface thereof. The appellant starts with an opaque material and by treating a portion thereof makes a transparent window therein at the point where the address is to appear. It is said that the preparation used in treating the material to make the transparent window cannot be applied in such way as to make a clear cut and regular outline for the window but will creep and make an irregular and rough outline.

To hide this rough outline and leave a transparent window of symmetrical and regular shape the appellant applies a colored border to the surface around the window. The supposed invention here resides in placing this border around the window."

The Examiners then quote from the Brown 1862 patent, and, on page 618, say:

"It is obvious that by following the directions first stated an envelope of the same construction as the appellant's is produced. The appellant has merely added a colored border for the purpose of ornamentation."

And this was and is exactly what it was and is for, and nothing else. Ornamentation—to make the envelope look better—"for the purpose of obliterating or concealing the effects of the tendency of the said preparation to creep into the surrounding opaque stock," to use the words of the claim. The border does not *prevent* the creeping but merely *obliterates* or *conceals* the creeping. The border, as the Examiners-in-Chief say, is for the purpose of ornamentation.

The Examiners-in-Chief then proceed to consider the Cohn and Busch British patents, and say:

"In the patent to Cohn *et al.* is described an unpunctured envelope having a transparent window surrounded by a portion to which dark colored ink has been applied. This is also true of Busch. The border in this case seems to extend to the edge of the envelope, but it is nevertheless a contrasting border. Its purpose is, like that in the appellant's case, to have a transparent window regular in outline and of the shape desired. If the transparent material extends to the edge of the envelope it is necessary to extend the ink covered surface to the edge, whereas if the transparent portion does not extend so far it is not necessary to extend the ink so far. It may, however, be applied in the shape of a border sufficiently wide to cover the edges of the transparent portion. The purpose, function and idea of means seems to

be the same in both cases. The rough edges of the transparent portion would be concealed just as well by coating all of the balance of the envelope with dark colored ink, and the only purpose of substituting a narrower border seems to be to get a different artistic effect. There is no mechanical advantage or utility in it. It is a mere matter of design.

“The claims are lacking in patentable novelty in view of the references cited and therefore the decision of the Primary Examiner is affirmed.”

An appeal from the decision of the Board of Examiners-in-Chief was thereupon taken to the Commissioner of Patents, and a decision in favor of applicant obtained, whereupon the case was referred to the Primary Examiner, and on August 6, 1906, it was amended by applicant by canceling the first claim, so as to leave only the claim which now appears in the patent. Thereupon the application was formally allowed and the patent issued.

From the foregoing it appears that four of the five judges in the Patent Office who passed on the matter were of the opinion that there was nothing of patentable invention in the Cohn envelope. These four judges—the Primary Examiner and the three Examiners-in-Chief—are required by the Statute to be men of *mechanical, legal and scientific* attainments, while no such requirement is made as to the Commissioner. The Commissioner’s office is largely *executive*, and the President is free to appoint any one, whether possessing legal, scientific, or mechanical experience and attainments or not, to the position of Commissioner. As to the others, however, the Act of Congress is particular as to their qualifications and attainments. Section 482 of the Revised Statutes, in defining the duties and qualifications of the Examiners-in-Chief, says that “The Examiners-in-Chief shall be persons of *legal* knowledge and *scientific* ability.” The Primary Examiners are appointed by the Secretary of the In-

terior, after they have satisfactorily passed rigid technical, mechanical, and scientific examinations. The Commissioner of Patents, however, may be anybody that the President may see fit to appoint, and there is no requirement that he shall have "competent *legal* knowledge and scientific ability," nor any other kind of knowledge or ability.

When we come, therefore, to consider the *weight* that should be attached to the opinions and decisions of the Examiners and Examiners-in-Chief and the Commissioner, upon questions of invention, novelty and patentability, we think there is no question as to whose opinions should have the greatest consideration and weight. In this case, four men of special knowledge, acquirements and ability, acting as judges, united in saying that the envelope of the first Cohn patent contains nothing of invention or patentability, while the Commissioner alone is of a different opinion. It is to be remembered that these proceedings are *ex parte*. On hearings before the Board of Examiners-in-Chief and the Commissioner, nobody appears to orally explain and present the matter on behalf of the public. Only the written statement of the Primary Examiner is present. On the other side, however, the applicant may be represented by his attorneys to make oral presentation and arguments. They evidently succeeded in this case in persuading the Commissioner to pass the question on to the courts to determine should litigation ever arise under the patent.

We submit and insist that great consideration and weight should be given to the opinion of the Primary Examiner and of the Examiners-in-Chief in their conclusions in this case, and that but little weight or consideration should be given to the conclusion of the Commissioner, who has thrown upon the court the responsibility of deciding as to the validity of the Cohn patent.

The conclusion of the Examiner and of the Examiners-in-Chief is in harmony with the views expressed by the various witnesses for the defendant, reinforced as they are by grounds and reasons that were not presented to the Office on the *ex parte* proceedings leading to the issuance of the first Cohn patent. The Office was not furnished with proofs as to the use of borders by three-color picture printers, or lithograph label printers, or of printers generally, to cover up and conceal unsightly, rough, or undesirable appearances in the edges and margins of work of various kinds, due to the misplacement of the colors or the running or spreading of the inks employed. Nor were they furnished with exhibits or illustrations of such work, showing the use of borders accomplishing the same purpose and object as they do in the case of the envelope of the first Cohn patent. Nor were they supplied with the reasons and decisions that are now placed before the court for showing the lack of invention and patentability in the Cohn envelope.

Yet, in the absence of all of these cogent and convincing reasons for finding that there is nothing of inventive quality or character in what Cohn did, the Examiner and the Examiners-in-Chief came to the conclusion, on the meager showing before them, that there was no invention or patentable novelty in the envelope of the first Cohn patent. Much greater reason is now presented for a similar conclusion on the part of the court.

In vain we search the opinion of the learned judge who decided the case below for any consideration of the question of *invention* over the state of the art which we have explained above. We either failed to make our position clear to the learned judge, or else when he came to decide the case he in some way overlooked the defense of lack of invention in view of what had been done and disclosed by the prior art; at least he failed to specifically refer to and dis-

cuss this defense. His whole opinion, so far as the validity of the first Cohn patent is concerned, appears to have been directed to the defenses of *anticipation* and lack of *novelty*, which we have seen is entirely separate and distinct from the defense of lack of *invention*. We therefore confidently submit to this court our belief and contention that the first Cohn patent exhibits nothing of invention in printing the border around the transparent window of the Brown 1862 patent, in view of the numerous uses of borders around various matters on paper used for different purpose, established by the evidence, including the printing of a border around the window space of an *envelope*, as disclosed and described by Busch in his 1896 British patent.

It may be well, before closing this branch of the case, to refer to one matter which we regard as of no importance or consequence but which counsel in the argument below seemed to regard as worthy of discussion and which he strongly pressed upon the attention of the court. The fact has already been referred to that on December 15, 1903, we wrote a letter to Mr. Regenstein, which is quoted at page 268 of the record. This letter was in relation to a one-piece window envelope in all respects like that claimed in the first Cohn patent, with the exception that it had no border around the window. This envelope was exhibited to us by Mr. Regenstein and Mr. Reese, who was associated with him, and we were asked whether we considered that such envelope would infringe the Callahan patent for a two-piece window envelope, appearing at page 725, which calls for an envelope having "a display opening therein having transparent covering"—an envelope in which a piece of opaque paper is cut out and a separate piece of transparent paper pasted over the opening. In our letter we advised Mr. Regenstein that the envelope shown us did not infringe the Callahan patent, and also that we considered that the envelope was patentable over the envelope claimed in the Callahan patent. Coun-

sel for complainant argued that if we considered the envelope without a border as involving invention and as being patentable, much more should we consider an envelope having a border as containing invention and as being patentable. The conclusion that counsel attempts to draw is in no way justified by the premises.

It will be noted that our letter merely says that "We consider that the envelope which you showed us is patentable over *the* envelope claimed in the *Callahan* patent"—a two-piece transparent window envelope. Undoubtedly, were it not for the state of the art afterwards disclosed when Reese applied for a patent on the *envelope* itself, and by the research of counsel in this case, as disclosed by the evidence, a *one*-piece transparent envelope would be patentable over a *two*-piece window envelope—over the envelope of the *Callahan* patent. In pursuance of our advice, Reese made an application for a patent on the *one*-piece transparent window envelope, which application is printed at page 652 of the record. It developed, however, that a patent for a similar envelope had been issued to Brown in 1862—something that we knew nothing about at the time our letter was written. The Reese application was rightly rejected on the Brown patent, as appears at page 67, and no patent ever issued on the Reese application, because the Reese envelope and the Brown envelope were the same. The Brown patent removed every vestige of invention and patentability from the one-piece window envelope about which our opinion was given, and on which Reese made his application, because it thus appeared that the Reese envelope was old.

We apologize for referring to so trifling a matter,—a matter so irrelevant and easy of explanation—but our justification is in the fact that counsel for complainant laid great stress on it in his printed argument in the court below.

The Preparation Instead of the Border Took Time and Work.—The Border Was Easy.

Both Mr. Cohn and Mr. Regenstein spent a lot of time in getting their envelopes into the market. In both cases, however, this time was principally required in getting a satisfactory oily preparation for producing the transparent spaces or windows. For instance, at almost the end of his deposition, Cohn was asked at page 208 and testified:

“R-D. Q. 195. You have testified to the placing on the market in 1904, some 10,000 envelopes used by the Zellerbach Company and embodying your invention. Can you state the amount of time and the amount of money you expended in bringing your invention to the point of development represented by those commercial envelopes which you have heretofore identified as corresponding to Exhibits L and M?

“A. I can. I worked continuously and persistently for over a year, beginning some time in 1903 and ending with the production of these 10,000 envelopes in 1904, putting in many nights, many Sundays and several holidays. I never at any time desisted from my efforts, but kept on patiently sticking to the object I had in mind, never quitting until I accomplished the object I sought. During this period I expended some \$3,000, which may not appear to be a great sum to some people but meant a vast amount to a man of my means. This money I used for various purposes such as the purchase of different chemicals and oils used in making my preparation; also for ink and paper of numerous natures and consistency. Part of this money was also used in paying for labor which was generally at a high rate on account of the work being done on what is termed as ‘overtime.’ I also paid to chemists various amounts for work done at my request. I frequently found that after spending much time and money on a certain preparation that the same was useless for my purpose and it was necessary for me to start over again. During this period I did a little work on the envelope described in my abandoned application dated May 9, 1904, but the expenditure of time and money on this particular feature was very trivial.”

The witness Tooker, who was foreman of the press-room of F. H. Abbott & Co., and who worked with Mr. Cohn, also lays great stress on the difficulty of getting the desired and requisite material for producing the transparency. In answering question 6, among other things, at page 236, he said:

“All of the mixture for transparency was supplied by Mr. Cohn. There was quite a bit of trouble in getting the printing-press to handle these different preparations, which required a good deal of time and thought. We had a great many difficulties to overcome, *the main one being to get the desired transparency*, which he finally succeeded in getting.”

Again, in answer to question 31, the witness Tooker explained the necessity of thoroughly cleaning the press before applying the oily preparation. Among other things, at page 244, he said:

“In washing up for the preparation it became necessary to go over the press again and again and the rollers more particularly. The least bit of color on the press or rollers had a tendency to discolor the transparency and make it darker or opaque. It became necessary in using this preparation to make the press absolutely, or as near as possible, clean. We found another difficulty in using some of the preparations, and it became necessary in order to make the preparation flow as freely as was necessary to use gas stoves under the press, heating the plate and making the preparation run out smoothly. We finally got these things so that the preparation run perfectly. The transparency that we reached in the early stages was inclined to be more dirty and mottled, not smooth.”

In like manner, Mr. Regenstein spent the great bulk of his time and money during the experimental stages in perfecting the transparency producing materials so that they would not only make a transparent window, but also make it satisfactorily. In answer to question 79, at page 278, he said:

“A. After the border matter was settled in January,

1904, we gave our attention, up to this day, to the perfecting of the transparency of the window.

“Q. 80. Do I understand that the matter of improving and perfecting the transparent portion of the envelopes was a difficult matter?

“A. A very difficult matter.

“Q. 81. Without going into details as to the preparation of the oil or whatever it is that you used, you may state what difficulties you found in that matter, if any.

“A. The difficulties in preparing the windows properly were found on account of atmospheric conditions, non-elastic oils, and various other causes.

“Q. 82. You may state what the fact may be as to losses of envelopes through the sticking of the sides together, where the transparent windows were formed, or matters of that kind.

“A. We have found and experienced in 1906 that the transparent window would stick to the back of the envelope, and have spoiled at least forty to fifty million envelopes in that matter.

“Q. 83. You may state whether your company has much money invested in the business of manufacturing transparent window envelopes, or has spent much money for that purpose, from first to last.

“A. The loss to our company in perfecting envelopes is over \$100,000.

“Q. 84. How far do you consider that your company has brought the manufacture of these transparent envelopes to a condition where they are practical and satisfactory to the public?

“A. Our envelope is now considered the most perfect transparent envelope in existence, and has a sale in this country as well as in foreign countries.”

Both Cohn and Regenstein found the great difficulty was in getting a satisfactory material for producing the transparency—one that while producing the transparency would be inexpensive and unobjectionable in other respects. The application of the *border* was purely a mechanical act. Anyone familiar with the printing art would find that a simple matter. Mr. Regenstein, in answering question 52, at page 271, said:

“As soon as we found out early in January that the

oil was found to bleed some, as old printers, we decided that we had to go back to our old trick and print a border which was intended to cover such bleeding of the oil which could not be prevented.”

Again on page 294 he was asked and testified:

“Q. 138. When you saw that the oil ran or bled into the paper, how long did it take you to know what to do to remove the difficulty?

“A. The time was so short that I cannot state the same, since it was simply a thought.

“Q. 139. Did you do anything more than apply the knowledge you had of the printing art ~~as~~ to the situation?

“A. I did not.”

The witness Sauerman, who was the pressman that helped print the envelopes in January, 1904, was asked, on page 348, and testified:

“Q. 14. What did they do with the paper after you had applied the oil, if you know?

“A. We found that upon applying the oil to the paper it crawled or spread; so we made a ring plate and printed it on the paper.

“Q. 15. What did you print it on the paper for?

“A. To cover up the unevenness of the oil.”

The witness Wien, who also assisted in printing the envelopes in January, 1904, was asked, on page 356, and testified:

“Q. 16. When did you first see, if you did see, a ring or border printed around the transparent portion formed by the oil?

“A. On the same day that the oil was put on the envelope. In January, 1904.

“Q. 22. Did you yourself personally do any work printing or otherwise, on these one-piece transparent window envelopes, or the paper for making them?

“A. I did.

“Q. 23. What was that work?

"A. I printed the oil on the paper, and later in the afternoon I printed the border around the window."

The witness Olson, an engraver, who made the ring for printing the border around the transparent window in January, 1904, was asked, on page 377, and testified:

"Q. 24. Did you ever make any plate for printing borders for or under the directions of Mr. Regenstein?"

"A. Yes.

"Q. 25. Please tell us what you made borders for Mr. Regenstein for.

"A. We made one especially of a ring to print over and around the window in an envelope.

"Q. 26. Did you yourself make a plate for the ring or border mentioned in your last answer?"

"A. Yes.

"Q. 27. Prior to making the plate for the ring or border for the envelope, had you made plates for rings or borders for or under the direction of Mr. Regenstein for other classes of work?"

"A. Yes, sir, as referred to before.

"Q. 28. How common a thing was it to make plates or rings and borders at Mr. Regenstein's place before you made the one for the envelope?"

"A. It was so common that any engraver would make a ring of this kind immediately upon seeing that the pictures showed any ragged edges, without even consulting with the foreman. In fact, everybody in the printing business used that method to cover defects.

"Q. 29. Please tell us about how you came to make the plates for the ring or border for the envelope work that you have referred to.

"A. Mr. Regenstein called me down to the office and instructed me how to make this ring.

"Q. 30. What instructions did he give you?"

"A. He told me to make a ring on a plate of zinc to print around a window of an envelope, which he gave me as a size to go by.

"Q. 31. Did he explain what he wanted it for?"

"A. Yes.

"Q. 32. Did he show you anything to go by?"

"A. Yes, as I have previously answered, he gave me

a sheet of paper showing an oblong spot covered with oil and told me to make a ring to print around the edges.

"Q. 33. Did you make the plate as directed by Mr. Regenstein?

"A. Yes.

"Q. 39. If you know, please state who did the printing on the press with this plate.

"A. Ernest Sauerman."

"Q. 51. Prior to making the plates for the rings or borders for the envelope paper, as you have explained, had you seen work where the inks ran or spread at the borders?

"A. It does so in most every case where a solid plate is used. I have seen this as far back as I can remember being in business.

"Q. 52. In such cases as you have just mentioned, what was done, if anything, to cover up the running and spreading of the ink at the borders or edges?

"A. In the first place the printer would thicken up his ink or use a different kind of ink to prevent this spreading, or he would run something around the border or edge to hide this defect.

"Q. 53. Did you ever make any plates for the printing of a ring or border around the edges to cover up the running or spreading of the ink, as you have just mentioned?

"A. Yes, just as often as the printer would decide that by printing a border he could eliminate the ragged appearance of the edges of the picture, I would have to make a plate for him.

"Q. 54. How long ago have you made plates for printing a border around work, where the ink ran or spread so as to prevent ragged or unsightly edges or margins?

"A. About 16 or 17 years ago.

"Q. 55. How common a practice was it, to your knowledge, in the printers' art, to print rings or borders around different kinds of work, where the ink ran or spread, to cover up defects or unsightly appearances in the edges or margins of the work?

"A. It is so common that everybody in the printing establishment would be expected to know it.

"Q. 56. Was it a part of the common knowledge and practice of the printers' art?

"A. Yes."

From the above it is plain that the difficulty in making a one-piece transparent window envelope with a border around the edge, to cover up or conceal any running or bleeding of the oil, resided, not in the *printing of a border*, which was the usual and common expedient of printers, but in securing out of the many oily preparations that can be compounded a *preparation for producing* the transparency that would not evaporate or dry out and cause the transparency to disappear; that would not make the window muddy or mottled in appearance; that would not cause the sides of the envelope to stick together; that would flow with the requisite freedom to do the work; that would not change under climatic conditions after the envelope had been made, and matters of that kind.

Both Mr. Cohn and Mr. Regenstein had their troubles with the transparency producing preparation. The border was such a minor matter that Mr. Regenstein saw at a mere glance what was needed to correct or conceal the objectionable appearance in the margin of the transparency. His men all understood the same thing. There was no hesitation, no experimentation, no difficulty about it. The need of the border was apparent to these men familiar with the custom and practice of applying such borders in the printers' art. Hence, the amount of time and money that Mr. Cohn may have expended in getting a *suitable material* to make the *transparency* is immaterial on the question of whether his act of *applying the border* involved invention. The Cohn patent, like the Brown 1862 patent, gives no formula as to the material to be used, but the patentees in both cases left that to the selection of the maker of the envelopes, and it was in the *selection of the material* best adapted for producing the transparency and not in the *printing of the border* around it that the difficulty and the *only* difficulty occurred.

We inquired into the matter of expenditure of Mr. Regenstein, not to show any inventive quality in the application of the border, but to show the merits which are to be attributed to one who, at great expenditure of time and money, has developed a manufacture, made it practical, and supplied it to the world. The application of the border to a one-piece transparent window envelope was simply an application of an old and well-known expedient to an old and well-known purpose in an old and well-known way, involving nothing of the quality or character of invention.

The Nearest Approach to the First Cohn Patent.

After the defendant's expert, Mr. Bond, had considered, both on direct and on cross-examination, the various patents of the prior art, and had pointed out their similarities to and differences from the Cohn patents in suit, and was asked in cross-question 80, at page 536, which one of all the patents he had considered most nearly approached the Cohn patents in suit, he said, as to the first Cohn patent:

"The Brown 1862 patent has the envelope containing the feature of a single-piece transparent-window envelope, corresponding to the envelope of the Cohn patent, without having the opaque border around the transparent window, and which it would be necessary to have in order to make the envelope of the Brown 1862 patent the *fac-simile* of the envelope of the first Cohn patent."

In question 17 of his second deposition, Bond was asked, on page 581, why he selected the Brown 1862 patent instead of the Busch 1896 patent, and replied:

"For the reason that the Brown envelope is made from an opaque stock, as called for by the claim of the first Cohn patent. This opaque stock in Brown has a portion thereof rendered transparent, which is also a requirement of making an envelope under the claim of the first Cohn patent; and, therefore, it seemed proper

for me to select the Brown patent as having the nearest resemblance or being the nearest approach to the envelope of the first Cohn patent, rather than the Busch, in which the stock for the envelope is made entirely transparent instead of being opaque with only a portion transparent."

In giving his opinion as requested above, as to the nearest approach by any single patent to the first Cohn patent, Mr. Bond did not, of course, mean to imply that the other patents of the prior art were not pertinent or were not to be considered in determining whether or not the envelope of the first Cohn patent involved invention. That is a question to be answered after a consideration of the entire prior art presented. What is lacking in one patent on such a consideration may be supplied from the teachings, instructions, and disclosures of other patents. Everything disclosed in *all* of the prior patents in evidence constitutes a factor to be considered in the determination of the question as to the presence of invention and patentability in the envelope of the first Cohn patent.

As said by the Supreme Court in *Loom Co. v. Higgins*, 105 U. S., 586,

"That which is common and well known is as if it were written out in the patent and delineated in the drawings."

In *Imperial Bottle Cap & Machine Co. v. Crown Cork & Seal Co.*, 139 Fed., 324, the United States Court of Appeals for the Fourth Circuit said:

"The general rule is that every patent is to be read as if the whole state of the art is written on its face, and in considering the patents for a combination, it is to be remembered that the alleged infringer has equal rights with the prior patentee to the use of every element known in the art at the time when the first patent was issued."

In selecting the Brown 1862 patent, we simply have a starting point—a disclosure to which all of the disclosures of the other patents, exhibits, and practices in evidence are to be added and the *accumulated* sum of the knowledge thus obtained is to be considered—just, as the Supreme Court says, as if it were written into the Cohn specification and delineated in the Cohn drawings. The Cohn patent must, therefore, be considered the same as if it stated on its face that Cohn took the envelope of the Brown 1862 patent and printed a border around the transparent window, as was done by the three-color printers, and as was done by the lithograph label printers, and as was done in the printing art generally, and as was done in the way described in the Tudor 1878 patent, and in the way described in the Busch 1896 patent, and as described in the various other patents in evidence. In short, the Cohn patent is to be judged precisely as if it said in its specification that it took the Brown 1862 envelope and printed a border around the window, according to the *usual practice* of the printer's art, and according to the *instructions* contained in the other patents in evidence.

If Cohn had come before the Patent Office in his application November 8, 1904, and stated in plain language that what he did was to take the envelope of the Brown 1862 patent and print a border around its window, according to the instructions of the Busch and other patents, and according to the *usual and well known practice* of printers in doing their various kinds of work, can it be supposed for a minute that his application for a patent would have been entertained? Suppose that Cohn in his application had *written* in the state of the art, as the Court of Appeals for the Fourth Circuit in the above case says that it is to be *read* in, and had stated in his specification the *exact facts* as to the prior art, as they are established in this case, his specification—and

we begin *our* rewriting of it at line 63 of the second column of the first page—would in fact and reality have read:

The Cohn Specification as the Law Reads It.

“Since the oily preparation has a tendency to creep or ‘bleed’ beyond the borders of the space imprinted by the stamp or die by which it is applied, and so possibly stain or discolor the rest of the envelope or give a ragged appearance to the window opening, it is preferred, even where the paper might ordinarily be deemed sufficiently opaque, to apply some sort of coloring matter at least around the immediate borders of the transparency. This border is printed around the transparent space or window either in black or other colored inks. The border that I print on my envelopes is the *same kind* of a border as has been used *for many years* by printers of three-color pictures, printers of lithograph labels, and printers generally, to obliterate, cover up, or conceal, any running or spreading of the inks or colors, or any ragged, irregular or other undesirable appearances in the margin or edge of the work enclosed within the border and so as to give definition and sharpness of outline to the work enclosed within the border. The border furthermore may be like the border described in the Busch 1896 British patent, and extend, if preferred, from the transparent window space over the entire face of the envelope; or like the border shown in the Leigh 1894 British publication, which extends from the desired transparent space to the margin or edge of the paper; or like the border shown in the Tudor 1878 patent; or like the border shown in the Hole 1894 British patent. In fact, the border may be of *any of the old and well known kinds* that have been used by printers for many years on various kinds of work, and shown and described in prior patents for various purposes. There is *no novelty* in the use of a border to cover up, obliterate, or conceal the running or spreading of inks and colors and to give definition and sharpness of outline to the work enclosed within the border. The border on my envelopes, furthermore, may be *printed* on the paper the same as has been done *for many years* by printers with the borders used by them to cover up or conceal irregular, ragged, or unsightly outlines in their

work. There is *no novelty* in printing or applying the border to the paper of my envelope.

“In fact, I may say, in describing the invention for which I desire a patent, that the *envelope itself* is old, as shown in the Brown 1862 patent, with the exception of the border which I propose to print around the transparent window. The *border itself* is old, as used by printers for many years for various kinds of work, and as disclosed in various prior patents. The *method* of applying the border, by printing on the paper of my envelope, is old and is *precisely the same* as the method that has been used by printers for many years. In short, all that I do is to take an *old and well known envelope* and an *old and well known border* and apply the one to the other in the *old and well known way*, and for *this* I want a patent.”

The above specification, as we have rewritten it, is precisely the way it *would have been written* and presented to the Patent Office *if it had been written* “as if the whole state of the art is written on its face,” as the Circuit Court of Appeals for the Fourth Circuit in the above case says that it is to be *read and understood*. But if it had been presented in full as we have rewritten it above, the Office would instantly have said, as any court would say, that nothing of invention was disclosed, that Cohn simply applied the old familiar and well known method used by printers and described in patents, for giving definition to his window or transparent portion, and for covering up and concealing any ragged, irregular, or undesirable appearance in the edges or margins of his window, and that all this was matter of common knowledge and practice.

Inasmuch as everything which was common and well known is to be considered as if it were written out in the specification and delineated in the drawings, we see that all of the patents, exhibits, and practices showing what was “common and well known” are to be taken into considera-

tion, and that in selecting the Brown 1862 patent as being in and of itself, without reference to anything else, the nearest approach to the first Cohn patent, we are simply getting an admitted starting point, leaving open merely the question as to whether the other patents, practices, and exhibits *supplemented* its disclosures and taught the art how to *remove* the obvious and admitted difference between such exhibit and the envelope of the first Cohn patent. In this view, it is plain that what was *not* disclosed by Brown in his 1862 patent *was* disclosed in the other patents, exhibits, and practices established by the proofs, so that at the time Cohn entered the field nothing of original, creative, or inventive work was left for him to do in producing his envelope.

It follows, therefore, as already pointed out, that nothing in the nature of *invention* was performed by Cohn when he took the envelope of the Brown 1862 patent and printed onto it the border disclosed in the Busch, Tudor and other patents, and used by three-color picture printers, lithograph label printers, and printers generally, for giving definition to what was inclosed within the border, and for covering up and concealing whatever ragged, uneven, or undesirable appearances there might be in the edges and borders of such work.

The First Cohn Patent Anticipated by the January, 1904, Envelopes.

The first Cohn patent, applied for November 8, 1904, contains but one claim, which reads as follows:

“As a new article of manufacture, an envelope with an unpunctured face of relatively opaque stock, said envelope-face having a portion to which a preparation has been applied to render such portion transparent, and a colored or tinted border surrounding said transparent portion for the purpose of obliterating or concealing the

effects of the tendency of the said preparation to creep into the surrounding opaque stock.”

The above claim describes what has been repeatedly designated in the testimony as a one-piece transparent window envelope. This distinguishes it from those window envelopes which have the window made from a separate piece, pasted in to cover an opening cut in the stock of the envelope itself. The transparent portion is formed by the use of an oily preparation which fills the pores of the paper, and naturally spreads more or less into the texture of the paper itself, so that the edge or border of the opening may present somewhat of an irregular and unfinished appearance. Cohn says that to obviate this and to cover up and conceal the ragged or unfinished appearance around the edge of the window, he prints a border of coloring-matter around the window.

The first Cohn patent is fully met and anticipated by the envelopes made by Mr. Regenstein and Mr. Reese in January, 1904. It appears from the testimony of Mr. Regenstein that he and Mr. Reese visited the office of Banning & Banning in the latter part of 1903 to consult them in reference to a one-piece transparent-window envelope, both as to its patentability and as to whether it would infringe the Callahan 1902 patent, and on which occasion they exhibited an envelope about which they desired such opinion. In pursuance of this visit and on December 16, 1903, Banning & Banning wrote a letter to Mr. Regenstein, which is quoted in defendant's record at page 268. This envelope exhibited to Banning & Banning, however, had no border around the transparent window. It appears, furthermore, that, immediately after this visit and opinion, and beginning early in January, 1904, Mr. Regenstein, who was assisting and financing Mr. Reese, began to make one-piece window envelopes by applying an oily prep-

aration to the desired portions, and as soon as they noticed that the oil they were using spread or ran into the material, they, as old printers familiar with the practice of the printers' art, had a plate made, and printed borders in the form of rings around the windows. This not only gave definition to the windows, but also covered and concealed the running or bleeding of the oil used to make the transparencies. Mr. Regenstein had preserved a number of these first envelopes made in January, 1904, and produced them in evidence. They will be found in the defendant's original record, opposite page 30. The first sample has the border printed with a white ink, which gave a border that did not contrast to the desired extent to the yellowish color assumed by the window on the application of the oily preparation. He, therefore, immediately printed borders by the same plate with a greenish or olive ink, which gave a more finished and desirable effect. In both cases, however, a border or ring was printed around the transparent section or space, and the full and complete invention of the first Cohn patent embodied and realized. These January, 1904, envelopes were made in the printing shop of the American Colortype Company of Chicago, of which Mr. Regenstein was at that time the Western general manager.

That these January, 1904, one-piece window envelopes provided with borders were made in January, 1904, is fully and completely established beyond a reasonable doubt by the testimony of Mr. Regenstein, beginning at page 270; Ernest W. Sauerman, who helped to do the printing, beginning at page 348; Joseph E. Wien, who also helped to do the printing, beginning at page 355; Gustaf Olson, the engraver, who made the plates for printing rings or borders on the January, 1904, envelopes, beginning at page 377; Max Lau, secretary of the American Colortype Company, where the printing was done, who not only saw the envelopes, but also saw Wien

print sheets of paper containing a number of blanks, as described in the Reese 1904 patent, beginning at page 392; Behrens, whose father was one of the proprietors of the American Colortype Company, where the work was done, beginning at page 420; and Adolph G. Voss, who was office manager of the Company at the time the printing was done, beginning at page 407. These seven witnesses saw the envelopes, saw the work being done, most of them assisted in doing the work, and they testified that the envelopes produced and others like them were made in January, February and March, 1904,—some of them in January, and some of them in the next month or two. They all testified that the envelopes were made prior to a strike that occurred about the last days of March, 1904, at the shop of the American Colortype Company, and gave circumstances and incidents which corroborated their statements. This strike was occasioned by the transfer of the witnesses Sauerman and Wien to the press room to work as pressmen, and the strike was inaugurated by the Franklin Union No. 4 of pressmen. It resulted in the filing of a bill in the United States Circuit Court at Chicago, and the granting of an injunction against the union. This injunction or restraining order was entered April 4, 1904, and a copy of it will be found in the defendant's record, at page 343.

It furthermore appears that on January 15, 1904, Reese applied for two patents. One of these, printed at page 651, was for the one-piece transparent-window envelope, and the other for the sheets of paper or stock out of which the envelopes are made. The first of these applications was rejected in the Patent Office, on reference to the old patent for that kind of an envelope granted to Brown, in 1862, already considered, and no patent was granted on it. The other resulted in the Reese patent of August 9, 1904. Neither of these applications showed or described the border

around the transparent window. The rejected application for the envelope appears, from the certified copy in evidence, to have been sworn to January 2, 1904. It was immediately after this application had been sworn to or filed that Regenstein began to make the January, 1904, envelopes, when he immediately observed the ragged or unfinished appearance of the edge or margin of the window and resorted to the expedient of printing a border around the transparent portion, to give it definition and to cover and conceal the undesirable appearance caused by the running of the oil. He made no effort to get a patent on this feature, as he regarded it simply as the old well known expedient employed by himself and other printers from time immemorial for giving a desired finished appearance to a job. In answer to question 136, at page 294, he says that "I did not apply for a patent on a thing or operation which I and others have done and made for years." His knowledge of the printing art and of what had been done for years, and was being done every day in the printing of three-color pictures and other work where borders were printed, made him consider that it would be ridiculous to ask for a patent covering the printing of the old and well-known printers' border around the windows of envelopes—something that had been done for years on many kinds of work. This answers the curiosity of complainant's counsel expressed in his question in the court below as to why Regenstein did not apply for a patent on it if he made envelopes in January, 1904, with a border on them—he did not consider that any invention was involved.

The first Cohn patent was applied for November 8, 1904. The January, 1904, envelopes, in evidence, were made some ten months before the application for the Cohn patent. Under these circumstances they operated to anticipate and invalidate the Cohn patent, unless Cohn could show beyond

a reasonable doubt that the envelope of his first patent was made prior to the January, 1904, envelope. For Cohn to anticipate the January, 1904, envelopes, as some of the cases hold, his evidence must be as strong as that required from the defendant to establish their making—certain beyond a reasonable doubt. Other cases use somewhat different language. They say that the evidence furnished by a complainant to anticipate an anticipation must be exceptionally strong, clear, and convincing. We will quote from two or three cases to show the exact language in which the law as to this matter is laid down by the courts.

In *Thayer v. Hart*, 20 Fed. Rep., 693, Judge Coxe, in 1884, said:

“The complainant’s patent antedating the defendants’, it was incumbent upon them to prove beyond a reasonable doubt that theirs was the prior invention. This they have done by proof so positive that the complainant’s counsel conceded on the argument that the date of their invention was January 15, 1877, eleven months prior to the filing of the complainant’s application. This date being fixed the burden was transferred to the complainant to satisfy the court by proof as convincing as that required of the defendants, that his invention preceded theirs. The rule in such case is very strict. It is so easy to fabricate or color evidence of prior invention and so difficult to contradict it, that proof has been required which does not admit of reasonable doubt.”

In *Westinghouse Electric & Mfg. Co. v. Mutual Life Ins. Co.*, 129 Fed., 216, Judge Hazel, in 1904, said:

“Evidence in support of the claim of earlier conception than the date of the application, disclosure of the invention, and its actual reduction to practice must be received with great caution. Unless such inventions were actually made and perfected before the date of the Ferraris publication, the patents cannot be sustained. The burden is upon the complainant, under the

circumstances to establish by clear, unequivocal, and convincing proof that the anticipation has been anticipated."

In *Clark Thread Co. v. Willimantic Linen Co.*, 140 U. S., 492, the Supreme Court, in 1891, said:

"After Weild's patent was introduced into the case, showing with certainty the date of its publication, and such date anterior to the issue of Conant's patent, it was incumbent on the plaintiffs in rebuttal, to show, if not with equal certainty, yet to the satisfaction of the court, that Conant's invention preceded that date."

But, without quoting from other cases to the same purport, the law is settled that where a complainant's invention has been anticipated by satisfactory and indisputable evidence, the complainant is defeated, unless, on his part, he can establish that he made his invention prior to the date of the anticipating structure. The presumption arising from the patent is that Cohn made the invention of his first patent at the date of his application—November 8, 1904—but this is some ten months too late, unless he has established by evidence outside of the patent that he made the invention at an earlier date and had it completed prior to the making by Mr. Regenstein and others of the January, 1904, envelopes. This brings us to a consideration of the dates claimed on behalf of Cohn.

The complainant Cohn was examined twice as a witness on behalf of himself. His second examination was begun February 23, 1911, after the testimony on the part of the defendant had been taken establishing January, 1904, as the date when the completed invention was embodied in the January, 1904, envelopes. Cohn knew, therefore, what date he must get behind in order to sustain his patent. Hence, every inducement existed for assigning a date for his invention

prior to January, 1904, to magnify everything he did and to confuse what he did on his *transparent* stock envelope with what he did on his *opaque* stock envelopes, and thus piece out the work on the one by the work done on the other.

In his *second* deposition Cohn says that after much thought he struck upon the idea of printing a border around the transparent portion of the envelope, and then, on page 113, said:

“This discovery was made by me some time in the year of 1903, this date being indelibly impressed on my memory from the fact that I severed my connection with the Illinois-Pacific Glass Co. on October 15, 1903 in order to take a position with A. Zellerbach & Sons, now known as the Zellerbach Paper Company.”

In the above Cohn says that the date when he made his alleged discovery was “indelibly impressed upon his memory. If this is the fact, if the date was *indelibly* impressed on his memory, then there should never have been a time after he had made his discovery when he could not have stated when it was made. Facts which are “indelibly” impressed can always be recollected and stated.

Cohn gave his *first* deposition in his own behalf on November 3, 1910. At that time no testimony had been taken on the part of the defendant. Cohn was, therefore, not informed as to what dates would be disclosed by the defendant's proofs. Nevertheless, as the date of his discovering the border was “indelibly” impressed on his mind, there could have been no difficulty of his fixing and stating the same. In cross-examination he was asked more than a dozen times as to when he made or conceived his invention. He invariably declared he could not tell. He professed to have no sufficient recollection. In order that the court may see the number of times in which he declared that he could not

remember when he had made or conceived of his invention, we will quote a number of questions and answers from his cross-examination while giving his *first* deposition in November, 1910, beginning at page 47:

"X-Q. 15. When did you first conceive of this invention, Mr. Cohn?

"A. I can't answer at the present moment.

"X-Q. 16. You don't know, then, when you first conceived of the envelope which you claim to have patented?

"A. Not at the present time."

"X-Q. 20. How long prior to the filing of your application for the patent No. 835,850 was it that you conceived the idea of that patent?

[No answer.]

"X-Q. 21. Do you decline to answer?

"A. My answer is the same as before, that I cannot at this time state the time of conception.

"X-Q. 22. You don't know whether it was two years or six years or twenty years or one month prior to the time of filing your applications. Is that the way you want to be understood as testifying?

"A. It would be necessary for me to go through a great amount of data which I have and consult with some of my witnesses, before being able to answer as to the time of conception.

"X-Q. 23. Well, you were the person who conceived the patent, were you not, Mr. Cohn?

"A. Yes, sir.

"X-Q. 24. And you at this time cannot give us any approximate idea as to how long prior to the time you filed your application in this matter it was that you conceived the idea of this patent?

"A. No, sir.

"X-Q. 25. And your answer would be the same as to the patent No. 824,908. Is that correct?

"A. Yes, sir."

"X-Q. 28. Well, was the first general feature of the patent conceived a non-perforated window?

"A. I can't recollect at this time just what the first conception of the patent was."

"X-Q. 31. So that altogether you have invented these two patents in this matter, and two others, and yet you can't tell us how long prior to the time you filed your

application for the patents in this case you first conceived the idea of the patent, nor are you able to tell us what was the first conception of the patent that you had in this particular case, what feature you first conceived. Is that correct?

"A. Yes, sir."

"X-Q. 45. I ask you then if up to June or July as you stated, 1904, when you and Mr. Shipp applied for a patent in England for an envelope with a visible window, had you up to that time conceived of the idea of placing a border around the edge of that visible window indicating the particular character of business in which the user of the envelope was engaged?

"A. As I stated, it is impossible for me at this time.

"X-Q. 46. Do you answer that in that fashion simply because your counsel at this moment called your attention to the fact that you had so testified previously? Is that your only reason for so testifying now

"A. No, sir; my reason is because it is a fact.

"X-Q. 47. You can't tell us at all, then, whether or not up to June, 1904, you had conceived the idea of a visible window of the envelope for which you applied for a patent in England or in this country?

"A. I can't state at this time."

"X-Q. 50. Now as I understand your testimony, you are not prepared to tell us whether prior to 1904, when you and Mr. Shipp applied for a patent on an envelope in England somewhat similar to the envelope in question, you had conceived the idea of a border around the window of the envelope indicating the character of the business in which the one who used the envelope was engaged, or not indicating the character of his business. That is the way I understand your testimony?

"A. Yes, sir."

Following the deposition of the witness Maynard, Cohn was recalled and further cross-examined. He stated that he conceived the idea of a border around the window prior to January 17, 1905, and was then asked:

"R-X Q. 2. How long prior to January 17, 1905, had you conceived such idea?

"A. I can't state at this time.

"R-X Q. 3. Was it more than a year?

"A. As I stated before, it is impossible for me to tell, at this time, just when the idea was conceived."

"R-X Q. 9. Was it before or subsequent to the issuance of the British patent that you first conceived the idea of placing around a window of the envelope a border so as to indicate the particular line of business of the user?

"A. As stated before, it is impossible for me at this time to give anything definite in reference to the time of conception."

In the above testimony Cohn more than a dozen times—fifteen times—declared that it was impossible for him to state when it was that he conceived of the invention involved in this litigation. In view of his statement, when called as a witness the second time, that the date when he conceived of the application of the border to his envelope was "indelibly impressed on his memory, it is hardly necessary to comment on the manifest character of his testimony given in his first deposition and quoted above. We think the plain fact was that he was determined not to disclose any date to which he could be held, and that he determined to leave himself in position to meet any contingency that might arise and so professed inability to state when he had conceived of the invention in question. If this be so, then, manifestly, his subsequent testimony should be accepted with caution, and unusual certainly required as to any definite claim of invention prior to the date established by the defense.

Cohn says that he severed his connection with the Illinois-Pacific Glass Company on October 15, 1903, in order to accept a position with A. Zellerbach & Sons. This may be true, but does not establish any other fact. It merely affords a date prior to which or subsequent to which other events may be referred. We will, therefore, consider what Cohn claims to have done prior to October 15, 1903, and what he claims to have done subsequent to that date.

In answer to question 9, Cohn, beginning at page 114, describes what he claims to have done prior to October 15, 1903. He says:

“My early experiments consisted of taking a sheet of paper and applying various oily preparations with a brush. Later, I applied these preparations with a block of wood and with pieces of rubber. It was then that I found that the oily preparation would spread beyond the size of the block. I remember one instance after applying the oily preparation I took a lead pencil and marked all around the spot made by the preparation and the next day I discovered that the oil had gone over the pencil marks in every direction. After making the discovery mentioned above of printing a border around the transparent portion, I consulted with Mr. Epting, an artist in the employ of the Glass Company, and asked him to make a drawing for me from which a zincograph could be made, and I described to him several designs that I had in mind. Among others, was a design showing an oblong space surrounded by a cloud effect. I have in my possession an envelope which was made from the original zincograph. This envelope shows that the ink is applied solidly around the space, which is understood to be the space reserved for showing the address, which I will call the window space, and is gradually shaded off. As a matter of fact, I bothered the various employees of the label department to such an extent that I incurred the wrath of the manager, Mr. George Walter, who had charge of all the employees in the label department, and had I not been an officer in the corporation, I think he would have kicked me out bodily. After zincographs had been furnished me by Mr. Epting of the label department, I took sheets of paper which I had prepared myself with an oily preparation and had the designs printed around the window space, thus prepared. The first ink that I used did not answer the purpose, and I was obliged to experiment with a great many different kinds of ink before securing one that would answer the purpose.

“Shortly before leaving the Glass Company I was introduced to a gentleman named B. T. Bean, a system man from Chicago. He was at that time installing a system for Dunham, Carrigan & Hayden, a hardware

concern whose place of business adjoined the Glass Company. Realizing that Mr. Bean was a man of a great deal of experience, also a man who was entrusted with all sorts of business secrets, I spoke to him in reference to my invention and showed him specimens that I had prepared in the manner described above. He was very enthusiastic about the envelope and in reply to my inquiry stated that in his entire experience, which carried him to every part of the United States, he had never seen anything like it, and told me that there would be a great market for an envelope of this description. It was about the time that I had the above interview with Mr. Bean that I made the change from the Glass Company to the Zellerbach Company. I remember this because I suggested to the Glass Company that since they were about to change accountants it would be a good time for them to establish a new system and Mr. Bean coming highly recommended, I considered him a good man to engage."

Further along in his answer to question 9, Cohn says that after October 15, 1903, he had all his printing done at the printing office of F. H. Abbott & Company; and in his answer he mentions a Mr. Tooker, the foreman of the Abbott Company, who did the work for him. As this details his work for the second period—the period beginning October 15, 1903, to take his date—we will again quote Cohn's exact language, beginning at page 117:

"After October 15, 1903, all my printing was done at Abbott's office, but I continued to have my drawings and zincographs furnished by the Glass Company, because F. H. Abbott & Company, being commercial printers, had no art department in connection with their business. From the time I began working with the Abbott Company I started to apply the oily preparation by means of a printing press. Up to this time I had used a brush or applied it with a block of wood or a piece of rubber, much in the same manner as rubber stamps are used. I encountered the greatest difficulty in finding a suitable material for making the transparent window and in connection with Mr. Tooker, foreman of the Ab-

bott Company, I worked continuously over a period of a great many months, putting in several evenings, also several holidays and Sundays. I found in some instances where I succeeded in getting a preparation that made an excellent transparency, that it would fade out and become almost useless; said preparations would keep the paper transparent for about a month and then for some reason or other the paper would become opaque again, and in some instances, this would occur within a very few hours after the preparation had been applied. I kept persistently at work from the time of my conception until August or September of 1904, when I brought my invention to a state of perfection. It was at this time that I placed an order for the Zellerbach Company with F. H. Abbott & Company for 10,000 envelope blanks, such as described above, and I still have in my possession a sample, which I here produce."

In the above statements, Cohn mentions three parties—Epting, the artist in the employ of the Glass Company; Bean, a system man from Chicago; and Tooker, the foreman of Abbott & Company. He says Epting made him some zincographs, one of which had a cloud effect border around an oblong space. He says that he has in his possession an envelope which was made from the original zincograph, but he does not say *when* it was made, but Tooker recognized it as one that *he* made. This envelope is the one introduced as "Complainant's Exhibit N." He says that he has a sample of the 10,000 envelopes made in August or September, 1904. This was offered as "Complainant's Exhibit L."

When were any envelopes made by Cohn containing a border around the transparent window or portion made by an oily preparation in *opaque* paper, prior to those made in August or September, 1904? Presumably, the first ones were with the cloud effect, like "Exhibit N," because **he** says: "I have in my possession an envelope which was made from the original zincograph." But *this* envelope was made by Tooker in the *spring or summer of 1904*, as we shall pres-

ently show. We think there is *internal* evidence in the record that this presumably earliest envelope, as well as all of the other samples of envelopes produced by Cohn, were made *subsequent* to May 9, 1904, and that there is no sufficient evidence that he ever made an envelope of *opaque* stock with a border around the transparent window prior to that date. We will therefore consider this internal evidence.

On May 9, 1904, Cohn filed an application in the Patent Office for an envelope, which application was afterwards abandoned. The envelope that he showed and described in this application was made from *transparent* material or stock as distinguished from *opaque* material or stock. This application was similar to the English patent obtained by Cohn and Shipp and applied for June 27, 1904. In the making of this envelope of the May 9, 1904, application, transparent stock was taken and ink of any desired color was printed over all of the envelope, with the exception of the addressing space or window, which was left transparent, as it was originally. This made a one-piece transparent window envelope with a border covering the entire face of the envelope except the window, as Cohn says in both of his patents the border *may* be made. An envelope embodying the idea of this abandoned application was offered in evidence as "Complainant's Exhibit R." This May 9, 1904, application continued pending in the Patent Office until June 24, 1905, when it was finally rejected and all effort to secure a patent on it abandoned.

This abandoned application, filed May 9, 1904, was the first application that Cohn filed for a patent on an envelope. But nowhere in this first application filed by Cohn, this application filed in May, 1904, do we find any description, statement or suggestion that Cohn had any idea in mind of the *bordered* envelope of his patent. This May 9, 1904, ap-

plication was the same in every respect—drawings and specifications—as the Cohn and Shipp June, 1904, British patent, as will appear at pages 128 and 178 of the Record. By reading the British patent, therefore, we can see exactly what the May 9, 1904, application disclosed. It in no way, shape or form described the envelope in question—a one-piece window envelope made from opaque paper with the window rendered transparent by an oily preparation and a border printed around the window to cover or conceal the spreading of the oil into the paper. Cohn at page 177 says it does not. Why was there no reference to this envelope if it had been conceived of and made in the fall of 1903? No explanation was offered for this omission. But it seems incredible that Cohn would have made an application in May, 1904, for a patent—his first application at that—and have left out all reference to the envelope now in question if he had made such envelope prior to that time, as he now claims. Why did he only describe the envelope made of transparent stock if he had also invented the other? He offers no explanation. We offer one—because he had not, prior to May 9, 1904, made the envelope. This explains the words on all the envelopes Cohn produced and offered in evidence—they were made *after* this May, 1904, application was filed.

When we look at the various envelopes produced by Cohn, we find that they are all marked “Patent Pending” or “Pat. Applied for.” The envelopes “Complainant’s Exhibits L, N, O, P and FF,” are marked “Patent Pending,” and the envelopes “Complainant’s Exhibits Q and R” are marked “Pat. Applied For.” These words speak for themselves. There is no explanation offered by Cohn or any other witness as to their presence. Presumably, at the time the envelopes on which they appear were made, an application *was* pending for a patent. They are either true or not. In the

absence of evidence to the contrary, the legal presumption is that they are true. If they were made after May 9, 1904, they are true. A patent was pending; a patent was applied for; and Cohn could truthfully print these warning words on his envelopes *after* May 9, 1904. To print them *prior* to that time would have been to put forth a false statement—an untruth—and the law never *presumes* that a man is lying.

All of the envelopes produced by Cohn, therefore, bear upon themselves, when taken in connection with the abandoned application of May 9, 1904, presumptive internal evidence that they were made *subsequent* to that date. If they were, as we think they were, then Cohn has not an envelope, a sketch, a plate, a memorandum—nothing physical and tangible—that antedates the January, 1904, Regenstein envelopes.

It is admitted by Cohn that the envelope "Exhibit R" was made *about the time* he filed his abandoned application. He was asked:

"Q. 25. Can you fix the time that this transparent sheet envelope 'Exhibit R' was made by you?

"A. I cannot fix the exact date but feel reasonably certain that it was made at about the time the application was filed for the United States patent.

"Q. 26. Which application?

"A. Application filed May 9, 1904, Serial No. 207,282."

He admits also that the envelope with cloud effect border, "Exhibit N," was made after he left the employ of the Glass Company. In speaking of this he says that before making the 10,000 envelopes which were made in August or September, 1904, "F. H. Abbott & Company printed for me some sample envelope blanks, printed from a zinc which was made by the Illinois-Pacific Glass Company before October 15, 1903," and he produces one of them, which was

offered in evidence as "Complainant's Exhibit N." Although he says the *zinco* was made while he was in the employ of the Glass Company, he does not state the time when the *envelopes* with the cloud effect were printed, but simply that they were printed by Abbott & Company "before making these 10,000 envelopes." The printer, Tooker, who did the printing recognizes the Exhibit N with the cloudy border as one he printed, but in answer to question 25 says that he cannot give the "exact date." It is reasonable, therefore, as they contain the words "Patent Pending," to assume that they were made *after* filing the abandoned application, May 9, 1904, which would still be "*before*" making the 10,000 lot in August or September, 1904. What evidence is there that any were made from opaque stock prior to May 9, 1904?

In answering Question 19, at page 125, Cohn claims that before he had left the Glass Company in October, 1903, he had "made up several envelopes by cutting out the blank with a pair of scissors and pasting it by hand"; and in answering Question 46, at page 138, he says that "I know that I showed them to Mr. Bean." On the next page and as an addition to his answers to Questions 21 and 22 and questions 45 and 46, at page 139, he says that "I am not positive that I retained these samples up to the time of the fire, and there is a possibility that I may have destroyed them before that date." If these samples were like the transparent stock envelope, "Complainant's Exhibit R," then, according to Cohn himself, they did not contain the invention of the two patents sued on. We asked him at page 177:

"X-Q. 142. Do you consider that the envelope Exhibit R, and the envelope described in your British patent and in your May 9, 1904, abandoned application, contains or embodies the invention described and claimed in your two patents sued on?

"A. I do not."

With the above admission and contention on the part of Cohn himself, we are prepared to see what kind of sample envelopes, if any, he had made prior to leaving the Glass Company in October, 1903, and to this end we will have recourse to the witnesses whom he called to show his early operations. We will see what each witness says.

The complainant's witness Selling, who was a salesman for the Glass Company and had been with them for more than twenty-three years, and who claimed that Cohn had talked with him about the matter, was shown the envelopes marked "Complainant's Exhibits L, M, O and R," and in question 10, at page 214, he was asked to "pick out from those an envelope which would correspond to anything you saw or understood from Mr. Cohn's description at that time to be his invention," and after examining the envelopes Selling said:

"This one here marked Exhibit R was shown me by Mr. Cohn and I recall even the printing thereon, at that time, this being the only one I recognize as having been shown me by Mr. Cohn when he was in our employ. The envelope Exhibit L was subsequently shown me by Mr. Cohn some little time after he went into the employ of Zellerbach & Sons [the Exhibit L was one of the 10,000 made in August or September, 1904, so that it was "some little time," indeed!]. The other two I do not recall ever having seen them."

"X-Q. 11. Do you mean that this envelope marked Exhibit R, or one like it, was the one shown you by Mr. Cohn while he was in the employ of the Glass Company?

"A. One similar to that."

"X-Q. 14. Do you have any letters, writing or other memorandums that enable you to fix the date when Mr. Cohn showed you this Exhibit L envelope?

"A. No, sir. However, I can recall where he mailed me one of those envelopes with the pickle design thereon, and had written a note therein asking me how I liked it."

"X-Q. 17. You speak of several hand samples that Mr. Cohn showed you. Were they like this envelope Exhibit R?

"A. Not in colors like that as I recall it.

"X-Q. 18. Were they like it in other respects?

"A. I should say yes."

"R-X Q. 32. When did you first see or Mr. Cohn show you envelopes with the windows or transparent portions in the shape of a pickle or cucumber or cigar?

"A. Short after leaving the employ of the Illinois-Pacific Company.

"R-X Q. 33. Did he show you such envelopes during the year 1904?

"A. Early part of 1904."

The above testimony of the witness Selling, even if given full credence, notwithstanding it depends upon the recollection of the witness only, unsupported by any writing or fixed memoranda, merely goes to the point of showing that Cohn made hand samples of envelopes like the envelope "Complainant's Exhibit R," which Cohn himself *repudiates* as containing or exemplifying the invention of either of the patents in suit, while in the employ of the Glass Company, and that the witness saw one of the pickle envelopes "shortly after leaving the employ of the Illinois Pacific Glass Company." Cohn says this was October 15, 1903, and Selling would have us believe that he saw one of the pickle envelopes "shortly" after that date. Yet Cohn in his long answer to question 9 says that he only conceived of the pickle envelopes "some time in the summer of 1904." The envelope Exhibit R was printed by Tooker *after* Cohn left the employ of the Glass Company, yet Selling recognizes it by "the printing thereon" as one he saw before he left—a palpable absurdity as the hand sample envelopes surely had no *printing* on them. No doubt the "hand samples" mentioned by the witness as like the Exhibit R were the ones Cohn cut out with the scissors before he left the Glass Company. If so, they were made of *transparent* material, and therefore, as Cohn claims, did not contain the invention of his first patent. This testimony is certainly lack-

ing in the certainty required in testimony sufficient to anticipate an anticipation as laid down in the decisions already quoted.

The next witness relied on by the complainant is the systems man from Chicago, B. T. Bean, whose business, in short, was to advise business concerns how to run their business. In question 8, at page 220, Bean was asked whether "during the time you have known Mr. Cohn has he ever claimed to you that he was the inventor of any particular style of an envelope or that he had any patents on the same," and in reply he said:

"A. At that time Mr. Cohn said that he wanted to show me something in confidence and as I was traveling all over the United States and knew more or less about business conditions and business practices, and that he had a new style envelope that he wanted to get my opinion on, and that he would show it to me in confidence, but did not want me to tell anyone about it. He then showed me some rather rough styles of envelopes that were translucent or transparent so that the address would show through the envelope, the writing being hidden by the rest of the paper which was opaque. It was after the style of an Outlook envelope, except that the opening was prepared by some process making it transparent. I remember that I told him that I had never seen anything like it before and that I thought it was a splendid thing, and I further thought that in my judgment there would be a good sale for that sort of an envelope.

"Q. 9. Can you describe with any more particularity the construction and appearance of the envelope Mr. Cohn showed you, and if you can please do so.

"A. As I remember the samples he showed me they were of rather rough construction and looked as if they had been made by hand. Some of the samples were flat, just blanks, treated with this preparation. The transparent part was surrounded by a sort of a border or cloud effect. I don't remember much about the samples in detail."

On cross-examination, at page 224, Bean was asked:

"X-Q. 20. Did you see Mr. Cohn after he left the employ of the Glass Company and during the year 1904?"

"A. I think I did."

"X-Q. 22. Did Mr. Cohn show you any of his envelopes during the year 1904?"

"A. I don't remember the exact times at which he showed me these envelopes during the years 1904, 1905 and 1906, but possibly two or three times during those years he spoke to me about the envelopes and showed me some I remember with advertising matter around the border."

In reference to the rough envelopes or blanks that Bean had mentioned in his answer to question 8, and which in his answer to question 12, at page 222, he thought were more like the envelopes "Exhibits N and O" with the cloud effect around the transparent portion, he was asked:

"X-Q. 26. Can you say as to whether or not they had any clouds in blue or in silver around the transparent portion?"

"A. I could not.

"X-Q. 27. Can you say positively that they had any border whatever around the transparent portion?"

"A. My memory is very vague as to the actual envelopes and papers submitted. I did not pay very much attention to the samples after the idea was given me."

"X-Q. 36. How did the paper of the blanks and envelopes which Mr. Cohn showed you correspond with the paper out of which this envelope R was made?"

"A. I don't remember."

From the above testimony it is plain that the witness Bean had no clear or definite idea as to what Cohn did show or disclose to him in the fall of 1903. He says that his memory is "very vague." He says that he "did not pay very much attention to the samples." He says that he cannot say whether they had "any clouds in blue or silver around the transparent portion." He says that he does not remember

whether the blanks and envelopes which he claims that Cohn showed him corresponded "with the paper out of which the envelope R was made"—the envelope made from transparent stock. He admits that Cohn showed him envelopes "during the years 1904, 1905 and 1906," and that possibly two or three times during these years "he spoke to me about the envelopes."

In view of the uncertain and vague character of his statements, the testimony of Bean certainly fails to establish the making of one-piece transparent window envelopes of *opaque* stock with borders around the transparent portions at the time of his talk with Cohn in the fall of 1903. In fact, Bean does not remember but that the blanks and envelopes which Cohn showed him were made out of transparent paper, *like* the envelope "R," which Cohn insists does not embody or realize the invention of either of his patents in suit.

The witness Vanderzweip, who was bookkeeper for the Zellerbach Paper Company, simply testifies, at page 232, to the use of the 10,000 envelopes made in August or September, 1904, and had nothing to say bearing on the question under consideration.

The witness Tooker, who was foreman for F. H. Abbott & Co., at which place Cohn says that "after October 15, 1903, all my printing was done," testifies that Cohn came to him and that he worked for and with him during holidays, Sundays and overtime on the envelopes. In answering question 6, at page 235, he says: "I was working on this process around the Holidays"—the Christmas Holidays of 1903—and he fixes upon this time because he says that "some of the money paid to me for my labor I used in buying presents." He says that, "We experimented in this matter for nearly a

year." He details the work and experiments that they did and made. He says that, "We had a great many difficulties to overcome, the main one being to get the desired transparency, which he finally succeeded in getting." He says that, "We finally got to the place where we could turn out these envelopes with the preparation covering the desired space and not spreading too far. He then gave an order for 10,000 of these envelopes to be printed, which I printed about September, 1904." He recognizes the envelopes "Exhibits L and M" as being a part of the 10,000 lot printed about September, 1904. Yet Selling in his endeavor to help Cohn carry the dates back says that Cohn showed him this Exhibit L "some little time" after Cohn entered the employ of Zellerbach & Sons—which was in October, 1903. In answer to question 23, at page 242, he recognizes the "Cremo Cigar" envelope "Exhibit FF" as a part of his work. It was made *after* he had adopted a piece of pulp board glued on the cylinder, and which he adopted, as stated in his answer to question 6, *after* they had "finally tried felt." He says, in answer to question 23, that this "Cremo Cigar" envelope "was one of the *first lots I printed* for Mr. Cohn, the exact date I cannot give, because we were simply working out this preparation of transparency"—and that required months. The "Cremo Cigar" envelope was therefore evidently made some time in the summer of 1904, and it "was one of the first lots."

Cohn first thought of making the window in the shape of a cigar or other article of manufacture, and utilizing the border for permanent advertising matter in the summer of 1904. In his long answer to Q. 9, he says:

"While working on various styles of envelope blanks I discovered that a good use could be made of the necessary border for the purpose of advertising, and I made a good many specimens of envelope blanks with borders carrying out this conception. I conceived this idea some time in the summer of 1904. To be more specific, I will

state that this border took on the general outline of a cigar, a pickle or cucumber, a cascade, and other well known articles."

If, therefore, the Cremo cigar "was one of the first lots" which Tooker printed for Mr. Cohn, then it must have been printed in the summer of 1904, because, according to Cohn's own statements, it was *not thought of* until "some time in the summer of 1904." The words "Patent Pending" on it, therefore, were printed after May 9, 1904, when Cohn filed his first application for a patent, and such words spoke the truth.

In answering question 25, at page 242, Tooker recognized the envelopes "Exhibits N and O" with the blue and silver cloud effects, as envelopes that he had printed. He says that, "The exact date I could not give" when he printed these two envelopes; but as the "Crema Cigar" envelope "was one of the *first* lots," these cloud effect envelopes "N and O" must have been printed *after* that one, and some time in the spring or summer of 1904. In answer to a very leading question, notwithstanding he had stated, in answer to question 23, that the "Crema Cigar" envelope "was one of the first lots," he fixes the Holidays of 1903 as the date when he first printed envelopes with a border. We will quote this question and answer:

"Q. 27. Do you know whether or not you had actually applied to an opaque sheet an oily preparation for making transparency for Mr. Cohn and used a border around this transparent space, for the purpose of an envelope, in 1903?

"Question objected to as leading.

"A. Yes, I would say that in those impressions that I made around the Holidays I used a preparation given me by Mr. Cohn, which made opaque paper transparent, but I don't say that it was the one printed like the cut the 10,000 was printed from, but that we had the transparency figured out at that time I am sure."

In answering question 31, at page 244, Tooker explains some of the difficulties that they had in making the oily preparation flow as freely as it should, and says: "It was necessary to use gas stoves under the press, heating the plate and making the preparation run out smoothly." He further says that, "The transparency that we reached in the earlier stages was inclined to be more dirty and mottled, not smooth. I am sure that around the Holidays of 1903 was the time when we first used the stoves, it being the winter time, and the preparation not having inclination at that time to flow freely."

We showed Tooker the envelope "Exhibit R" made from transparent stock and, at page 246, asked him:

"X-Q. 34. Do you recognize the printing on that envelope as some of your work?"

"A. I done some printing on paper of this kind for Mr. Cohn, but I cannot say that I printed that particular envelope."

In view of the above, it may very well have been that the printing which Tooker did for Cohn on or about the Christmas Holidays of 1903—if their experimental work had progressed to the printing stage—was on envelopes like "Exhibit R," which Cohn insists did not contain the invention of either of his patents in suit. Tooker says that he "done some printing on paper of this kind" and *nobody else* is shown to have done any.

The witness Epting, who was the artist for the Glass Company, says that he made some designs for Cohn before he left the employ of the Glass Company. In answer to question 8, at page 248, he says that he made quite a number of different designs, "some with shading around the edges and some with all the solid color in the back, and quite a number

of different ones, I don't remember all the different ones I did get up." In cross question 16, at page 249, he was shown the envelope "Exhibit R" made of transparent stock and in answer to the next question he says that he never saw any envelopes like the envelope "R" before seeing that one just shown him. In answer to cross-question 21, he says that he did some work for Cohn *after* he left the Glass Company. In answer to question 12, at page 249, he says that zincos were cut from the drawings with the cloud effect, like envelope "Exhibit N," but he does not say when he first saw an envelope made from the zinco.

The witness Dolge was simply called by the complainant to testify that he entered the employ of the Glass Company about October 15, 1903, and that he succeeded Cohn with that company. He gives no testimony whatever as to seeing envelopes or knowing about them.

The above gives the testimony of all the witnesses as to the earliest work done by Mr. Cohn in making envelopes. We think it plain that the first envelopes made by Cohn were made from transparent stock, like the envelope "Exhibit R." This is the envelope which he showed and described in his first application for a patent—his abandoned application filed May 9, 1904. All of the other envelopes appear to have been made at a later date, in all probability not until after the filing of his May 9, 1904, application. They all contain the words "Patent Pending" or "Pat. Applied For," which would be true if they were made after the filing of the abandoned application, in view of its broad and comprehensive claims, already quoted, but not true if made before that date. Some of them are identified by the witness Tooker, whose earliest work he claims was "around the Holidays"—the Christmas Holidays of 1903. As, however, he also worked in the making of envelopes from transparent stock, like the

envelope "Exhibit R," it is easy for him to have got the work on one confused with the work on the other. The probabilities are, as we insist, that no one-piece transparent envelopes, having the transparency formed by an oily preparation, and provided with a border around the transparency, were made until some time in the spring or summer of 1904—*after* May 9, 1904.

In view of the fact that the complainant has produced nothing whatever in the way of writings, memoranda and exhibits, or other matters that show that he made any one-piece envelopes having a transparent portion formed by an oily preparation with a border surrounding the same prior to January, 1904; in view of the fact that he was working on his transparent stock envelopes, like the envelope "Exhibit R," during the same time he claims to have been working on the envelopes of the patents sued on; in view of the fact that the witness Tooker, foreman of the Abbott Printing Company, identifies various of the envelope exhibits as having been printed by him *after* he began working for Cohn about the Christmas Holidays of 1903; in view of the fact, as he testifies, that he and Cohn were working on the matter for months to get the oily preparation so that it would make satisfactory transparent spaces; in view of the fact that all of the exhibit envelopes offered in evidence contain the words "Patent Pending" or "Pat. Applied For," and thus on their face raise the presumption that they were not produced until after the filing of the abandoned application, May 9, 1904; in view of the fact that although, as Cohn said in his last deposition, the time when he made the invention was "indelibly" impressed on his mind, yet in his first deposition he testified more than a dozen times that he could not give the date of the conception at the time his deposition was given; and in view of the liability of witnesses who have seen or worked on the

different kinds of envelopes--those made from transparent stock and those like the patents in suit—to confuse the one kind with the other, particularly when, as the witness Bean testifies, his recollection is “very vague,” and that he paid little attention to the details, we submit and insist that the testimony on behalf of the complainant is insufficient to anticipate the clear anticipation afforded by the January, 1904, envelopes established by the proofs on behalf of the defendant.

As said by Judge Coxe in *Thayer v. Hart*, 20 Fed., 693: “The rule in such cases is very strict. It is so easy to fabricate or color evidence of prior invention and so difficult to contradict it, that proof has been required which does not admit of reasonable doubt,” or as said by Judge Hazel, in *Westinghouse Electric & Mfg. Co. v. Mutual Life Ins. Co.*, 129 Fed., 216: “The burden is upon the complainant, under the circumstances to establish by clear, unequivocal, and convincing proof, that the anticipation has been anticipated;” or as said by Judge Putnam, in the *Eastern Paper Bag Co. v. Continental Paper Bag Co.*, 142 Fed., 501: “The proofs offered by the respondent in regard to the defense brought in by the amendment are not supported by a *scrap* of anything relating to the substance of the events *contemporaneous* with them. None of the witnesses had had occasion to consider the occurrences during a period of more than *seven* years;” or as said by the Circuit Court of Appeals for the First Circuit, Judges Colt, Putnam and Webb, in *Brooks v. Sacks*, 81 Fed., 405, in holding the complainant’s testimony insufficient to anticipate an anticipation: “The whole case, in this respect, depends on the *unsupported recollections* of witnesses as to facts and dates fully six years prior to giving testimony, and facts, moreover, of a *kindred character* to other facts occurring at or near the same time, with which they might be confused. Not only is this important as bearing on the weight

of their testimony, but, under the circumstances of this case, the fact that the testimony is thus unsupported is an affirmative one against the complainant below of very great importance;” or as said by the Supreme Court in *The Barbed Wire Patent Case*, 143 U. S., 284, in considering oral testimony to establish an anticipation: “In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, courts have not only imposed upon the defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory and beyond a reasonable doubt.”

In view of all the foregoing, we submit that the complainant has not anticipated the anticipation established by the January, 1904, envelopes, produced on behalf of the defendant, and that, aside from any other defense, the first Cohn patent should be held to be invalid because of anticipation.

The Second Cohn Patent.

The second Cohn patent was applied for January 17, 1905, as a division of the original application filed November 8, 1904, on which the first Cohn patent was issued. The drawings of the second Cohn patent are simply a reproduction of Figures 3 and 4 of the first patent. The specification is in many respects the same as in the first patent. The difference between the two patents consists in the *shape of the window* in the second patent, and the printing of certain permanent advertising matter *on the face* of the envelope, in juxtaposition to the window and co-operating with its outline to indicate a particular brand of goods. In the specification of his second patent, at page 691, Cohn says:

“In carrying out my invention I take a blank sheet of

paper or an envelope-blank of suitable strength and texture which is, say, semi-transparent and apply to a portion of one side of the blank, generally on the inside, a preparation which has the property of rendering transparent the portion to which it is applied. The remaining portion of the blank which forms the face of the unfinished envelope *a* is then imprinted with a suitable opaque coloring matter."

In his second patent, as in his first, Cohn says that

"This coloring matter may be applied *solid over the face* of the envelope, or it may take the form of graduated tints or of being shaded, or the representation of a surrounding border, or cloud effect."

In the second Cohn patent, therefore, as in the first, the "border" mentioned in the claims may cover either a narrow ring around the window, or it may include the *entire surface* of the face of the envelope outside of the transparent portion or window. We call particular attention to his, as we did in considering the first Cohn patent, as borders are shown in some of the prior patents which cover the envelope or paper to which they are applied from the edges of the transparent window to the edges of the envelope or paper.

The idea described and illustrated in the second Cohn patent is to make the *window*—the transparent portion of the envelope—in the *shape* of a trade-mark, design, or other article of trade. The specification says that:

"The number of shapes this transparency may take is almost limitless. Different people might use an envelope with a window in the shape of an oyster, a fish, a cake of soap, and other toilet articles, a cascade, a dress-shield, a biscuit, an article of hardware, and other articles of manufacture, and so on indefinitely, having due regard for the necessary size of the transparency, so as not in any way to interfere with the clear showing up of the addressee's name inside. The essential feature

in this connection is a window which in general outline is characteristic of a symbol of trade. By 'symbol of trade' is meant any design such as mentioned above or trade-mark characteristic of certain goods or the product of a certain manufactory."

It is to be noted that it is the *window* or transparency which is to resemble the trade-mark or article of trade. He says that "The number of *shapes* this *transparency* may take is almost limitless"; and again he says that "The essential feature in this connection is a *window* which in general *outline* is characteristic of a symbol of trade." Indeed, it *must* be the window—the transparency itself—which resembles the trade-mark or article of manufacture, as *otherwise* when the coloring matter is "applied *solid over the face* of the envelope," as he says it may be, there would be *nothing else* to indicate the trade-mark or article of manufacture—the trade-mark or article of manufacture would *wholly disappear and leave nothing to indicate it*.

To supplement and accentuate the trade-mark or article of manufacture represented by the outline of the window, Cohn proposes to have some permanent advertising matter, and in his claims he says that this permanent advertising matter "appears on said tinted border," and that it "relates to and is in juxtaposition with the outline of said window." He describes the permanent advertising matter as located *on* the border—not *in* the transparent window—but *on the face* of the envelope—on the *border*—in juxtaposition with the outline of the transparent portion or window.

The two claims of the second Cohn patent are expressly limited to a *window* which is in the *form or outline* of some trade-mark, or article of manufacture, and which has the advertising matter permanently located on the *border* or face

of the envelop surrounding the window. The claims, at page 692, read:

"1. An advertising device comprising an envelope having a window through which the addressee's name on an inclosure may show through, said window being in outline characteristic of some symbol of trade, a tinted or colored border surrounding and giving definition to said window and permanent advertising matter forming no part of the address, appearing on said tinted border, and related to and in juxtaposition with the outline of said window."

"2. As an advertising device, an envelope having a generally opaque face except for a transparent window portion through which an addressee's name on an inclosure may show through, said window being in general outline characteristic of a symbol of trade, and permanent printed matter on the face of the envelope related to and in juxtaposition with the outline of the window and co-operating with said outline to indicate a particular brand of goods."

It will be noted that both of the claims require the *window* itself—the *transparent* portion—to be in outline characteristic of some symbol of trade, and that there shall be permanent advertising matter appearing *on* the tinted border—not *within* the transparent window—but “on said tinted border,” to use the language of the first claim. The gauge is plain, explicit, and not to be misunderstood. It is not the *border*, which is to be in outline characteristic of some symbol of trade, but the window itself, as otherwise the symbol of trade would *be covered up and disappear* if the border covered the entire face of the envelope. As already pointed out, it would not be possible, unless the *window itself* were in outline characteristic of some symbol of trade, to extend the border of coloring matter entirely from the window to the edges of the envelope, or to apply it “solid over the face of the envelope” and have anything left in the form of a symbol of trade, or of an article of manufacture. Hence,

Cohn, in the claims of his second patent, meant, and intended to mean, that it was the window itself—the transparent portion—that was to have the *form* of an article of manufacture, or to be “in outline characteristic of some symbol of trade.”

No Invention in the Second Cohn Patent Over the First and Over the State of the Art.

In his first patent, Cohn has shown, described and claimed, a one-piece transparent-window envelope. His second patent merely modifies the form or shape of the window, so as to make it correspond to some article of manufacture, and has used in connection with it permanent advertising matter. He takes the *envelope* of his first patent and *changes* the *form* of the window, and prints some advertising matter on the face of the envelope. It was old to make the transparent windows of envelopes of *various* forms, and it was old to print permanent *advertising* matter on the face of the envelope. Cohn simply took the envelope of his first patent and did these two old and well known things to it—made the window in the form of some symbol of trade, and printed advertising matter on the border or face of the envelope.

It is true that the second Cohn patent was issued on an application divided out from the application for the first patent, so that technically neither patent is to be considered as a part of the prior art with respect to the other. This, however, is aside from the point we make in comparing the second patent with the first, which is that as the first patent covers, and was intended to cover, a certain kind of envelope, it is proper to consider the matter claimed in it and in the second patent to determine whether there is *patentable difference or invention* between the subject-matter of the second patent and that of the first. In other words, did the change or improvement made in the envelope of the second

patent constitute invention over the envelope claimed in the first patent? Manifestly, if the claims of the two patents were literally and *verbatim* the same, no invention would be involved in the claim of the second patent over the claim of the first patent. As they are not literally and *verbatim* the same, it is competent for the court to consider whether the *differences* in the claims of the second patent over the claim of the first patent constituted patentable invention. If there be no *invention* or patentable difference between the claims of the second patent over the claim of the first patent, then, manifestly, the claims of the second patent are invalid, as much as if they had been a literal repetition of the claim of the first patent.

The Proceedings in the Patent Office.

When Cohn, on January 17, 1905, filed his application on which his second patent issued, he presented two claims to the Patent Office, as printed at page 624. On March 20, 1905, the Examiner wrote him a letter rejecting his claims on the Watts 1895 British patent No. 7,955, and on the Busch 1896 British patent No. 11,876, and among other things, at page 627, said:

“The first shows that it is old to make the transparent openings in envelopes of various configurations and designs; while the Busch reference discloses applicant’s specific construction so far as defined by the claims.”

Thereupon, and on May 5, 1905, Cohn amended his claims by calling for “permanent” advertising matter and the words requiring the advertising matter to be “in juxtaposition” with the outline of the window, and presented an argument in favor of the patentability of the claims, among other things, at page 628, saying:

“We are not claiming an envelope with a transparent

opening, but we are claiming an opening of a particular kind which serves not only the function of the window of Busch but is also descriptive of some known article of trade. Thus we convert Busch's address window into a valuable advertising feature while preserving all that Busch can possibly claim for his window. We thus obtain a new result since we obtain a valuable advertising advantage without detracting from the view of the addressee's name. But this alone is not sufficient and is not only what our claims call for. The point that must be kept in mind all the time is the COMBINATION of the PECULIARLY SHAPED window and the correlative permanent printed matter on the envelope explanatory of and in juxtaposition with the said opening. For instance, a cigar shaped window has no especial significance but when the word 'Primo' or 'Blanco' or some other suitable trade name is printed on the face of the envelope in juxtaposition with the window opening, the entire design has a special significance, for the arrangement considered as a whole presents a novel and useful way of expressing some well known name or trade-mark."

It will be noted that in the above argument, intended to bring out the peculiar and identifying characteristics of the envelope of the second Cohn patent, Cohn states that he is claiming "an opening of a particular kind," which *opening* not only serves the function of the *window* of the Busch envelope, but "is also *descriptive* of some known article of trade." He says that he converts "Busch's address window into a valuable advertising feature." He says that in this way he obtains a new result, since he secures "a valuable advertising advantage without detracting from the view of the addressee's name." He says that the point must be kept in mind all the time that it is the combination "of the PECULIARLY SHAPED window"—and to give emphasis to this he uses capital letters—and the permanent printed matter on the envelope in juxtaposition to the opening. These statements clearly show that it was Cohn's window—the *transparent portion* itself—that he intended to have in the form of some

symbol of trade or article of manufacture, and not the surrounding border.

Afterwards, and on May 25, 1905, the Office again rejected the claims and, on page 630, cited the Cohn 1904 British patent No. 14,478. In answer to this rejection Cohn, after waiting some nine months, on February 21, 1906, again wrote to the Office and, on page 630, asked for a reconsideration and final action, with a view to an appeal. Thereupon, and on March 2, 1906, the Examiner wrote Cohn again, page 631, citing the Brown 1862, and the Callahan 1902 patent, and on March 13, 1906, Cohn wrote a letter to the Patent Office, page 632, expressing surprise that the Examiner should have cited the Cohn 1904 British patent, and among other things, the italics being ours, said:

“We really wonder that the Examiner will cite such a patent for claims which are for such matter as ‘said *window* being in *outline* characteristic of some symbol of trade, a tinted or colored border surrounding and giving definition to said *window* and permanent advertising matter forming no part of the address, appearing *on* said tinted border, and in juxtaposition with and related to the outline of said *window*.’ Not one of these features appears in applicant’s British patent cited, and we wonder that said patent is seriously considered as a reference for our claims.”

In the meantime, however, and on February 28, 1906, an appeal had been taken to the Board of Examiners-in-Chief, page 637, and on March 22, 1906, the Examiner filed his written reasons for rejection before the Board, and among other things, on page 639, the italics being ours, said:

“The mechanical structure of applicant’s envelope may be stated briefly to be an envelope having a transparent portion or window in its front surrounded by an opaque border formed by the application of coloring matter. This structure is clearly disclosed by the British patent to Cohn and Shipp. The limitations in the claims

to the *shape or contour* of the *transparent portion or window*, and to the advertising or printed matter placed upon the colored border cannot add any patentability to the claim. After an envelope has been provided with a transparent window surrounded with an opaque colored border, it is within the province of any mechanic or artisan to change the *shape or contour* of the *transparent window* to suit his own taste, without invention. The patent to Cohn and Shipp shows a variety of shapes for the windows. The printed matter upon the envelope likewise can add no patentability to the structure. This doctrine is well settled in the following decisions: *Ex parte Lee*, 18 O. G., 624, and *ex parte Mosler*, 118 O. G., 590.

“The British patent to Busch discloses an envelope having in its front portion a transparent window surrounded by an opaque border preferably made by printing with opaque coloring matter. This is applicant’s exact structure aside from the particular *shape or design* of the *window* and the advertising or printed matter on the envelope. As above stated, this particular design or the printed or advertising matter cannot add patentability to a structure otherwise old.”

It will be noted that the Examiner speaks of “the limitations in the claims to the shape or contour of the transparent portion or window.” Again he says that “it is within the province of any mechanic or artisan to change the shape or contour of the transparent window to suit his own taste.” Again he says that the Busch patent shows Cohn’s exact structure, “aside from the particular shape or design of the window,” and the advertising or printed matter on the envelope. These statements show that it was the *understanding* of the Office that the *window* itself was to be in *outline* characteristic of some symbol of trade or article of manufacture.

In reply to the Examiner’s statement Cohn filed a brief or argument before the Board of Examiners-in-Chief. After referring to his other appeal that was then pending before

the Board, Cohn, among other things, at page 643, the italics being ours, said:

"Applicant has conceived the very useful idea of giving to the *transparent window* an *outline* characteristic of a symbol of trade, and he associates with this *specific symbol* permanent advertising matter which forms no part of the address but is so related to and in juxtaposition with the *specific form* of window as to instantly convey to the public a particular brand of goods, thus adapting the envelope as a novel and valuable advertising medium, in addition to its function as an inclosure for a letter.

"To give the *window* any *old shape* and without any regard to the character of the permanent printed matter, or to employ printed matter which is not related to or fails to explain the *form* of the *window* would serve no useful purpose, and therefore the invention is in the combination in the envelope of a window which by itself means substantially nothing of value as an advertising feature but which when viewed in connection with permanent printed matter, related to and in juxtaposition with the window, explains the symbol of trade which the *window* is designed to describe. As a good example of this, take a window in the form of an elongated oval. Such a window would have little, if any, meaning to the public; but print adjacent to such a window the word 'Perfecto' or 'Cremo' or 'LaGato' or the name of some other well known brand of cigars, and how soon a smoker of such brand would associate in his mind the otherwise meaningless symbol and otherwise more or less meaningless word.

"Thus the novelty of this case lies in the addition to the novel features of the companion case, of the '*window* in *outline* characteristic of some symbol of trade' and 'permanent printed matter on the *face of the envelope* related to and in juxtaposition with the *outline* of the *window* and co-operating with said outline to indicate a particular brand of goods.' These qualities in this structure make the new and useful 'advertising device' claimed.

"It must be remembered that the permanent printed matter does not obscure or interfere with the window and the address to show therethrough, nor will it inter-

fere or necessarily be related to a name card on the envelope.

“Neither of the references cited, namely, applicant’s British patent or the British patent to Busch, shows (1) an advertising *symbol* of any character, which enables the *window* to have a *double* function, or (2) any printed matter ‘related to and in juxtaposition with’ the *window outline* ‘to indicate (therewith) a particular brand of goods’ and for this reason we submit that there is an invention involved, and that the Examiner is in error in refusing the claims as not patentable over the art cited.”

The Board of Examiners-in-Chief, on April 13, 1906, filed their written opinion, in which they concluded that the claims were allowable because of the peculiar *form or contour* of the window or transparency itself, showing or illustrating an article of manufacture or symbol of trade which was not shown in the Cohn and Shipp and Busch British patents, which merely showed a variety of different forms in which the window could be made, as rectangular, oval, diamond-shaped, etc. In their opinion, among other things, the italics being ours, after citing the two British patents, at page 646, they selected the Cohn and Shipp patent as the preferable reference, saying:

“Of these two patents, British No. 14,478 is the more pertinent. That patent describes an envelope having a window through which the addressee’s name on an inclosure may show, said window being ‘oval, rectangular, diamond-shaped, or fancifully bordered’ in outline and having a tinted or colored border surrounding and giving distinction to said window, or, as the specification of the patent puts it (p. 2, lines 10, 11) ‘the finished envelope gives the effect of a transparent, light colored area on an opaque, dark colored background.’ The patent also suggests having transparent letters as in Figure 5 and lettering ‘Boots and Shoes’ thus referring to the business of the sender.

“The applicant in this case before us has carried the idea of this patent a little further by making the *fanciful shaped opening* in the shape of a pickle, cigar, or other

symbol of trade, and instead of merely referring to the business has used some other advertising matter associated with the article *whose form has been given to the window or opening*. This idea appears to us to be inventive in character and the claims may accordingly be allowed."

After the decision of the Board of Examiners-in-Chief, the Examiner again, and on April 27, 1906, wrote to Cohn, page 634, requiring that Figure 1 of the drawings "be eliminated as not being covered by the claims, such figure not showing a *window* having a general *outline* of a symbol of trade."

Figure 1 referred to by the Examiner above was substantially—indeed practically precisely—the same as Figure 1 appearing in the first Cohn patent.

Thereupon, and on May 2, 1906, Cohn wrote the Office canceling Figure 1 of the drawings, but declining to cancel Figure 2, which the Examiner had also suggested should be canceled, as well as Figure 1, saying, at page 635, in declining to cancel Figure 2:

"In original Figure 2 the pickle shaped window—and the Examiner seems to readily recognize the shape—is representative of an article of trade."

Thereupon, and on May 11, 1906, the application was passed to issue, and on July 3, 1906, the patent came out.

It will be noted that in the above, the last communication to the Office in reference to the matter, Cohn speaks of the "pickle-shaped window"—the window or transparency itself—as representative of an article of trade.

In view of all the foregoing, we submit that it is plain that throughout the entire proceedings in the Patent Office, Cohn

on the one hand, and the Office, representing the public, on the other, understood and considered that it was the *window* itself, and not the border, which was to be in the form of an article of manufacture, or trade-mark, or symbol of trade. Both parties to the contract understood and accepted it as being limited to an envelope in which the transparent portion or window, and not something else on the envelope, was to be in outline characteristic of some symbol of trade.

In the investigation into the state of the art in this case, the defendant discovered an English patent issued in 1897 that showed *the very thing that was lacking*, and on the *lack* of which Cohn urged the patentability of his envelope, and on the *lack* of which the Board of Examiners-in-Chief concluded that he was entitled to his patent. This was the Boldt 1897 English patent No. 29,956, page 718, which was brought into the matter for the first time by the defendant in this case, and which removes every vestige of novelty in the window on which the patent was granted. The Boldt 1897 English patent shows and describes an inclosing case or receptacle—"packet, wrapper, envelope, or whatever it may be termed"—to use the words of the patent—for containing small articles, such as hooks and eyes, pins, and similar things, in which the drawings represent six or seven different shaped, transparent window openings. The specification, at page 718, says, among other things:

"More than one of these *openings* protected by transparent material may be used and they may be of any *desired shape or size or pattern*. For example, they may be made to represent the initials of the firm selling them or may otherwise be utilized for *advertisement purposes, trade-marks, or the like*."

Again, in describing the drawings, the specification says:

"In Figure 8 the opening B is shown cut to the shape of the letter N which might represent that the package

contained needles. Or the letter might be chosen to indicate the name of the maker or the full name might be so set forth. The same purpose may be effected by painting or embossing or otherwise delineating a trade-mark or a name or other symbol or device upon the transparent covering as indicated in Figure 9.

"Any design or symbol for the purpose of identification or advertisement or other purpose may be conveniently set forth on the transparent covering C."

It will be seen from the above quotation that Boldt contemplated two ways of displaying his trade-mark or symbol of trade. The first of these ways was by making the *window itself* of a shape or contour to represent the article of manufacture, or by imprinting or otherwise displaying the trade-mark or symbol *upon* the transparency itself. The third and fourth claims of the Boldt patent claimed both of these ways of displaying the trade-mark or symbol of trade. They read:

"3. A windowed envelope or wrapper having one or more openings such as B closed by transparent material representing one or more letters, trade-marks or devices.

"4. A windowed envelope or wrapper having one or more letters, trade-marks or devices delineated on the window."

The Boldt 1897 English patent shows it was old to make packets or envelopes containing transparent portions or windows in the shape, figure, contour, or outline of an article of manufacture or symbol of trade. This was done, so the specification tells us, for *advertising* purposes. If this Boldt 1897 English patent had been discovered by the Examiner and had been before the Board of Examiners-in-Chief, it is plain that they would never have recommended the issuance of the second Cohn patent. The only thing, and everything, that can possibly be said to be left in the Cohn claims after the Boldt English patent was discovered, was the printing of permanent advertising matter on the face of the envelope

outside of the window or opening, and the printing of permanent advertising matter on envelopes has been used generally, as the evidence shows, for forty years or more. No doubt such permanent advertising matter has been used on envelopes practically ever since they were introduced into use. The advertising matter printed on envelopes is always located or placed so as not to interfere with displaying or showing the name of the addressee to whom the letter is being sent. Samples of such envelopes were shown as illustrations at page 316 of the typewritten Record.

Indeed, if the claims of the Cohn patent be stretched to cover such an envelope as those used by the defendant and charged to infringe—an envelope in which the alleged permanent advertising matter appears *through* the transparent opening or window itself, as does the word “Heinz”—then the Boldt 1897 English patent describes and discloses the advertising matter, as well as the window or transparent opening in the form or outline of an article of manufacture or symbol of trade.

The Boldt patent says that the purpose or object may be effected by painting, or embossing, or otherwise “delineating a trade-mark or a name or other symbol or device upon the transparent covering as indicated in Figure 9,” and the fourth claim says that there may be “one or more letters, trade-marks or devices delineated on the window.” In the envelopes used by the defendant, the word “Heinz” is printed on the inside back of the envelope, so that it appears through the transparent window when the receiver removes the letter. In effect, it is “delineated” on the transparent window.

The defendant’s expert, Mr. Bond, in answering questions 62 and 63, at page 503, says that the defendant’s envelopes more nearly resemble the Boldt patent than they do the Cohn

patent by "delineating the trade-mark or device so as to appear on the transparent material." It follows, therefore, that if the Cohn claims be stretched to cover the defendant's envelope they likewise cover the envelope of the prior Boldt 1897 patent, so as to be invalidated by it. This grows out of the familiar principle announced in many cases, as, for instance, by the Supreme Court in the case of *Miller v. Eagle Mfg. Company*, 151 U. S., 203, where they say: "That which infringes if later anticipates if earlier." Hence, the claims of the Cohn patent are fully anticipated and invalidated by the disclosure of the Boldt 1897 English patent, if they be construed to cover envelopes in which the permanent advertising matter is made to appear *upon or through* the transparent window, instead of being restricted to a location *on the border or face* of the envelope itself, as the claims call for.

No Infringement of the Second Cohn Patent.

We have already pointed out at length and in detail the limitations and requirements of the two claims of the second Cohn patent, to determine exactly what it was that Cohn desired to claim and what the Office understood he was being given by his patent; and have found that the claims are limited to an envelope in which the *window or transparent portion* itself is made in the shape, contour, or outline of an article of manufacture, or some symbol of trade, with permanent advertising matter placed or printed *on the border or face* of the envelope itself, to assist and supplement the shape of the article represented by the form and contour of the window. We insist that the claims are to be understood as suggested above, and that they must be so understood in order to ascertain and give effect to the *intention* of the parties to the instrument, which is the thing which is always to be ascertained and effectuated in the construction of patents, as well as other contracts, if possible. As said by the Circuit Court

of Appeals for the Eighth Circuit, Judges Sanborn, Van De-
vanter and Hook, in the case of the *Jewell Filter Company v.*
Jackson, 140 Fed., 343:

“The rules for the construction of contracts apply with equal force to the interpretation of patents. The great desideratum here, as there, is to ascertain and give effect to the *intention* of the parties to the contract when they made it.”

The court also said that,

“When the terms of a patent are plain and the *intention* of the parties is manifest, the latter must prevail, and there is no room for construction.”

In view of the above considerations and of the settled principles of law that must be applied, we think it is plain that the defendant's envelopes do not respond to the requirements of the claims and that there is no infringement.

The defendant's envelopes are made by the manufacturer with the *window* or opening of the *exact size and shape* that they are made in the regular or stock envelopes made and sold generally, of which one was introduced at typewritten page 5 of the Defendant's Record. The same plate is used for applying the oily preparation for making the window in the Heinz envelope as in the stock envelopes. The *window* or transparent portion in the defendant's envelopes is not *in the shape* or configuration of *any* article of manufacture or symbol of trade. The *border* surrounding the window is in the form of a cucumber or pickle, but it is not the form of the *border* which, by the express terms of the claims of the second Cohn patent, is *required* to be in the form of a symbol of trade. The public is at liberty to make the *border* in the form of an article of manufacture or symbol of trade, or of any shape desired, so far as the *claims* of the second Cohn patent are concerned. Indeed, as we have already pointed

out, the *border*, according to the statements of the patent, may be extended from the *edges of the window to the edges* of the envelope, and still leave the *window* in the form or contour of the shape of an article of manufacture or symbol of trade, but if the border in the *defendant's* envelopes were extended from the edges of the window to the edges of the envelope, as the second Cohn patent provides that they may be, there would be *nothing whatever left* on the defendant's envelopes in *outline characteristic* of some symbol of trade. There would only be left the *regular* window or transparent portion of the stock or regular envelopes. To be the envelope of the patent, the defendant's envelopes must be capable of the same peculiarities of construction and use.

Furthermore, in the case of defendant's envelopes, a change in the shape of the window, or even the entire elimination of the transparent window portion, would not in any way change or alter the character of the border outline, which, in any event, would present the configuration of a cucumber. As a matter of fact, the presence of defendant's transparent *window* of conventional shape, formed within a border having the outline of a pickle, *detracts from* rather than *adds to* the suggestive character of the trade symbol. It introduces a foreign element or factor into the very *body* of what would *otherwise* constitute a perfect representation of a pickle. This simply indicates beyond question that defendant's *window* itself has nothing whatever to do with the *indication* of a symbol of trade. Cohn chose to impose an *additional* and *peculiar* function *on the window*, and thereupon, and for that reason, and for that reason alone, he obtained his patent, but defendant's *window* does not even *assist* in the performance of that function.

It is equally plain that the defendant's envelopes do not contain any permanent advertising matter printed either *on*

the tinted border or on the face of the envelope, as required by the claims of the second Cohn patent. 'The only thing that is printed on the face of the envelopes is the ordinary and usual return request, which is not the advertising matter contemplated and required by the Cohn patent. The only other place where the word "Heinz" appears is through the transparent window opening. It is printed on the inside of the back of the envelope, so that when the letter is removed it appears through and in the center of the transparent window. The word "Heinz" was placed in that position, as explained by Mr. Regenstein, in answering cross-question 159, at page 299, because the Heinz Company always uses the word "Heinz" printed or placed *on* the body of their pickles. As said by Mr. Regenstein, "The trade-mark of the Heinz Company represents a pickle which shows the word 'Heinz' *on the pickle*;" and as further said by him, "The only way Heinz would accept the envelope was to show the word 'Heinz' the same as it appears *on* the trade-mark." But printing the word "Heinz" on the *back of the envelope* is not printing it where Cohn in his patent and in his claims located and required the permanent advertising matter to be placed. It is not on the *tinted border*, and it is not on *the face of the envelope*, nor is it placed "in juxtaposition with the outline of said window," as required by the claims of the Cohn patent. Hence, it is not the arrangement which Cohn *segregated and selected from all other arrangements*, and in which he asked the protection of his patent.

Furthermore, in using the word "Heinz" where it appears *through* or in effect on the transparent portion or window itself, the defendant's envelopes substantially follow and employ one of the ways for using the word or name described and disclosed by the Boldt 1897 English patent, where he says that the same purpose may be effected by painting or otherwise "delineating a trade-mark or name or other symbol or

device upon the transparent covering"; and, again, in the fourth claim, he calls for "A windowed envelope or wrapper having one or more letters, trade-marks or devices delineated on the window." The defendant's envelopes substantially follow and employ the second method *described and disclosed* in the Boldt 1897 English patent, instead of the method described and disclosed and claimed in the second Cohn patent. As already suggested, that which would *infringe* will operate to *anticipate* if prior in date to the patent sued on. It follows, therefore, that, in attempting to hold the defendant's envelope as an infringement of the second Cohn patent, the *prior* similar arrangement disclosed in the Boldt 1897 patent must operate as an anticipation. The Cohn claims cannot cover or interfere with forms and arrangements which were disclosed to and in the possession of the public for years prior to the application for the Cohn patent.

For the reason, therefore, that the defendant's envelopes do not have the transparent portion or *window itself* in the form or configuration of an article of manufacture, and "in outline characteristic of some symbol of trade," and for the reason that they do not have permanent advertising matter either on the *border* surrounding the window or envelope, or on the *face* of the envelope itself, all of which are required by the claims of the Cohn patent, the defendant's envelopes do not contain, embody, or employ the particular arrangement of devices which Cohn claimed as his own, and for which he sought protection through his second patent.

If it be contended, on behalf of the complainant, that the defendant's envelopes are an infringement of the claims of the second Cohn patent, on the ground that as an advertising device they accomplish the same purpose and secure the same result, then we reply that equivalency in result is not determinative of the question of infringement. This has been

established by the decisions of the Supreme Court for half a century or more.

In *Burr v. Duryea*, 1 Wall., 572, the Supreme Court said:

“That two machines produce the same effect, will not justify the assertion that they are substantially the same, or that the devices used by one are, therefore, mere equivalents for those of the other.”

Again, on page 373 of the report, the Supreme Court said:

“The argument to show infringement assumes that every combination of devices in a machine which is used to produce the same effect, is necessarily an equivalent for any other combination used for the same purpose. This is a flagrant abuse of the term equivalent.”

Again, on the same page, the Supreme Court said:

“It has been argued, that though not a colorable invasion of the patentee’s claim it is an evasion of its patent, which is equally injurious. If so, it is *damnum absque injuria*. Every man has a right to make an improvement in a machine, and evade a previous patent, provided he does not invade the rights of the patentee.”

In order to infringe a patent, three things are to be taken into consideration—the means, the mode, and the result. As said by Judge Morrow, of California, in *American Can Co. v. Hickmett Asparagus Co.*, 137 Fed., 90:

“To sustain a claim of infringement three things must be found: First, identity of result; second, identity of means; third, identity of operation.”

Or, as said by Judge Reed in *American Steel & Wire Co. v. Denning Wire & Fence Co.*, 176 Fed., 565:

“To sustain the charge of infringement of a patented machine the infringing machine must be substantially identical with the one alleged to be infringed in (1) the

result attained; (2) the means of obtaining that result; and (3) the manner in which its different mechanisms operate and co operate to produce that result. If the machines are substantially different in either of these respects, the charge of infringement is not sustained."

To constitute an infringement of the claims of the second Cohn patent, it is necessary to show that the patented envelopes and the defendant's envelopes, as advertising devices, are substantially identical in their means, their mode of operation, and their results. The *windows* must be substantially alike—they must both be, in form or contour, in *outline characteristic* of a symbol of trade, irrespective of the form or contour of the border. The permanent advertising matter must be located in both envelopes substantially alike—on the *tinted border* or *on the face* of the envelope. The result attained must be the same in both envelopes—the *shape* or contour of the *window* must *indicate* the article of manufacture, *even though* the border extend from *the edges of the window* to the *edges of the envelope*, which result cannot be attained in the defendant's envelope if the border were so extended. The patented envelope and the defendant's envelope are not alike, therefore, either in the window, the printed advertising matter, or the results which they are capable of *attaining*.

Furthermore, it must be borne in mind that the proofs as to infringement must be so strong and sufficient as to overcome the legal presumption of innocence, beyond a reasonable doubt. The infringement of a patent is a trespass or tort and the law presumes no wrong. If on the whole case the court has doubts on the question of *infringement*, such doubts must be resolved in favor of the defendant. Courts do not take a defendant's money or property and give it to a complainant, or interfere with his business, if they have any reasonable *doubt* on the question of infringement. This is

ancient law established in the beginning of patent suits. As said by Justice McLean before any of us were born, in considering the question of infringement, in *Brooks v. Bicknell*, 3 McLean, 432:

“The proof here devolves on the plaintiffs. They allege that the defendants have infringed their rights, and to obtain your verdict they must show it. Doubts under this head will incline you favorably to the defendants, as they are not to be deprived of a right which is common to every citizen, unless it shall clearly appear that their machine is substantially like the one claimed by Woodworth.”

If, therefore, upon weighing the various considerations urged in favor of infringement and against infringement, the court have doubt on the subject, it must resolve such doubt in favor of the defendant and hold that no infringement is established.

The Unauthorized Admission as to Infringement.

It is contended, however, on the part of the complainant, that during the taking of the *prima facie* testimony, on November 3, 1910, defendant's counsel, who was in attendance, admitted and conceded that the defendant's envelope contained the subject-matter of the first claim of the second Cohn patent. It is true that during the complainant's *prima facie* testimony, Mr. Sullivan, the local solicitor that we got to represent the defendant in San Francisco, made a concession that appears to justify such contention, so far as the first claim is concerned. This concession, however, was made inadvertently and *contrary to the express instructions and directions* given to Mr. Sullivan in a letter from ourselves, dated October 11, 1910, and quoted in the Defendant's Record at page 480. In that letter, after requesting Mr. Sullivan to attend on the part of the defendant, we said:

"We presume that all Mr. Townsend will do in making his *prima facie* will be to offer the patents in evidence, samples of the envelopes, and examine an expert to testify to the similarities between the envelopes and the patents.

"Do not admit infringement, as we think there is no infringement—particularly of the *second* Cohn patent. Simply admit the fact of use, but make no admission that such use *infringes* the Cohn patents."

Immediately upon receipt of a copy of the testimony taken on *prima facie*, we wrote Mr. Sullivan calling attention to the error into which he had fallen, and he immediately, and on November 23, 1910, served a notice on complainant's counsel, which was quoted into the Defendant's Record, at page 483, in which he withdrew the admission made during the taking of the *prima facie* testimony. In this *Retrahit* we offered to permit complainant to proceed further with the examination of the witness on the stand at the time the admission was made, offered to waive all objections to the further examination of the witness growing out of the fact that the time for taking the *prima facie* testimony had expired, and further, offered "to pay any and all costs necessary and incident to the further examination of the said witness." This was done so as to place the complainant in a position where he could not possibly claim that he had been prejudiced or injured in any way by the inadvertent admission made by Mr. Sullivan. At that time no testimony whatever had been taken on the part of the defendant, and, as the court can see, in view of the prompt withdrawal of the admission, and notice and offer on the part of the defendant, no injury or prejudice whatever had or has accrued to the complainant by reason of the admission.

Furthermore, the admission related to a matter that is before the court and open for the inspection and consideration of the court; and in such cases courts always exercise

their own judgment as to the truth of the admission, unless the complainant has been so prejudiced by relying upon the admission that greater injustice would be done by disregarding than by accepting the admission. The question that is always presented in such cases is as to whether the party has been put into such a position by the admission that injury and prejudice would result from its withdrawal or from disregarding it. In this case, however, as no prejudice has resulted, or can result, by giving full effect to the *Retraxit*, the court will consider the question of infringement presented on its merits, without reference to an admission made inadvertently and contrary to express instructions.

Even in the case of an admission in an answer under oath a Court of Equity will not hesitate to look at the facts, although giving effect to the admission, but to the *minimum* extent required. This is fully illustrated by the action of the Supreme Court in the case of *Jones v. Morehead*, 1 Wall., 164, where the defendant had filed an answer under oath admitting infringement. After considering the construction and limitations that were to be put upon the patent in suit, and comparing the defendant's locks with them, the court, the italics being ours, said:

“It therefore appears that, in point of fact, the defendants have not infringed the Sherwood patent, and if we were unembarrassed by the pleadings, we should dismiss the bill with costs. But the defendants have admitted in their answer that they did make locks as described in Sherwood's patent. . . .

“The fact that the defendants did manufacture and sell locks of the character of those patented by Sherwood, must be accepted as established in this case by the pleadings. The admission, however, *need go no further than its terms necessarily imply*. The language of the admission is satisfied, by assuming that the smallest number of *locks* were made, consistent with the use of that word in the plural.”

In the case at bar the admission was not made in the answer and under oath, but during the examination of the complainant's expert witness Maynard, and it was confined to *one* envelope—Exhibit C—and if given effect at all, should, under the principle of the above decision, be limited to the specific envelope. The admission was made inadvertently and against express instructions, and was promptly withdrawn. The reply testimony of the complainant shows that the witness Maynard was alive, available, and even with his office in the same suite of rooms occupied by the complainant's counsel, and that he was present during the taking of complainant's reply testimony. This is brought out in R-X Qs. 185-187 asked of the complainant, and his answers thereto, at page 199.

Furthermore, the admission becomes unimportant and immaterial, in view of the plain invalidity of the second Cohn patent, in view of the Boldt 1897 English patent, taken in connection with the state of the art as exhibited by the other prior patents in evidence. And in this connection, the envelope covered by the first Cohn patent, which discloses everything except the particular shape or contour of the window or transparent portion and the advertising matter, must be taken into consideration.

The Equities of the Parties.

In equity suits, the respective merits and equities of the parties are to be taken into consideration. The evidence shows that Cohn has never manufactured the envelopes of his patents, after making the first lot of 10,000 in the fall of 1904. He has never conferred on the public generally the benefit and advantages which result from furnishing them with envelopes containing his inventions. His patents are what the courts have frequently called "mere paper patents." We call attention to this, not for the purpose of denying the

right of Coln to hold his patents in non-use and still seek equitable relief under them, but for the purpose of saying that these non-used patents do not *especially appeal to a court of equity for any liberal consideration*, either on the question of *validity* or on the question of *infringement*.

On the other hand, the Transo Paper Company, manufacturer of the defendant's envelopes, stands in a very meritorious position. Mr. Regenstein, in answering question 79, on page 278, says that, "After the border matter was settled in January, 1904, we gave our attention, up to this day, to the perfecting of the transparency of the window." In answering the next question, he says that this was "a very difficult matter." He then says that, "The difficulties in preparing the windows properly were found on account of atmospheric conditions, non-elastic oils, and various other causes." In answering question 82, on page 278, he says that, "We have found and experienced in 1906 that the transparent window would stick to the back of the envelope, and have spoilt at least forty to fifty million envelopes in that manner." In answering the next question, he says that, "The loss to our company in perfecting envelopes, is over \$100,000." In answering question 84, on page 279, he says that, "Our envelope is now considered the most perfect transparent envelope in existence, and has a sale in this country as well as in foreign countries." In answering question 88, he says that, "To my knowledge, I am the only manufacturer, and have never seen any one-piece transparent envelopes made by any one else in this country." In answering redirect question 344, on page 341, Mr. Regenstein says that his company is engaged exclusively in the manufacture and sale of these one-piece window-envelopes. He says that they have about 120 hands employed in the work, and that they have in their plant machinery, etc., for carrying on the business, and an investment of "about \$150,000."

It may be said that these equities concern the Transo Paper Company rather than the particular defendant sued in this case. As a matter of fact, and of common sense, we all know that the *manufacturer* of a machine, device, or article of commerce, is the party who is most affected by the result of a suit against a user, as in this case, and so we submit that it is proper to consider the equities as between Cohn on the one side and the manufacturer, whose business will be affected, on the other.

Not only has Cohn never manufactured more than a few envelopes—for 10,000 is a mere bagatelle when we consider that millions of envelopes are used every day—and put the public in the possession and enjoyment of the envelopes of his patents, but he has apparently attempted to make improper capital out of the pendency of this suit. He has sent broadcast to the customers of the Transo Paper Company, the manufacturer of the defendant's envelopes, a "WARNING" made to resemble to a layman a subpoena or writ issued from the court, referred to at page 334; and that it has had the effect of creating that impression is shown by Palm Bros.' letter in evidence, quoted in the Defendant's Record, at page 338, in which they say that they are in receipt of a notice from San Francisco, signed by Max M. Cohn, "which purports to be a notice from the United States Circuit Court in and for the Northern District of California." Palm Bros. further state in their letter, as showing the effect of the "WARNING" which purported to be "a notice from the United States Circuit Court," that they had been using the envelopes, "but in view of having received this notice we have discontinued their use." Of course, the complainant was within his rights in notifying the public of his patents and of the commencement of the suit, when doing so in a proper way, but when framing his notice in such a way as to create the impression that it emanated from the United States Circuit

Court, he was, as we think, transcending the limits of proper notification. This is particularly so when the effect of his "WARNING" was to deter the public from using an article which he was not manufacturing and not in position to supply. It caused a direct injury to the public that might not have been occasioned if he himself had been manufacturing envelopes and ready to supply them to the public.

It is the party or manufacturer who actually gives an article of manufacture to the public that benefits the public, and not the man who merely procures a patent and fails to introduce his invention into public use.

No doubt it will be claimed that Mr. Regenstein, the president of the company manufacturing the defendant's envelopes, prior to their manufacture, had seen the second Cohn patent and some specimens of his kind of envelope, in view of cross-question and answer 176, on page 302. We regard this as a matter of no importance, in view of the fact that it is proper and right in every way for a party to consider and study a patent in order to devise other ways of effecting the same result; or, as said by the Supreme Court in *Burr v. Duryea*, 1 Wall., 574:

"Every man has a right to make an improvement in a machine, and evade a previous patent, provided he does not invade the rights of the patentee."

In *American Steel & Wire Co. v. Denning Wire & Fence Co.*, 194 Fed., 177, 122, the United States Circuit Court of Appeals for the Eighth Circuit, through Judges Adams, Smith and Amidon, in a case where there had been former litigations between the same parties under the same patent, said:

"Appellant complains because after the decision in the former case respondent deliberately set about devising, with the aid of patent experts, a machine which would

produce the Bates fence, without infringing the Bates patent. It is sufficient to answer that complaint in the language of Mr. Justice Grier in *Burr v. Duryee*, 1 Wall. 531, 574, 17 L. Ed. 650: 'Every man has a right to evade a patent, provided he does not invade the rights of the patentee.' "

Indeed, it is for the purpose of informing the public as to just what a patented invention consists of that the law requires specifications and drawings to be filed in the Patent Office and made accessible to the public. The simple question, and the only question, is as to whether the defendant's envelopes, whether made with knowledge or without knowledge of the second Cohn patent, contain the invention which such patent describes and claims. If there be infringement, *ignorance* of the Cohn patents would not make it non-infringement; and, if there be *non-infringement*, knowledge of the Cohn patent would not make it infringement. The whole question of knowledge or lack of knowledge of the Cohn patents on the part of the makers of the defendant's envelope becomes, therefore, wholly irrelevant and immaterial.

An Apology and Explanation.

We feel like apologizing for the length of this brief. Its justification, however, is found in the length of complainant's brief below, which contained 287 printed pages. It seems to us that the case has been exaggerated out of all proportions to the real character of the supposed invention. It is a pyramid built on its apex. The patent rivals one we had to defend against years ago, which was for tying two strings together to make one long one, though the claim was couched in sonorous terms about tying the outside end of one ball of twine to the inside end of the next to cause them to unwind in succession, and so forth. In this case the first Cohn patent

is essentially for nothing more than a grease spot on paper with a ring around it. The paper was old; the grease spot was old; the ring or border was old; the spreading effects of grease and inks were known; the concealing effects of a ring or border around the grease or inks were known; they had been used together for many years in the printers' art; old printers considered that the use of borders was so well known that it was ridiculous to ask for a patent on a border around a grease spot on paper intended for an envelope; yet here it is, and the people who devised the method of printing a multiple of envelope blanks on a sheet at one operation with each revolution of the cylinder in the press, with the grease spots properly positioned, and thus made the production of one-piece transparent-window envelopes economical, practical, and commercial, are harassed by litigation by a man who, in his ignorance of the use of borders in the printers' art generally, teased the Commissioner of Patents, who was likewise ignorant of such use, as far as the record shows, into giving him a patent under which he has put the really meritorious parties to thousands of dollars of expense; and all this under a patent which, however its claim is worded, is practically for nothing more than a ring around a grease spot on a piece of paper used in making an envelope.

Well did the Supreme Court, in *Atlantic Works v. Brady*, 107 U. S., 200, describe the effect of granting such patents, when it said: "It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts." The Supreme Court says that such a course on the part of the Patent Office "embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to law

suits and vexatious accountings for profits made in good faith."

The Gist of the Matter.

To get down to the decisive facts and considerations of the case, they are very few, settled and indisputable, and may be thus formulated:

As to the first Cohn patent, envelopes of *opaque* paper with *transparent* windows produced by some oily substance, but without any border around them, had been disclosed to the world in the Brown 1862 patent; envelopes of *transparent* paper with *borders* around a desired transparent portion constituting the *window* and covering the remainder of the face of the envelope had been disclosed to the world in the Busch 1896 British patent; opaque paper with *desired portions* rendered transparent by an oily preparation, with a *border* printed around the transparent portions, had been disclosed to the world in the Tudor 1878 patent and others; and *borders* had been printed for many years around *various kinds of work* in the different branches of the printers' art, to *define* the work and *cover* and *conceal* ragged, irregular and unsightly edges produced by the running or spreading of the inks or colors, imperfect registration, and other causes.

With these facts established, it follows that to print the *borders* of the Busch or Tudor patents, to mention no others, around the *transparent window* of the Brown 1862 envelope, or the border used by printers for the same purpose, that of concealing, defining and beautifying, was merely a double use of the old border—not as much as that, considering that Busch used the border on *envelopes* to define his window—merely an old and common printers' *expedient*, merely the applying of the *familiar* knowledge and *usual skill* of the

printers' craft, merely a *mechanical* act that required nothing of *invention* in its application.

As to the second Cohn patent, its envelope merely differed from that of the first patent in the shape or contour of the window—the *transparent portion* pure and simple—irrespective of the *border*, and the use of advertising matter on the border or face of the envelope; the border may extend *from* the window to the *edges* of the envelope, “solid over the face of the envelope,” to use the words of the patent, which would, of course, annihilate and *remove* the invention *unless* the word “window,” which he says is “in outline characteristic of some symbol of trade,” means the *window* and *not* the border; envelopes having transparent windows in the form of trade-marks or symbols, or “in outline characteristic of some symbol of trade,” to use the words of the Cohn claims, or having “a trade-mark or a name or other symbol or device upon the transparent covering,”—the window—to use the words of the Boldt patent, had been disclosed to the world in the Boldt British 1897 patent.

With transparent *windows* in the form of *trade-marks*, or in other words “in outline characteristic of some symbol of trade,” as disclosed in the Boldt 1897 patent, it follows that no *invention* was involved or could be involved in merely *changing* the form of the transparent window of the first Cohn patent into a similar shape or outline. It further follows that, as the transparent *window* in the defendant's envelope is *not* “in outline characteristic of some symbol of trade,” but is in the form and size of the regular stock windows made by the manufacturer of the defendant's envelopes and printed from the same blocks, so that, if the border were printed solid from the window to the edges of the envelope, as the Cohn patent says the border may be printed, every

possible *suggestion* of any particular article of manufacture would be *annihilated* and removed, which is not the case where the *window* is "in outline characteristic of some symbol of trade," as claimed by Cohn, the defendant's envelopes, irrespective of the fact that they do not have any "permanent" printed matter, in the sense of the second Cohn patent, printed on the *border* or on the *face* of the envelope, do not contain the subject-matter of the claims of the second Cohn patent and are not an infringement of the same.

In view of all the foregoing, we insist that both of the Cohn patents are invalid, in view of the state of the art, for want of invention, as already explained, and that the defendant's envelopes do not infringe the claims of the second Cohn patent.

Respectfully submitted,

THOMAS A. BANNING,
For Defendant.

SAMUEL W. BANNING,
THOMAS A. BANNING, JR.,
EPHRAIM BANNING,
Of Counsel.

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

H. J. HEINZ CO.,

Appellant-Defendant.

vs.

MAX M. COHN,

Appellee-Complainant.

On Patents
No. 835,850
and
No. 824,908
"Envelops"

APPELLEE'S BRIEF

CHAS. E. TOWNSEND,

Solicitor for Appellee.

FILED



IN THE
District Court of the United States

IN AND FOR THE
NORTHERN DISTRICT OF CALIFORNIA,
SECOND DIVISION.

HON. WM. C. VAN FLEET, JUDGE.

MAX M. COHN,

Complainant,

vs.

H. J. HEINZ COMPANY (a Corporation),

Respondent.

In Equity
No. 15204
on
Patents
No. 835,850
and
No. 824,908
Envelopes

MONDAY, JUNE 24TH, 1912.

THE COURT (orally) :

This is a suit in equity to restrain the use by the defendant of a certain envelope alleged to infringe the patents of the complainant sued on, numbered respectively 835,850 and 824,908, both issued to the complainant and relating to an envelope commonly referred to in the art as a window envelope; that is, an unpunctured envelope made from generally opaque stock, having a transparent portion on its address side called a window, through which an address placed upon the enclosure may show through, and thus avoid the necessity of writing it upon the face of the envelope,—the window or transparent portion being produced by

the application of some oily substance suitable for the purpose of producing the transparency. This window portion is surrounded by a colored or tinted border of opaque ink to give the window definition and cover up an otherwise unsightly and irregular margin produced by the inevitable tendency of the oily application to bleed or creep into the surrounding opaque portion of the paper.

Patent 835,850, although later in issue, was first applied for and covers the primary form of the invention above outlined.

Patent No. 824,908, which, although later in application, is earlier in issue, is based upon the first as a divisional application, and relates to an envelope such as described in the primary application, but having the window or transparent portion produced in the form or outline characteristic of some symbol of trade, article of commerce or trade mark. There is also printed matter of a permanent character appearing upon the face near the window to indicate and attract attention to the brand of goods or article of merchandise designed to be advertised thereby.

The main defense of the defendant, who is a user of the article and not the manufacturer, is that the complainant here was not the first inventor or discoverer of the device or process covered by these patents, but that the discovery was made by and put in use by one Regenstein for the manufacturer, the Transo Paper Company, the party really making the defense here; and a large part of the record is devoted to evidence bearing upon the question as to who was in fact the original designer or inventor of the device. The rule is very well established in such cases that in order to overcome the presumption of validity of the patent and the prior rights thereby protected, the evidence must be such as to satisfy the mind of the court beyond a reasonable doubt that the patentee was not the original discoverer or designer of the device; and I am fully persuaded, after a very thorough examination of the evidence in this case that it does not come up to the requisite strength to overthrow the primary case of the complainant and the

presumption which runs in his favor through the issuance of the patent. It is not necessary, nor would it be of any material benefit to go into any detailed statement of that evidence. It is somewhat unsatisfactory in certain respects on both sides, but it is such as in my judgment fails to establish this claim of the defense.

The second defense is that there was a want of novelty, by reason of the prior art, in the primary invention—not perhaps a strict anticipation but a failure to disclose novelty by reason of the existing state of the art. A large amount of evidence is devoted to that subject as well; a considerable number of prior patents were put in evidence for the purpose of sustaining this plea of anticipation or want of novelty. I have examined those features of the evidence very carefully. What is apparently regarded by defendant as the best reference is a patent to one Brown in 1862. That does disclose a glimmering of one feature of the invention that is involved in this first Cohn patent. I should say perhaps, preliminarily, that these Cohn patents are what are known in the patent law as combination patents; that is, they disclose a combination device or process; I think perhaps “process” would be the better term because it is by a process that the articles of commerce are produced. This Brown patent of 1862 discloses in a way an idea approaching one element of the first Cohn patent; that is, it discloses an idea of a window envelope. This window, however, is unaccompanied by any ring or border, and the calls of the patent are indefinite as to the manner in which the window shall be produced. It says that the transparent portion may be produced in the same way that tracing paper may be produced, while the evidence tends very strongly to show that by the application of that method no successful result would be accomplished, as the means for making tracing paper are such that they cannot be applied for the purpose of producing transparency in simply a portion of a sheet; it must be applied to the entire sheet. Moreover, as I say, the Cohn patent being a combination, the Brown patent entirely fails to come up to an anticipation, because it involves, if it be admitted that that

element is disclosed in the Brown patent, nothing but the single feature of this transparent window unaccompanied by the other which I regard as an essentially characteristic feature of the first Cohn patent, a border or ring of opaque ink applied for the purpose of covering up the ragged edge that the evidence discloses inevitably results from the application of the oily substance applied for the purpose of producing the transparency.

There is also a British patent issued to one Busch which is pleaded as an anticipation, or, more properly, as an illustration of the state of the art, which it is claimed should preclude a finding of novelty. This patent is claimed to embrace the feature of a ring or border. I am satisfied from my examination of the record that this claim cannot be sustained. Moreover, the Busch patent involved a device which required for its production a paper entirely transparent; the entire envelope in its primary form was to be made of transparent material, and thereupon the window feature would be produced by covering the entire portion of the face of the envelope other than the window space with opaque ink, thereby resulting in the production of an envelope the back portion of which would remain transparent, and the transparent opening or window in front, while the balance of the face of the envelope would be entirely in either black or some other dark colored ink which, as the evidence tends to show, produced an unsightly or unattractive effect, and rendered that device very largely an unsalable product; that is, it never was a success, and so far as appears, it has gone entirely out of use, if it ever had any; so that I am unable to regard that as an anticipation of the device embraced in the Cohn patents or either of them.

There was another British patent issued to one Boldt. That is a device which is even broader in its distinctive features from the Cohn conception than the one just suggested. It was a patent secured by Boldt for a method or process of making not strictly an envelope, although the envelope is included within the definition of its terms, but a receptacle or casing or container for

goods of any particular character that for the purposes of commerce it should be desired to have done up in packages; and had this transparent window or opening so placed as to disclose the character of the contents of the package, so that picking up the package you could look through this transparency and see the character of the goods contained therein; and it was that feature which seemed to be the principal idea in the mind of the inventor of that device, that is, making a container which would enable the buyer of an article of commerce to readily see what he was getting without breaking the package. It is largely, if not wholly, to my mind, along a different line in its conception than the Cohn patents, and I do not think, either in a primary sense or in its details, can be looked to or regarded as an anticipation of the real feature which is embraced in the Cohn conception. Moreover, it is constructed in a distinctively different manner from the Cohn patent. It is not a one piece receptacle or envelope, but is an envelope or covering having a punctured face, and the puncture or opening is then covered or closed by a separate piece of transparent material of any appropriate character. In that respect it is entirely different from the conception of Cohn, which embodies, as indicated by the claim of the patent—I am speaking now of the first Cohn patent—a single piece, an unpunctured envelope rendered transparent through the application of the substance which is employed for that purpose. This Boldt patent, like the previous one, that of Busch, seems never to have had any successful life, so far as commerce is concerned, and so far as the evidence discloses is not now in use. This window, moreover, which Boldt provided for was likewise unaccompanied by any border or ring for the concealing of the edge. It is true, however, that that was a method of construction which did not require it, because of the different manner in which the window was produced; but I am entirely satisfied that no one of these so-called anticipations put in evidence subserve the purpose for which they were submitted, and that there is nothing in the prior art which can be regarded

as an anticipation of the first Cohn conception, that is, the device embraced in the so-called first patent.

It is unnecessary to state, perhaps, with reference to a doctrine so well established, that it is not sufficient, as against a combination patent, to show simply anticipation of some one or more of the different elements of the combination, but not all. The unitary result of the combination is the subject of the patent; and unless you disclose in the art an anticipation of that unitary thing you do not disclose anticipation; and so, whether or not the record does disclose that some one or two features of either one of these devices is anticipated, the evidence entirely fails to show any device which could be taken as an anticipation of the combination of either patent.

It is also urged as against the second Cohn patent, which is also claimed to be infringed by the envelope defendant uses, that it is wholly lacking in novelty and patentability. As indicated, that device is merely a step beyond the primary device covered by the first Cohn patent. It employs the same method for producing the envelope and the transparency, but adds the distinctive feature of changing the form of the window as may be desired to represent a symbol of trade, a trade mark, or article of manufacture, accompanied, as stated, by a permanent printed word or sentence such as may be desired which always remains upon the envelope however used, as purely an advertising feature. It is claimed that this change from the original was purely an advance in the nature of a mechanical difference; that it involved no use of the inventive faculty. I am unable to sustain this contention. I think that the device gives very decided evidence of inventive thought. Inventive thought is not confined of course to devices which relate to machinery or things of that kind, but to anything which produces a result in the art or science to which it relates which is of a novel and useful character and which is materially different from that which precedes it. I think that the evidence discloses very clearly that this conception was one which had been sought after for a long period,—something of the kind,—but the real idea

occurred to no one to put it into successful form until Cohn seized upon it. I am satisfied that the objection that the second patent does not cover a device which discloses patentability is entirely unsustained by the evidence.

The last defense is that there is a want of infringement in the use of the envelope which the defendant employed because of certain differences in its construction. There is no question made but what it infringes the first Cohn patent, but it is claimed that it fails as an infringement of the second Cohn patent because of certain structural differences. The primary form of the envelope is produced in precisely the same way, through the application to a portion of its opaque face of some transparency producing material; the ring or border is applied in precisely the same way and is of distinctive characteristic form; but although accompanied by permanent printed matter, this printed matter instead of being upon the face of the envelope adjacent to the window is printed upon the inside of the back flap of the envelope in such a position that it shows through the window when the enclosure is removed, and not being visible until the enclosure is removed; and the claim is that by reason of this difference, the second Cohn patent, being as claimed a very narrow one, there is not disclosed equivalency in the manner of constructing the defendant's envelope. I am of opinion that this defense is without merit. Equivalency is always to be found where the same or like result is produced and the function is performed in substantially the same way; and I am quite satisfied that under any just application of the rule bearing upon that question, equivalency would be found in this device which is used by the defendant. This being so, I am satisfied that the defenses must be held bad and the decree must go in favor of the complainant as prayed.

No. 2195.

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

H. J. HEINZ CO.,

Appellant-Defendant.

vs.

MAX M. COHN,

Appellee-Complainant.

On Patents

No. 835,850

and

No. 824,908

“Envelops”

(The page numbers refer to printed record.)

APPELLEE'S BRIEF.

This cause comes before this Court on the appeal from a final decree of the District Court of the United States for the Northern District of California, sustaining the validity of two several letters patent, No. 835,850 and No. 824,908, for Envelops, respectively dated, November 13, 1906, and July 3rd, 1906, issued to the complainant-appellee, and from a permanent injunction issued against the defendant-appellant, restraining the further infringement of said letters patent, and each of them.

The witnesses have elected to speak of Patent No. 835,850 as the “First Cohn Patent,” and Patent

No. 824,908 as the "Second Cohn Patent." A specimen of the infringing envelop is attached at the back of the original copy of this brief.

The defendant-appellant was sued as a user of infringer envelops manufactured by the Transo Paper Company of Chicago, of which one Julius Regenstein is president and owner. The latter assumed the entire defense in this suit, so that the H. J. Heinz Company is the defendant and appellant in name only.

Judge Van Fleet's opinion appears at the beginning of this brief, and also R. 32-40.

The sole question before the Court on this appeal is:

Did the lower Court err in granting an Injunction?

The title of appellee-patentee is conceded, as well as is the due issuance of the patent and incorporation of the defendant (Appellant's Brief, p. 3).

Infringement of the First Cohn patents is admitted by the defendant. (X-Q. 109, R. 551.) Infringement of the Second Cohn Patent was also admitted by the defendant, although later this admission was withdrawn. Independent, however, of this admission proofs were later submitted by complainant to show infringement.

The only ground that appellant-defendant has urged for contesting the Order for the Injunction is that the inventions covered by the letters patent

were not novel at the date of the invention thereof by the appellee, Cohn. The Defense, therefore, is founded on Anticipation, with its corollary lack of Invention. This defense is alleged to be made out by certain prior patents which were carefully considered by Judge Van Fleet and referred to in his Opinion; and rests also on the claim that either Regenstein or an associate of his, one Reese, invented the subject-matter of the First Cohn Patent prior to the invention thereof by the patentee, Cohn. But as the proofs show Regenstein lays no claim to a possession of the invention earlier than January, 1904, whilst Cohn has amply established his conception of the invention, the making of models and a disclosure thereof to others prior to October 15, 1903, and has shown due diligence in reducing the invention to practice and applying for patents.

Concerning the effect to be given the decision of the lower Court, we would quote the words of the Circuit Court of Appeals for the Eighth Circuit recently, in *De Laval Separator Co. v. Iowa Co.*, 194 Fed. 423:

“When the chancellor has considered conflicting evidence, and made his finding and decree thereon, they must be taken to be presumptively right; and unless an obvious error has intervened in the application of the law, or some serious mistake has been made in the consideration of the evidence, they must be permitted to stand. *Tilghman v. Proctor*, 125 U. S. 136, 8 Sup. Ct. 894, 31 L. Ed. 664; *Kimberly v. Arms*, 129 U. S. 512, 9 Sup. Ct. 355, 32 L. Ed. 764;

Evans v. State Bank, 141 U. S. 107, 11 Sup. Ct. 885, 35 L. Ed. 654; *Furrer v. Ferris*, 145 U. S. 132, 134, 12 Sup. Ct. 821, 36 L. Ed. 649; *Warren v. Burt*, 58 Fed. 101, 106, 7 C. C. A. 105, 110; *Paxson v. Brown*, 61 Fed. 874, 883, 10 C. C. A. 135, 141; *Stuart v. Hayden*, 72 Fed. 402, 408, 18 C. C. A. 618, 624; *Coder v. Arts*, 152 Fed. 943, 946, 82 C. C. A. 91, 94, 15 L. R. A. (N. S.) 372."

The appellant's arguments now presented to your Honors' attention are identical with those used in the lower Court and its Brief on Appeal is almost word for word a copy of the Defendant's Brief on Final Hearing. No new theories, no new reasons are advanced now by appellant adverse to the patents that were not with equal earnestness and lucidity laid before the lower Court.

On pages 3 to 8 inclusive, of Appellant's Brief, the establishment of 18 facts supposedly favorable to defendant are claimed with respect to the patents in suit.

ON BEHALF OF COMPLAINANT THE FOLLOWING ALLEGATIONS OF APPELLANT ARE DENIED:

1—It is denied that Julius Regenstein ever made any one-piece transparent envelopes with a border in January, 1904, or at any other time in fact prior to the date of Mr. Cohn's application for patent. This matter will be fully gone into under the head of "Defenses."

2—It is denied that the border in the "three-color" or lithographic art was ever used "to cover up and

conceal ragged, imperfect or unsightly edges *resulting from the running of the ink or colors;*" because it is undeniably the fact that the ink used for this kind of work does not *run* or *bleed*, and a border is only used where the job is left *intentionally* in an unfinished condition to receive a border later (like where a trimming strip of wood is nailed over the unfinished ends of boards), or where the color printer wanted to get a *higher price* for his work. The border of the old "three-color" work, as testified to by Regenstein and his witnesses, and shown by the samples of the Osborne Art Calendar, was a matter of individual fancy, and of extra price; and *even where used as seen in many of the pictures in the Osborne Art Calendar, the border did not even cover up the so-called deficiencies in the pictures!* See for example "A Florentine Girl" No. 4202 on page 43; and the picture of "A Soldier and a Girl," page 54; also page 59; also page 61; see testimony of Regenstein, R. 324.

A picture without a border is just as good as one with a border; see picture "Off to the Front," loose sheet 4564 and on page 54, also Regenstein X. Q. 285 and 286.

Furthermore a border never appears in the *body* of the picture where the different colors blend and where *running* of the colors would be most perceptible if they ever ran or bled, which they do not do. There are splendid examples of pictures and labels in this Osborne book which shows no borders and

By Mr.
Banning
Sec. Rec.
p. 383

of Deun-
ing's Note
See Rec.
281.324

where a border would be a positive detriment. See the cigar box labels at the back of the book. The uses of the border by Cohn and the lithographers were not analogous.

Cohn created a new art and a new industry and both he and Regenstein were driven to evolve the border in the combination through experience and necessity.

3—It is denied that the Brown patent shows or describes a one-piece transparent envelop made of opaque paper and with window spaces “rendered transparent by the application of an *oily* or *similar suitable preparation*.” We are surprised at Counsel even claiming that Brown shows or describes anything about the use of “oil” whatsoever. The assertion on behalf of appellant is wholly unwarranted, although it is only a repetition of his argument in the Court below.

4—The defendant uses the border for precisely the same purpose and in the same combination and in substantially the same way as taught by Cohn.

5—It is denied that the Busch British patent shows a “border.” It is true that defendant’s expert and his Counsel *thought* it did, but we will point out how they were mistaken and that Busch is simply for a transparent stock envelop made from transparent paper.

6—It is denied that any combination of Brown, Busch, and the “three-color” art, or the printing art

Mr. Bann-
ing's Note
See Rec.
293

Mr. Bann-
ing's Note
See Rec.
614. 617.

Mr. Bann-
ing's Note
See Rec.
609.

Mr. Bann-
ing's Note
See Rec.
580.

generally will, "produce the envelop described and claimed in the First Cohn Patent sued on." We will show why they do not do so, either singly or combined, and we will show that the law does not sanction such massing of patents in prior arts to destroy a meritorious invention.

Your Honors, in the recent case of *Kitchen v. Levison*, 188 Fed. 658, said in upholding the Levison 1902 Patent on a Triplicating Manifolding Book having a *bound* carbon, over the prior Barlow Triplicating Book with a *loose* carbon and the Bengough *Duplicating* Books with a *bound* carbon:

"It is urged that the improvement which the appellee made on the prior art was simple and obvious. It may be conceded that it was simple, but that fact alone does not deprive the invention of patentability. There may be the highest form of invention in some of the simplest improvements on the prior art."

In the Levison case the "Barlow" 1884 patent was a much closer reference to the Levison patent than is the Brown patent, to Cohn; because the "Barlow Book" was a *practical* book and is used extensively today. Judge Gilbert said:

"But the device which is principally relied upon by the appellants is shown in the patent of H. G. and J. B. Barlow of April 29, 1884. *This patent anticipates the appellee's patent in every feature except one.* Instead of having their carbon sheet *bound* in the book as in the appellee's patent, it was *loose*. * * * Eight (18?) years after the issuance of the Barlow patent the

appellee conceived the idea of binding the carbon sheets with the stubs of the record sheets of the book so that the carbon sheets would always be in their place. * * * The patent to James Bengough of January 28, 1896, shows a *bound* manifold sales book * * *.

“In addition to the presumption which arises from the issuance of the patent to the appellee, there are to be taken into consideration as sustaining his patent, the further facts that when his invention was made, there was a *want* in the art for such a device, that in the prior art there were well recognized and admitted defects, and that the appellee’s device eliminated those defects and went into general and successful use. In view of all these considerations, we find the evidence insufficient to overturn the finding of the Court below that the appellee did exercise inventive faculty in devising the book for which he obtained his patent.”

7—It is denied that the numerous patents for imitation stained glass windows, dress charts, etc., relied on by defendant, have any bearing on the issues.

8—It is denied that printing the border of three-color work or a border such as shown in any of the above patents, upon Brown, “produces the envelop described and claimed in the First Cohn Patent sued on.”

9—It is denied that printing the border of three-color work or a border such as shown in any of the previously mentioned patents, upon Brown, even if such combination is possible, was merely an exercise of mechanical skill.

10—It is denied that Cohn did not make any transparent window envelops from opaque paper, produced by an oily preparation, and with a border, until “subsequent to May 9, 1904;” because Mr. Cohn and the other witnesses have positively testified that they did make experimental envelops in crude form, embodying the invention of the First Cohn Patent in the latter part of 1903 and were working diligently on the invention from the very first conception. It has never been claimed by Mr. Cohn that the envelops introduced in evidence were the earliest he had made, because his early specimens were burned up in the fire of 1906. There is nothing inconsistent in the marking of the envelops in evidence, with the words “Patent Pending,” and the evidence of conception and reduction to practice of the invention by Mr. Cohn in 1903.

NOTE: Defendant has nowhere denied as far as we have observed, either in the testimony or in the brief, the *conception* by Mr. Cohn of the invention in issue and its *disclosure* to others *prior to the alleged invention by Regenstein in January, 1904*, (See Mr. Cohn’s summary, R. 56):

“SUMMING UP WHAT I DID UP TO THE TIME OF LEAVING THE GLASS COMPANY ON OCTOBER 15, 1903, IS AS FOLLOWS:

“I CONCEIVED THE IDEA OF MAKING AN UNPUNCTURED ENVELOP WITH A WINDOW ADDRESSING SPACE.

"I SUCCEEDED IN MAKING AN OPAQUE SHEET TRANSPARENT BY THE USE OF AN OILY PREPARATION.

"I DISCOVERED AND APPLIED A PRINTED BORDER AROUND THE WINDOW ADDRESSING SPACE.

"I DISCLOSED MY INVENTION TO A DISINTERESTED PARTY."

11—It is denied that the claims of the Second Cohn Patent sued on, are limited to envelopes containing a transparent window space considered by itself alone, and irrespective of the border. This is fully considered under the head of "Infringement," herein.

12—It is denied that the Boldt British Patent shows or describes transparent windows in the shape of a trade-mark, article of manufacture or symbol of trade, or that this Boldt British Patent embodies or suggests in any way the invention of the Second Cohn Patent.

13—It is denied: (1) that as a matter of fact any combination of the First Cohn Patent and Boldt would produce the envelop of the Second Cohn Patent; and (2) as a matter of law it is denied that the First Cohn Patent is any part of the prior art with respect to the Second Cohn Patent.

14—It is denied on the two grounds last-above stated, that it would only require mechanical skill to combine the First Cohn Patent with the Boldt British Patent with anything else in the so-called prior art, to produce the Second Cohn Patent.

15—It is denied that the defendant's transparent window is as a matter of law not in the shape or form of an article of manufacture, or that it is not in outline characteristic of some symbol of trade, but is simply a regular Transo stock envelop. The transparency and the border constitute the window; "and the mere change in form, proportion or degree" practiced by the defendant is immaterial to the question of infringement.

The Century Dictionary gives the following definition of the word "Window": "In modern building this opening is usually fitted with a *frame* in which are set movable *sashes* containing panes of glass or other transparent material, *the whole frame with the sashes, etc., also being known as the window.*"

16—It is denied that "the defendant's envelop contains no permanent advertising or printed matter on the border or face of the envelop as required by the claims of the Second Cohn Patent sued on." The defendant has merely changed the *location* of the word "Heinz" from the outside of the envelop to the inside. The word "Heinz" "appears" on the face of defendant's envelop and is "permanent printed matter" and is "related to and in juxtaposition with the outline of the window" and it certainly "co-operates with said outline" and "indicates a particular brand of goods." (The claim does not say *printed* on the face of the envelop but as "appearing" on the face.)

17—It is denied that the defendant's envelop does not infringe the claims of the Second Cohn Patent.

CROSS-EXAMINATION OF MR. COHN.

Beginning page 104 and following, Appellant's Brief, Mr. Cohn is taken to task for refusing on cross examination at the time of putting in his *prima facie* case, to go into details as to when he first invented the envelopes here in issue. This cross examination was contrary to all the rules of evidence; it was objected to as not proper cross examination and it was further objected to by Counsel for complainant on the grounds that the cross examination was only a fishing expedition, having as its object the finding out in advance just how far back Mr. Regenstein would have to swear in order to even hope to win. That this was not proper cross-examination even in patent cases, see:

Aeolian Co. v. Standard Music Roll Co., 176
Fed. 811;

Ferry-Halloch Co. v. Orange Hat Box Co., 95
Fed. 186.

Just as was said in the latter case:

“While several of these questions might perhaps be permitted without substantial invasion of the rights of the complainant, yet, *in view of the evident purpose of the examining counsel to encroach upon such rights and to construct his defense under the guise of cross-examination*, sound discretion requires that he should be held strictly within the rule.

“Under equity rule 67, the party calling the witness must, in the first instance, be at the ex-

pense of taking the depositions, and this furnishes one reason, and in some cases one of considerable moment, why the cross-examination should be kept within the proper limits; but the chief reason, and one which is founded in principle, the maintenance of which is vitally essential in preserving the rights of litigants, is the one stated by me in *Aeolian Co. v. Standard Music Roll Co.*, *supra*, viz.:

“ ‘A party offering a witness stands sponsor for his credibility, and, stated generally, is bound by what he may say both on direct and cross-examination. Being so bound, he has the right to call him for a particular purpose, and his adversary has no right to examine him generally, but is confined to the subjects testified to by him in chief. The cross-examiner will not be unduly restricted in the examination. Full scope and opportunity will be afforded, for cross-examination is the best-known method for the ascertainment of truth; but it must be confined to the subjects of the direct examination. If it is desired to examine the witness as to other matters, the proper practice is to make him his own witness. The only exception to this rule is to show bias or prejudice and to lay the foundation to admit evidence of prior contradictory statements.’ ”

On *direct* examination five questions only were asked of Mr. Cohn as follows:

“Q. 1. Will you please state your name, age, residence and occupation. A. Max M. Cohn; 12 Monte Ave., Piedmont; Paper Man; Paper Business; Age 42.

“Q. 2. Are you the complainant in this action? A. I am.

“Q. 3. Are you the patentee mentioned in the two patents? A. I am.

“Q. 4. Do you own those patents? A. I do.

“Q. 5. Have you ever made any transfer or assignment of either of them? A. I have not.”

There is certainly nothing inconsistent in Mr. Cohn's answering, that “*at that present moment*” he could not tell when he first conceived the invention in suit, X. Q. 15, especially when he knew, or had reason to suspect, the object of the inquiry made on behalf of his canny adversary. Neither had he had occasion to look up the matter of dates, etc., as he had no idea of his being interrogated along these lines.

In answer to X. Q. 22 (quoted at page 105, Appellant's Brief) Mr. Cohn explained that: “it would be necessary for me to go through a great amount of data which I have, and consult with some of my witnesses, before being able to answer as to the time of conception.” And in answer to R. X. Q. 9 (quoted at page 107, Appellant's Brief) Mr. Cohn said: “as stated before, it is impossible for me at this time to give anything *definite* in reference to the time of conception.” The consequences of answering such questions at random can readily be imagined.

In making a *prima facie* case, all that is required of a complainant is to introduce his patent, show title to it and show infringement. The question as to when the invention was conceived or made, is immaterial, and can only arise when the defense sets up a contra-claim to prior inventorship and introduces *evidence* to that effect.

THE PATENTS AND INVENTIONS
IN SUIT; THEIR PURPOSE
AND HISTORY

THE PATENTS AND INVENTIONS IN SUIT; THEIR PURPOSE AND HISTORY.

The *generic* invention covered by the First Cohn Patent relates to an envelop made from opaque stock, having a window portion, through which the address on an enclosure may show through, made transparent by the application of an oil, or the like, and a colored or tinted border of opaque ink surrounding the transparent portion for the purpose of obliterating or concealing the effects of the tendency of the transparency-forming preparation to creep into the surrounding opaque stock.

The Second Cohn Patent pertains more especially to such an envelop in which the window and border, either singly or together, are in general outline characteristic of a trade-mark, or symbol of trade, and with which characteristic outline some permanent printed matter appears in juxtaposition, and co-operates therewith to indicate a particular brand of goods, and thereby confronting anyone seeing the envelop with a striking advertisement of a particular brand of goods of a particular merchant or firm.

The two inventions covered by these several patents were described in the original application as filed November 8, 1904; the original application being prosecuted for the *genus* envelop as given to the world in the First Cohn Patent, and the divisional application and Second Cohn Patent being for the *species* advertising envelop and protected and covered as "an advertising device."

The drawings of the two patents are illustrated on the next two pages.

Patent No. 824,908, although earlier in date than the other patent, was applied for subsequent thereto, to wit:—January 17th, 1905, as a “divisional” application of the original application filed November 8th, 1904, which original application resulted in the afore-said patent No. 835,850.

FIRST COHN PATENT NO. 835,850.

After stating that the object of his invention is to provide an envelop having a generally opaque, unpunctured face, with a more or less limited transparent area for the addressee's name and address to show through, and which envelop “shall be simple and cheap to manufacture, practical in every way and which shall offer novel and unique possibilities for advertising,” the patentee proceeds to describe his invention in the following language:

“In carrying out my invention I take a blank sheet of paper or an envelop-blank of suitable strength and texture which is, say, semitransparent and apply to a portion of one side of the blank generally on the inside, a preparation which has the property of rendering transparent the portion to which it is applied. The remaining portion or a part of the remaining portion of the blank which forms the face of the finished envelop A is then imprinted with a suitable opaque coloring matter.”

FIRST COHN PATENT

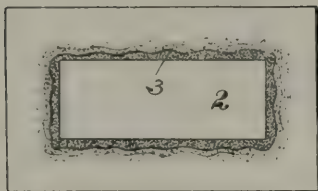
No. 835,850.

PATENTED NOV. 13, 1906.

M. M. COHN.
ENVELOP.

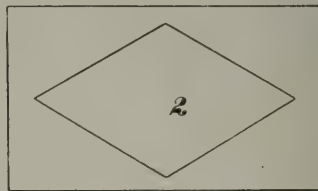
APPLICATION FILED NOV. 8, 1904.

Fig. 1.



A

Fig. 2.



A

Fig. 3.

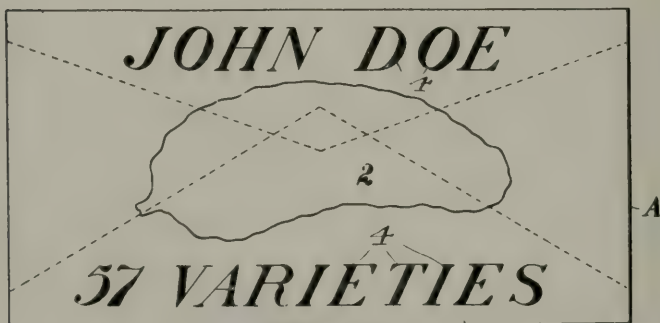


Fig. 4.



SECOND COHN PATENT

No. 824,908.

PATENTED JULY 9, 1906.

M. M. COHN.
ENVELOP.

APPLICATION FILED JAN 17, 1906

FIG. 1.

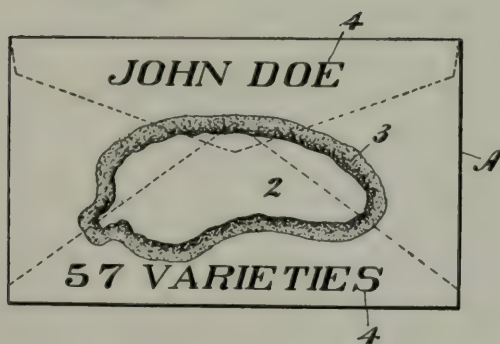
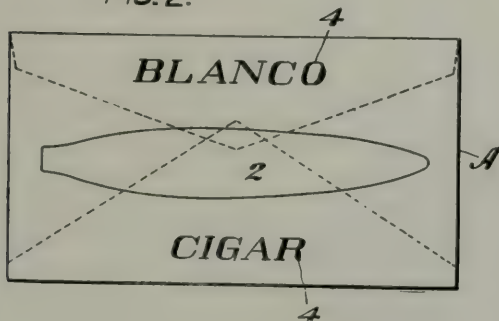


FIG. 2.



Continuing the patentee describes how he produces his transparent window in this opaque blank. He says:

“I employ a compound or preparation, such as parafin-oil and resin or a grease, which produces the desired result of rendering a semi-transparent paper transparent. This preparation is stamped or printed on or otherwise applied to the blank to provide the transparency or window of the desired design, and it is applied to such part of the blank where the transparency is desired to appear on the face of the envelop, and it may cover a larger or a lesser space, according to the desired size of the transparency or window.”

We would state here, that this was absolutely the first time in the art, that envelops were ever treated by means of an oily preparation to provide a transparent window portion. This use, however, of an oily preparation led to unforeseen difficulties which after various experiment, Mr. Cohn solved; some of these difficulties and the manner by which he overcame them being described in his patent, as follows:

“Since the oily preparation has a tendency to creep or ‘bleed’ beyond the borders of the space imprinted by the stamp or die by which it is applied, and so possibly stain or discolor the rest of the envelop or give a ragged appearance to the window-opening, it is preferred, even where the paper might ordinarily be deemed sufficiently opaque, to apply some sort of coloring-matter *at least* around the immediate borders of the transparency. This coloring-matter may be applied solid over the face of the envelop

around the window, as in Fig. 2, or it may take the form of graduated tints or of being shaded, or the representation of a surrounding cloud effect, as indicated at 3 in Fig. 1. In any event the effect and object of the colored border is to give definition to the window-opening and obliterate or cover up the otherwise rough unfinished outline of the window resulting from the encroachments of the oil or grease or other substance beyond its desired limits."

This use of oil with its attendant propensities to creep and the necessity of doing something to overcome this tendency, was wholly foreign to the printer's art is conclusively established by Mr. Regenstein when in answer to X. Q. 253 (R. 318) he says:

"I do not think that the making of paper transparent has anything to do with the printing art."

When we come to consider the infringing "Heinz Envelop," as appearing at the back of this brief, it will be seen how slavishly the manufacturer of the defendant's envelop has followed the instructions of Mr. Cohn as outlined by the quotations from his patent. *The defendant even applies his oil on one side and prints his border on the other, just as directed by Mr. Cohn in his patent, lines 85-88:*

"Usually and perhaps preferably, the preparation and coloring matter are applied to opposite sides of the blank, the preparations on the inside, and the coloring on the outside."

The reasons for applying the oil on one side and the border on the other side of the sheet was pointed out by Mr. Cohn in his appeal to the Commissioner of Patents, at the time his application was pending. (See file wrapper.) To quote:

“Now it is a fact that grease or oil applied to paper will spread more upon that surface of the sheet to which it is directly applied than upon the opposite surface. This probably is due to capillary attraction and to the oil following more quickly the direct path offered by the fibres which lie upon the side nearest to that to which the oil is applied; and if this side is an unprinted one or to which a coloring matter has not been applied to make the paper opaque, the ‘creeping’ effect of the oil will be more pronounced, as the printing ink itself would retard the same if on the same side as the grease, although it will not obliterate or almost entirely conceal the same, and the ragged line which would bound the transparent window would be unsightly and the window itself would not be sharply defined and have a neat finished appearance. When the colored preparation is used on one side of the sheet and the grease applied to the opposite side of the unprinted area, as we decide, we reduce the ‘creeping’ effects of the oil to a minimum, and obtain an envelop of commercial value, and the only envelop of this type which has proved commercially valuable.”

(Although Mr. Cohn describes the *advertising feature* in this First Patent, we will defer consideration of that until we take up the Second Patent, since this advertising feature is a separate invention and forms the subject matter of the Second Patent.)

The claim of the First Patent, is as follows:

As a new article of manufacture;

1—an envelop with an unpunctured face of relatively opaque stock—

2—said envelop face having a portion to which a preparation has been applied to render such portion transparent—

3—and a colored or tinted border surrounding said transparent portion for the purpose of obliterating or concealing the effects of the tendency of the said preparation to creep into the surrounding opaque stock.

This claim is therefore for an *envelop* as “an article of manufacture.” The reference character “2” represents the transparent portion of the unpunctured face to which a preparation has been applied and “3” represents the colored or tinted border surrounding the transparent portion “2” and obliterating and concealing the creeping tendencies of the oil.

The claim, we see, is a “combination” claim and is governed by the rules as to combination claims.

“ * * * It is no defense to claim of an infringement that one or more elements of a patented combination, or one or more parts of a patented improvement, may be found in one old patent or publication, and others in another, and still others in a third. It is indispensable that

all of them, or their mechanical equivalents, be found in the same description or machine, where they do the same work by substantially the same means. *Imhaeuser v. Buerk*, 101 U. S. 647, 660, 25 L. Ed. 945; *Bates v. Coe*, 98 U. S. 31, 48, 25 L. Ed. 68; * * *

J. L. Owens Co. v. Twin City Separator Co.,
168 Fed. 265.

To the same effect is the case of *Gormally & J. Mfg. Co. v. Stanley Cycle Mfg. Co. et al.*, 90 Fed. 280:

“Of course the claim can not be defeated by showing that each of its elements, separately considered, was old. The defendant must prove that the combination was old. If they fail in this, they fail irretrievably.”

The proofs show that the Cohn *combination*, including as it does *the ring or border*, was absolutely new in the art.

THE SECOND COHN PATENT.

No. 824,908.

Dated July 3, 1906;

Application filed January 17, 1905.

The patentee says that the present application is “a division of my original application ‘Envelop’ filed November 8, 1904, Serial No. 231,886.”

THESE TWO PATENTS, THEREFORE, ARE TO BE CONSIDERED AS APPLIED FOR ON THE SAME DAY AND NEITHER

PATENT CONSTITUTES AN ANTICIPATION OF OR LIMITS IN ANY WAY, THE OTHER.

“A divisional application takes the benefit of the date of filing of the original application from which it was divided.”

Smith v. Goodyear, 93 U. S. 486;

Brill v. North Jersey St. Ry. Co., 124 Fed. 778.

The date of invention and application and not the date of patent is the controlling date in determining as to the legal effect to be given to two patents issued at different dates to the same inventor in which are shown certain features common to both.

Suffolk County Mfg. Co. v. Hayden, 70 U. S. 3 Wall. 315 (18:76);

McMillan v. Rees, 1 Fed. Rep. 722.

Not only therefore, are both these patents to be considered as *applied for* November 8, 1904, but *neither patent is to be considered as part of the prior art with respect to the other.*

As was said in *Brill v. North Jersey St. Ry. Co.*, 124 Fed. 778:

“This patent (No. 627,900), being divisional relatively to patent No. 627,898, relates back to the date of the original application on which that patent was granted. The latter patent, therefore, does not, with respect to the divisional patent, belong to the prior art.”

NEITHER COHN PATENT LIMITS OR MODIFIES THE OTHER
AS EACH IS FOR A SEPARATE INVENTION.

At page 130 and following of his brief, appellant devotes several pages to try and show that in some way or another, the Second Cohn Patent is limited by the disclosures in the First Cohn Patent. We have already pointed out that such is not the law and that with two co-pending cases of the same applicant, each claiming different subject-matter, neither limits the other.

That this is not an open question, see the following cases:

Ide v. Trorlicht & Co., 115 Fed. 137-145, C. A.:

"Where each of several applications, which subsequently ripen into patents to the same inventor, describes an entire machine and the inventions claimed in all of the applications, but no one of the applications claims any invention claimed in any of the others, and they are all pending at the same time, the respective dates of the applications and of the patents and the dates when the applications were filed are immaterial, and the applications and the patents cannot be used to anticipate each other. *Walk. Pat. Sec. 180; Westinghouse Electric & Mfg. Co. v. Dayton Fan & Motor Co.* (C. C.) 106 Fed. 724, 726; *Suffolk Manufacturing Co. v. Hayden*, 3 Wall. 315, 318, 18 L. Ed. 76; *Graham v. McCormick* (C. C.) 11 Fed. 859."

See also

Anderson v. Collins, 122 Fed. 451, 458;

Victor Talking Co. v. American Graph Co.,
140 Fed. 860; affirmed 145 Fed. 350;

Welsbach Light Co. v. Cohn, 181 Fed. 122,
126;

Cleveland Foundry Co. v. Detroit Co., 131
Fed. 853, 858, C. C. A.;

Kinnear Mfg. Co. v. Wilson, 142 Fed. 970,
C. C. A.

Consequently, the Second Cohn Patent is not limited or affected in any way by the First Cohn Patent. Conversely the First Cohn Patent is in no wise affected by the prior issuance of the Second Cohn Patent; for as said in *Cleveland Foundry Co. v. Detroit Vapor Stove Co.*, 131 Fed. 853, 858, C. C. A.:

“As was explained in the Dayton Fan & Motor Co. Case, when the patent first granted is distinctly and only for an improvement, on another invention which is already the subject of a prior application then pending, and on which a later patent is granted, the patent for the improvement in no wise interferes with the other application or the patent issued thereon, for the reason that the patents are for separate and distinct inventions. In just such a case as this we held that the later patent, being one for the generic invention, was not invalidated by

reason of the issue of a previous patent in which improvements upon the other only had been patented. We had already so held in *Thomson-Houston Electric Co. v. Ohio Brass Co.*, *supra*. It is true that in the applications for these patents for improvements there was no express disclaimer or renunciation of the matter of the former application. But that was unnecessary. That application was pending and being prosecuted in the Patent Office, and the fact that the application for the improvement patents did not intend to release his former invention to the public was as well understood as if he had in express terms said so. In order to explain the basis of the improvement patents, it was necessary to state what the improvement was upon, and how it fitted it. Having done this, he claimed what was new, and thereby distinguished what his patent was intended to include."

See also the opinion of Judge Taft in *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 80 Fed. 712 C. C. A.

In his Second Patent Mr. Cohn says that the object of his invention, "is to so design the window opening and to *associate with said window such descriptive matter* as will offer novel and unique possibilities for advertising."

This is a succinct statement of purpose and of the relationship between the design of the window opening and the associated printed matter, and to which relationship and combination frequent reference will be made.

The specifications of the two patents are substantially the same. In the Second Patent the patentee after describing the method of forming this transparency and the use of the border, as quoted above in connection with the First Patent, goes on to say:

“Developing out of this idea of making an unpunctured envelop with a window or transparency for the addressee’s name to appear through is the idea of changing the form or outline of this transparency to correspond with the trade-mark, design, or advertised object of a merchant, manufacturer, advertiser, or other person, company, or firm.

“Fig. 1 shows a transparency in the shape of a cucumber, the trade-mark of a well-known manufacturer of a great many varieties of goods.

“Fig. 2 shows a cigar in transparency and the words ‘Blanco cigar’ in non-transparency on colored opaque field. The number of shapes this transparency may take is almost limitless. Different people might use an envelop with a window in the shape of an oyster, a fish, a cake of soap, and other toilet articles, a cascade, a dress-shield, a biscuit, an article of hardware, and other articles of manufacture, and so on indefinitely, having due regard for the necessary size of the transparency, so as not in any way to interfere with the clear showing up of the addressee’s name inside. The essential feature in this connection is a window which in general outline is characteristic of a symbol of trade. By ‘symbol of trade’ is meant any design such as mentioned above or trade-mark characteristic of certain goods or the product of a certain manufactory.

“When the window-opening is formed by the application of a grease or equivalent compound to the envelop-blank, the colored or stained window is essential to the production of a window of properly-defined outline.

“I thus produce a most unique and at the same time inexpensive and effective advertising medium. Every one needs envelops. These advertising-envelops can be made at small expense. They can be made of any shape or size and made to fit the stationery rather than the stationery made to fit the envelop. They can be used not only for mailing, but for sending out circulars and the like by messenger. The characteristically-shaped window and the associated letters and colored background constitute a most striking advertisement to attract public attention, the object of all advertising. I do not wish, however, to limit myself in the application of this idea of an envelop having a window which in outline is characteristic of a symbol of trade to envelops made originally from non-transparent stock, as above described, for I may employ a transparent stock and form the window-opening by printing with or otherwise applying opaque coloring-matter to a portion of the envelop.

“Generally the window-opening by itself alone and unassociated with any descriptive matter or words forming an essential feature of the trade-mark would have very little significance as referring to a particular manufacturer. For instance, a window in the outline of a bolt might refer to many bolt manufacturers, or a window in the shape of a cigar unassociated with a trade-name would be meaningless; but when there is associated with the window-opening of characteristic or peculiar design a trade-name

or some word or words usually associated with or relating to the pictorial feature every one seeing the envelop is confronted with a striking advertisement of a particular brand of goods of a particular merchant or firm. At the same time the envelop not only performs its ordinary function as a closure, but the transparent portion of the envelop allows the name and address on the inclosure to show through, protects the writing thereon, and obviates the necessity for an address on the exterior of the envelop."

As showing the possibilities of this invention as an advertising novelty, Mr. Cohn states that he had in his possession at the time of the fire in 1906, "some four or five completed envelop specimens of different designs and some *200 sketches*."

Also, that in 1905 he sent Mr. Regenstein specimen envelops, actually made up complete, showing the "Pickle" and "Cigar" design similar to the drawings of the Second Cohn Patent and like the "Cremo Cigar Envelop," Complainant's Exhibit "FF," and also a "Cascaret" design envelop.

Claim 1 of this patent is as follows:

An advertising device comprising an envelop,

1—having a window through which the addressee's name on an enclosure may show through;

2—said window being in outline characteristic of some symbol of trade;

3—a tinted or colored border surrounding and giving definition to said window;

4—and permanent advertising matter forming no part of the address appearing on said tinted border and related to and in juxtaposition with the outline of said window.

In Fig. 1 the outline of the window is characteristic of the “Pickle” trade-mark, or symbol of trade of the respondents, the H. J. Heinz Co. (See bottle and label, Exhibit “D.”)

In Fig. 2 the window is an outline of a cigar. The tinted or colored border which surrounds and gives definition to the window is represented by the *pickle-shaped border* “3” of Fig. 1, and in Fig. 2 it is shown as applied solid over the face of the envelop. The permanent advertising matter consists of the words, “John Doe, 57 Varieties,” in Fig. 1, and of the words “Blanco Cigar,” Fig. 2, which “form no part of the address and are related to and in juxtaposition with the outline of the window.”

Claim 2 of the Second Cohn Patent, is as follows:

As an advertising device, an envelop,

1—having a generally opaque face, except for a transparent window portion on which an addressee’s name on an enclosure may show through;

2—said window being in general outline characteristic of a symbol of trade;

3—and permanent printed matter on the face of the envelop related to and in juxtaposition with the

outline of the window, and co-operating with said outline to indicate a particular brand of goods.

Since the value of all advertising is its effect upon the public, so here with the envelop represented by the above claims, the value and efficacy of the patented envelop is indicated and measured by its effect upon the observer, and this effect is manifested to the observer by what he apparently *sees*. If by an *optical illusion* (as is apparently attempted by the defendant in this case by mere *change in location and form* of some of the elements) whereby that which is printed inside the envelop *appears nevertheless on the face* of the envelop—or whereby the necessary configuration or simulating a trade symbol is represented in a little different manner in one case than in another, but in both cases through the medium of the relationship primarily existing between the transparent area and border, *which together, represent the window*—we have a concrete embodiment of the combination of these two claims. This matter will be again referred to when we come to consider the question of infringement.

It is a singular coincidence in this case, that the defendant, The H. J. Heinz Co. with its well-known trade-mark, was the motive and inspiration of Figure 1 of the Second Patent in suit; and it is a still more remarkable coincidence that the only two advertising envelops which the Transo Paper Co. and Regenstein have made, are the Heinz envelop and the Stiekney Cigar envelop, Exhibit "E," both pic-

tured in the Cohn patents. A greater tribute to the genius and teachings of Mr. Cohn and an index to the lack of originality in Regenstein can scarcely be imagined. *It is manifest that the designer of the Heinz envelop had before him the Cohn patents when he laid out the Heinz envelop.* (Also compare the cigar envelop, Exhibit E—"Stick to Stickney's" of defendant, with the Cohn drawings and also with the Cohn "Cremo" specimen cigar envelop.)

THE QUESTION OF INVENTION AND MECHANICAL EQUIVALENCY IS OFTEN DETERMINED BY CONSIDERING WHETHER THE INFRINGING DEVICE IS MORE LIKE THAT OF THE PATENT IN SUIT THAN THOSE DEVICES CLAIMED TO ANTICIPATE THE PATENT.

The National Hollow B. B. Co. v. Interchange B. B. Co., 106 F. R. 699;

Dowagiac Mfg. Co. v. Minnesota Moline Plow Co., 118 Fed. 136, C. C. A.

In the present instance, the evidence shows that *the only envelops ever in use embodying the patented combinations are the devices of the appellant and the appellee.*

In *Dowagiac Mfg. Co. v. Minnesota Moline Plow Co.*, 118 Fed. 136, it is said at page 141:

"This question of mechanical equivalents is often well determined by considering whether the infringement is nearer to the patent in suit in its construction and means than those devices

which are claimed to anticipate the patent. When this test is applied, it is perfectly plain that the new structure of the defendants more closely imitates the means used by Hoyt to accomplish the desired purpose, than anything found in the art prior to the patent to Hoyt. There is nothing in the prior art that comes anywhere near so close to an imitation of the complainant's combination. Indeed, it is very plain that defendants' new structure would never have existed, if Hoyt had not taught how to make it. It not only operates the principle in the same way that Hoyt did, but it uses plain mechanical equivalents for every essential element of Hoyt's combination."

THE HISTORY OF THE INVENTIONS COVERED BY THE PATENTS IN SUIT.

THE TRADE—ONLY TWO KINDS OF "WINDOW" ENVELOPS KNOWN TO THE TRADE AND THEY DID NOT ANTICIPATE COHN.

At the time of Mr. Cohn's advent into the field in 1903, there were only two kinds of *mailable* envelopes known to the trade or in use which did not require the addressee's name to be written on the envelop.

In one the envelop blank was punctured in its face portion to form a window opening for an address and name on an enclosure to show through.

This style of envelop gave so much trouble to the Post Office authorities by reason of the unprotected edges of the uncovered opening catching in and clog-

ging the cancelling machine that its use to a considerable extent at least, was suppressed. (R. 112.) It does not now appear to be on the market.

The other kind of envelop was that known as the "Outlook" or Callahan 1902 patent envelop, in which the blank is punctured to form a window opening and from a separate sheet of transparent paper there is cut a blank of the shape of said window opening which blank is subsequently pasted to the inner face of the envelop over the opening. Such a construction is open to several serious objections, such as the extra cost in "puncturing" the face of the envelop; the cutting of the transparent blank, and the pasting of said blank to the inner face of the envelop; but more especially is there the objection of imperfect pasting and the consequent presence of raw edges to be caught and torn by cancelling machines or in the other handling of the mail.

There is also the liability of the paste becoming soft and "sticky" in the presence of moisture and the possibility of the inner or enclosed sheet adhering to the pasted envelop.

It is practically conceded that neither of these old types of envelops anticipate or show lack of invention in the patents here in suit. They are referred to now, simply to show that they represent the sum total of every practical effort in the direction of securing an envelop which could be sent through the mails and have the capacity of securely enclosing and

sealing the contents of the envelop and of revealing that portion only, of the enclosure, bearing the sendee's name and address, thus doing away with the necessity of writing the addressing directions on the envelop itself. These two types of envelops appear to be the only ones that ever succeeded in getting into use and one of those has proven a flat failure.

Everything else in the so-called prior art is purely a matter of theory and speculation; or the borrowing from widely different arts, a bit here and a bit there, and reconstructing under the exigencies of desperate defense and in the light of the teaching of the patents in suit, the Cohn inventions.

But, as is well known to your Honors, "anticipation by reconstruction," is not favored under the law.

THE WANT SUPPLIED BY THE COHN INVENTION.

The testimony of both Cohn and Regenstein, who may be considered experts in the manufacture of envelops having a transparent window, throws new light on the problem and novelty of envelops of the type here in suit.

The history and development of the inventions in suit by Mr. Cohn, the patentee, appears at pages 111 and following of the record.

In brief, it shows that prior to 1902 Mr. Cohn had been using in business an uncovered window envelop

of the first type described and was reluctant to give its use up after objections made by the Post Office. He set about to get up an envelop which would be acceptable to the postal authorities and, as he says:

“I finally concluded that there were two ways of accomplishing this result. One, by taking sheet of transparent paper and rendering it opaque with the exception of the space reserved for the address, and the other by taking a sheet of opaque paper and rendering it transparent in the portion reserved for the addressing space. Shortly after coming to this conclusion, I began a series of experiments. I encountered *very little difficulty in taking a transparent sheet and rendering it opaque* in that portion not reserved for the address, but I found *a great deal of difficulty in taking an opaque sheet and rendering it transparent in a certain portion.*

“I tried a great many different kinds of paper and a great many different kinds of preparations, but was not satisfied with any of the results obtained. The principal difficulty being that whenever I applied the preparation which in every instance was of an oily nature, I discovered that the preparation had a tendency to spread beyond the limits of space where it was originally applied. After much thought I finally struck the idea of printing a border around the transparent portion, and after that all my experiments included this border, and I have always considered it a very essential feature of my invention.”

This is practically the same difficulty experienced by Regenstein.

This discovery took place prior to October 15, 1903, while Mr. Cohn was still with the Illinois Pacific Glass Co., a large business firm of this city. On that date he went to work for the Zellerbach Paper Co.

The glass company had a large printing and label department, which Mr. Cohn made use of in his early experiments. In these early experiments he applied the oil with a brush, but later with a block of wood and pieces of rubber. Finding how the oil would in all instances creep beyond proper limits, he says he consulted Mr. Epting, an artist employed in the lithographic department of the glass company, who made drawings from which a zinco was made. Cohn says:

“Among others was a design showing an oblong space surrounded by a cloud effect. I have in my possession an envelop which was made from the original zincograph. This envelop shows that the ink is applied solidly around the space, which is understood to be the space reserved for showing the address, which I will call the window space, and is gradually shaded off.”

The envelops later made by Mr. Cohn from this zinco are illustrated by the “Cloud-effect” envelops in evidence. (Exhibits N and O.) Concerning this early work, Mr. Cohn says:

“The first ink that I used did not answer the purpose, and *I was obliged to experiment with*

a great many different kinds of ink before securing one that would answer the purpose."

This is another difficulty Regenstein says he encountered.

Mr. Cohn, prior to October 15, 1903, disclosed his invention to Mr. Bean, an expert accountant, and several others who testify in his behalf.

Mr. Cohn says:

"Summing up what I did up to the time of leaving the Glass Company on October 15, 1903, is as follows:

"I conceived the idea of making an unpunctured envelop with a window addressing space.

"I succeeded in making an opaque sheet, transparent by the use of an oily preparation.

"I discovered and applied a printed border around the window addressing space.

"I disclosed my invention to a disinterested party."

All this it is to be understood was prior to the earliest date claimed by Regenstein. It stands uncontradicted on the record and, therefore, is admitted to be true.

Continuing, p. 117 R., Mr. Cohn states that following October 15, 1903, he carried on his work continu-

ously and uninterruptedly for nearly a year, at the printing shop of F. H. Abbott & Co., assisted by their foreman, Mr. Tooker. Mr. Cohn says:

“I found in some instances where I succeeded in getting a preparation that made an excellent transparency, that it would fade out and become almost useless, said preparations would keep the paper transparent for about a month and then for some reason or other, the paper would become opaque again, and in some instances this would occur within a very few hours after the preparation had been applied. I kept persistently at work from the time of my conception until about August or September of 1904, when I brought my invention to a state of perfection. It was at this time that I placed an order for the Zellerbach Company with F. H. Abbott & Company for 10,000 envelop blanks, such as described above, and I still have in my possession a sample, which I here produce.” (Exhibit L.)

These difficulties encountered by Mr. Cohn foreshadowed the same difficulties which Mr. Regenstein says he met with in trying to bring the Transo envelop to a state of perfection, although it was not until 1905, many months *subsequent* to the issue of the 10,000 envelops by Mr. Cohn, that Regenstein or the Transo Paper Co. ever made any *use* whatsoever of a Transo envelop, or an envelop such as Regenstein claims the honor of originating.

Mr. Cohn even introduces an actual specimen of one of his old envelops which is post marked “San Francisco, November 27th, 1 p. m.,” and which was

sent to Manila, P. I., and bears the Manila postmark of December 28, 1904, 3 P. M. (Exhibit M.)

CONTEMPORANEOUS WITH THIS WORK OF MR. COHN IN PERFECTING THE ENVELOP OF THE FIRST COHN PATENT, HE DEVELOPED, TRIED OUT AND ABANDONED AS IMPRACTICABLE THE ENVELOP EXHIBIT R (COHN & SHIPP BRITISH PATENT), MADE FROM "TRANSPARENT" STOCK.

Mr. Cohn (R. 126) says he made up some hand-made envelopes using *transparent paper* and printing the same with opaque ink over the entire surface with the exception of the addressing space, and applied for a patent, said application being filed in the Patent Office on May 9, 1904, Serial No. 207,082. He also applied for a patent in Great Britain, jointly with one J. C. Shipp, June 27, 1904. The application of the United States patent was disallowed. The British patent was granted, and is numbered 14,478, A. D. 1904.

Cohn discovered, however, that the envelopes made by this method were not satisfactory or merchantable, firstly, on account of the transparent paper he was compelled to use was of a very brittle character, and had a tendency to crack; secondly, it was very difficult to seal envelopes of this character, the gum used in the ordinary envelop not adhering to the smooth surface of the transparent paper; thirdly, stamps would not adhere with sufficient strength to

the smooth surface of the paper. The envelopes produced by this method had the similar appearance to the imitation Busch envelop, introduced by the defendant, opposite page 400 in the defendant's testimony.

Cohn says:

"Considering all the objectionable features I abandoned the idea of manufacturing envelopes of this character." (Exhibit R.)

The drawing of the Cohn & Shipp British Patent is shown on the opposite page. It was held by the Patent Office not to anticipate or limit the claims in suit.

THE GENESIS OF THE SECOND COHN PATENT.

Mr. Cohn says that while working on various styles of envelop blanks he discovered that a good use could be made of the necessary border for the purpose of advertising, and made many specimens of envelop blanks embodying this idea, which was conceived, he says, by him "in the summer of 1904" (R. 120). His application for patent was filed November 8th, 1904, and prior to that date he had handed his attorney and solicitor perfected specimens embodying the "cigar" and "pickle" outlines. After filing his application work on this "advertising" envelop was conducted in the shop of Barnhart

Fig. 1.

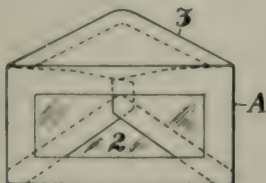


Fig. 2.

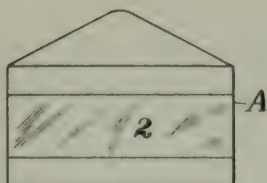


Fig. 3.

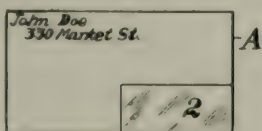
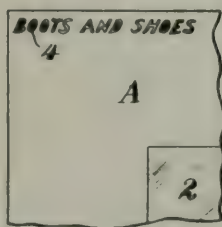


Fig. 4.



Fig. 5.



[This drawing is a reproduction of the original on a reduced scale.]

& Swasey, art printers (See Exhibit R), also "Cremo Cigar" envelop.

"Due diligence" on the part of Mr. Cohn is clearly shown. He says (R. 208):

"I worked continuously and persistently for over a year, beginning some time in 1903 and ending with the production of these 10,000 envelops in 1904, putting in many nights, many Sundays and several holidays. I never at any time desisted from my efforts, but kept on patiently sticking to the object I had in mind, never quitting until I accomplished the object that I sought. During this period I expended some \$3000.00 which may not appear to be a great sum to some people but meant a vast amount to a man of my means. This money I used for various purposes, such as the purchase of different chemicals and oils used in making my preparation; also for ink and paper of numerous nature and consistency. Part of this money was also used in paying for labor which was generally at a high rate on account of the work being done on what is termed as 'over-time.' I also paid to chemists various amounts for work done at my request. I frequently found that after spending much time and money on a certain preparation that the same was useless for my purpose and it was necessary for me to start over again. During this period I did a little work on the envelop described in my abandoned application dated May 9, 1904, but the expenditure of time and money on this particular feature was very trivial."

CORROBORATION OF COHN'S TESTIMONY.

Mr. Cohn is corroborated with respect to his early operations both by a number of witnesses and by documentary evidence, including early specimens of work, Exhibits L-M-N-O-P-Q-R; Collection Statement of April, 1904, Ex. "V" and patent Ex. "W"; Register Receipt Exhibit "X"; Cremo Cigar Envelop Exhibit "FF."

MR. BEAN, a system man, testifies that when he was experting the books of Dunham, Carrigan & Hayden, in the fall of 1903, and on his first trip to California, that he met Mr. Cohn, who was then with the Glass Co., only a few doors away, and went over the plans of their bookkeeping system and general office work with Mr. Cohn (R. 207). At that time Mr. Cohn showed him some window envelopes with a border. Mr. Bean says:

"It was after the style of an Outlook envelop except that the opening was prepared by some process making it transparent. I remember that I told him that I had never seen anything like it before and that I thought it was a splendid thing, and I further thought that in my judgment there would be a good sale for that sort of an envelop. * * * As I remember the samples he showed me they were of rather rough construction and looked as if they had been made up by hand. Some of the samples were flat, just blanks, treated with this preparation. The transparent part was surrounded by a sort of a border or cloud effect. I don't remember much about the samples in detail. * * * In

talking about the matter I told him that I was surprised somebody had not thought about it before and I figured it was merely some sort of oil that was put on the paper to make it transparent, and he said that it was an oily preparation and that that was one of the secrets and that the border was to keep this oil from spreading."

Mr. Bean substantiated his recollection by reference to the books of the Baker-Vawter Co., of Chicago, by whom he was employed in 1903, and the same shows that the contract for Dunham, Carrigan & Hayden was dated August 14, 1903, and that the bill rendered Dunham, Carrigan & Hayden was for fourteen days' service between August 14, 1903, and October 31, 1903 (R. 223).

MR. SELLING, a salesman with the Illinois-Pacific Glass Co., testifies to the disclosure to him by Mr. Cohn in 1903 and before Mr. Cohn left the Glass Co. of the subject matter of the invention in issue including the envelop of opaque stock with a transparent window with a cloud effect border (R. 213-9).

MR. EDWIN EPTING, an artist in the Label Department of the Glass Co., at the time Mr. Cohn was employed there testifies (R. 247) and following, that Mr. Cohn disclosed to him his invention for an envelop of opaque stock with a transparent window portion and surrounding border and asked Mr. Epting to get him up some designs, including the "cloud effect." Also that they had zincos made (Q.

12) before Cohn left the Glass Co. (X. Q. 19, R. D. Q. 22).

WILLIAM DOLGE testifies that he succeeded Mr. Cohn at the Glass Co., as bookkeeper and chief accountant, on Oct. 13, 1903 (R. 251), and that he first met Mr. Cohn the first two weeks of October, 1903 (R. 252).

JOHN C. TOOKER, a pressman, and foreman of the press room of F. H. Abbott, where all of Mr. Cohn's work on his envelopes was done, testified (R. 234-47) fully and unequivocally as to the operations of Mr. Cohn in the latter part of 1903, and up to September, 1904, when the 10,000 envelopes subsequently used by the Zellerbach Co. were completed as a perfect, commercial product.

As to these operations Mr. Tooker says:

"The envelop was to be used in mailing matters. The feature of it was that it would be an opaque envelop with a transparent space through which it would be possible to see the writing of a portion of the matter enclosed therein. It was printed from a zinc block with a hole to allow for the preparation which would be applied that would make the paper transparent in the vacant space in the zinc. The metal was so etched out that it left a border which would cover around the place where this application for transparency was to be applied. We experimented in this matter for nearly a year. * * * It was no easy task to get the desired result. First, we had trouble in getting

the desired inks and the preparations; I mixing some of the inks and Mr. Cohn supplying me with that he got outside. All of the mixture for transparency was supplied by Mr. Cohn. There was quite a bit of trouble in getting the printing press to handle these different preparations, which required a good deal of time and thought. We had a great many difficulties to overcome, the main one being to get the desired transparency which he finally succeeded in getting. In getting this preparation we met with an obstacle which caused us a good deal of hard labor. That was to keep the preparation from spreading all over the sheet, or running, as the printer terms it. We put on the preparation on the paper first from a wood block, then we used rubber and different kinds of straw-board and card-board; also pulp wood, but they seemed to carry too much of the preparation which spread out on the outside of the printing space, giving it a tendency to flow further over the sheet. We finally tried felt, which seemed to work more satisfactorily with a little help in 'make-ready.' There was a tendency to spread from this preparation, which would have to be overcome by what printing pressmen call 'make-ready,' which I managed to overcome by cutting a piece of pulp board and gluing to the cylinder to press the sheet tightly on the felt, which would make the preparation sink into the paper and still permit you to carry less of the preparation thereby having that much less pushed on the outside of the felt, so that it would not spread. This piece of pulp-board was cut smaller than the felt, which made the impression on the paper a little away from the border, thereby allowing a little spread so that the preparation would not flow beyond the border, and thereby make the paper transparent, further than Mr. Cohn had

figured in working out this proposition; his idea being as I understood, to have the envelop entirely opaque, with the exception of the transparent space in between the border. We finally got to the place where we could turn out these envelops with the preparation covering the desired space and not spreading too far. He then gave an order for 10,000 of these envelops to be printed, which I printed about September, 1904. I base the date of the time of printing on the fact that I took my vacation at that time and some of the money which he paid me for my services went toward paying for my vacation. I do not remember of having done anything for him after that time. The envelops were printed and delivered to him and as far as I know all used up."

Mr. Tooker in explaining the manner of getting around the difficulties of impressing the oil on the paper and trying to reduce the creeping effect, introduces the drawing, Exhibit GG, illustrating the piece of pulp board, cut smaller than the felt. *This illustrates that the ordinary presses were not suitable for doing this sort of work and had to be specially rearranged, as pointed out in the quotation above.* This is the same difficulty met by Regenstein.

On page 244, Printed Record, Mr. Tooker testifies as to the difficulty in getting and keeping the presses clean and using heat under the presses. He says:

"We found another difficulty in using some of the preparations, and it became necessary in order to make the preparation flow as freely as

was necessary to use gas stoves under the press; heating the plate and making the preparation run out smoothly. We finally got these things so that the preparation run perfectly. The transparency that we reached in the earlier stages was inclined to be more dirty and mottled, not smooth. I am sure that around the Holidays of 1903 was the time when we first used the stoves; it being the winter time, and the preparation not having inclination at that time to flow freely."

This is the testimony of an "old printer" and an expert and shows clearer than most anything else in the record how difficult the problem involved was. *It is conclusive proof of invention.*

Mr. Tooker identified Exhibit L as one of the batch of envelops made (Q. 9) by the *scratch on the original zinco* and the *effect of which shows on said Exhibit L.*

Mr. Tooker says that it was during the summer of 1904 that the "advertising" feature was developed, including the "Heinz Pickle" and the "Cremo Cigar" envelops (Q. 22). He says, by way of identification of the latter:

"Looking at the envelop I see the outline of the piece of pulp board which I used on the cylinder of the press to smash in the preparation on the paper, making it transparent. This envelop has the words 'Cremo Cigar' in white letters on its face. You will notice in looking

at the envelop a ragged edge appears where the impression of the preparation was applied to the envelop, and not covered by the green border. That was done by me to press the preparation into the paper.”

Tooker (Q. 25) also identifies the “Cloud effect” envelops, Exhibits N and Q, by the streak on the left hand side of the envelops, which was done accidentally at the time of printing by a sheet of paper being caught and smashed down on the plate.

MR. VANDERSWIEP, R. 231-4, testifies that as mailing clerk for Zellerbach Paper Co. he used the 10,000 Cohn envelops (per Exhibit L), in the latter part of 1904.

JUST AS IN THE COURT BELOW, DEFENDANT’S ARGUMENT
IS MAINLY BASED ON HYPOTHESIS AND INUENDO.

On pages 110-111 of his Brief, appellant advances the frequently repeated hypothesis that “presumably” Cohn’s earliest samples were not produced until subsequent to May 9, 1904. As rebutting this *supposition* of defendant we have the *actually testimony* of Cohn and his witnesses as to his work while with the Glass Co., using a brush to apply the oily preparation; the manufacture of the zincos with the cloud effect, and the use of stoves in the winter of 1903-4 under the printing presses around the Christmas holidays of 1903, all of which would have been

unnecessary to produce envelops of transparent paper.

The appellant's contention (pages 110-111 of his Brief) that the transparent envelops Exhibit "R" *presumably* represent the sum total of Mr. Cohn's operations prior to filing his subsequent abandoned application, May 9th, 1904, is not only at variance with the testimony of Mr. Cohn, Mr. Epting, Mr. Tooker and Mr. Bean, but is inconsistent with the "cloud effect" zinco and with the early 1903 specimen envelops made from this zinco.

In order to make an envelop such as Exhibit "R" it is *necessary* to print a heavy body of opaque ink over the *entire* surface. It would be absolutely impossible to make an envelop like Exhibit "R" by means of a zinco showing a "cloud effect" since such an envelop would be worthless as it would leave part of the face and the entire back of the envelop transparent.

Again on pages 112-124, defendant attempts to capitalize his hypothesis by reason that the envelops introduced by Mr. Cohn bear the mark "Patent Pending." *Cohn never said that the words "Patent Pending" or "Patent Applied For" were not on the original cloud effect "Zinco," but were set up in type and printed on the envelopes later.* Mr. Cohn has fully explained how all his early specimens were destroyed by the fire of 1906. It is also note-

worthy that the defendant frankly concedes the possession of the invention and its reduction to practice by Mr. Cohn in the summer of 1904.

This matter of argument by "guess-work" constitutes the main asset of the defense.

When all has been said we submit that even though Cohn were limited to a reduction to practice in the summer of 1904, the specimen envelopes he has introduced are much better evidence in support of his claim to priority than are the Regenstein 1904 envelopes, on Regenstein's behalf, because the *latter show on their face that they could not have been produced outside of an envelop factory*, and the appellant's Counsel in his Brief practically admits, as he must, that they were machine-made. It is also indisputable that Mr. Cohn actually *used* his envelopes in 1904 while Regenstein does not even claim that he ever used a single envelop before 1905.

COHN'S ABANDONED APPLICATION MAY 9, 1904.

On page 111, Appellant's Brief, it is attempted to make capital out of the fact that this application was applied for first. Because Mr. Cohn happened to apply for a patent on the transparent stock envelop cuts no figure one way or another. In the first place this old abandoned application does not nor is it claimed to, constitute any part of the prior art, since it is in no sense a "printed publication." The same

rule applies to this, that does to the Reese abandoned application. (*Interurban Ry. & T. Co. v. Westinghouse Elec. & Mfg. Co.*, 186 Fed. 166, 168, C. C. A.). In the second place the fact that the subject-matter of the first Cohn Patent was invented prior to May 9, 1904, is not inconsistent with the complainant's testimony or that of his witnesses and with his legal rights in the premises; for as was said in *Ide v. Trorlicht, Duncker & Renard Carpet Co.*, 115 Fed. 137, 144:

"Concede that the applications of February 20, 1888, prove that Ide had invented the improvement here under consideration before those applications were filed. *There was no law which required him to apply for a patent upon his invention as soon as he made it.* The acts of Congress gave him the right to apply for and to obtain a patent upon his combination at any time after he conceived it, provided only that his invention had not been 'in public use or on sale for more than two years prior to his application,' and that it was not 'proved to have been abandoned.' Rev. St. Sec. 4886. There was no evidence of any prior use or sale of this improvement. *Clear evidence of an intention to dedicate an improvement to the public is indispensable to establish an abandonment.* There was no evidence of an abandonment at the hearing of this case, and the patent in suit and the application upon which it is based are persuasive proof that Ide never intended to dedicate, and never did dedicate the improvement they secure to the public. *Mast, Foos & Co. v. Dempster Mill Mfg. Co.*, 27 C. C. A. 191, 195, 82 Fed.

327, 331; *Woolen Co. v. Jordan*, 7 Wall. 583, 607, 19 L. Ed. 177; *Adams v. Jones*, 1 Fed. Cas. 126, 127 (No. 57); *Babcock v. Defener*, 2 Fed. Cas. 293, 297 (No. 698); *Jones v. Sewall*, 13 Fed. Cas. 1017, 1027 (No. 7,495); *McMillin v. Barclay*, 16 Fed. Cas. 302, 326 (No. 8,902); *Pitts v. Edmonds*, 19 Fed. Cas. 751, 757 (No. 11,191).''

THE DEFENSES

THE DEFENSE.

The Defenses are:—

First: That Cohn was not the original and first inventor or discoverer of the things patented, but that the honor belongs to Regenstein, or to one Reese, now dead.

Second: That the patents are void for anticipation or lack of invention, or else are so limited in scope that the claims cannot be construed to cover the Defendant's structure.

Third: That the Cohn inventions did not represent patentable subject matter.

The First and Second Defenses will be considered in the order stated.

The Third is more properly considered under the head of Invention.

I.

The earliest date that Regenstein lays any claim to the invention in suit is January, 1904, as against Cohn's established date of October, 1903.

Regenstein approached the subject matter of the present controversy originally along lines which he himself considered to be wholly independent from anything theretofore existing, and that a one-piece

envelop of opaque stock with a window portion for the address to show through and omitting a ring or border was an entirely novel proposition, and constituted patentable subject matter.

Regenstein states that his attention was first called to the envelop business by a man named Reese, of the American Can Co., who later took out a patent, No. 766,902, dated August 9, 1904, introduced in evidence, which patent date appears on all the Transo envelops. This Reese patent is simply on a sheet of paper having a number of transparent window portions, without borders, scattered over its surface, and the so-called invention is in so placing these windows that a maximum number of envelop blanks can be cut out of the sheet with a minimum of waste. The drawing of this patent appears on the opposite page.

The Reese application was filed January 15, 1904. It is not claimed that this Reese patent anticipates or discloses the Cohn inventions here involved.

Immediately prior to this application, Regenstein and Reese had submitted to Mr. Banning, their attorney, at the same time they took up with him the subject matter of this Reese patent, the idea of the *single envelop* itself as cut out of the sheet (R. 268). This *single envelop* was simply a piece of paper with a "grease spot" on it for forming the transparency and *did not show any border* around the transparent portion (Q. 49, R. 270). Mr. Banning (who is counsel for the defendant) gave his opinion that *both*

No. 766,902.

PATENTED AUG. 9, 1904.

G. REESE.
PAPER FOR MAKING ENVELOPS.
APPLICATION FILED JAN. 16, 1904

40 MODEL

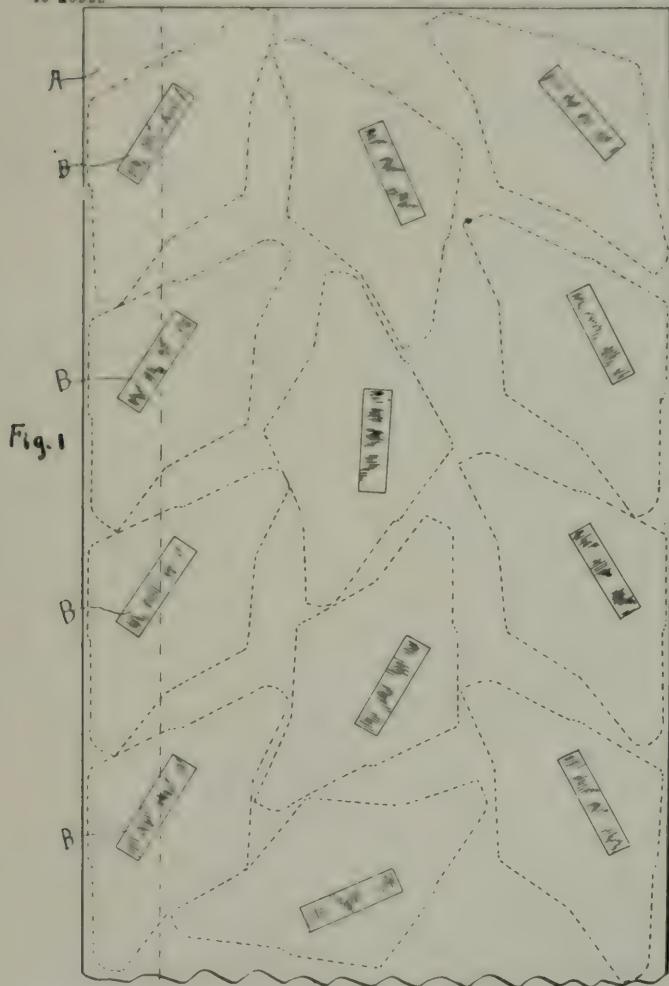


Fig. 1

Fig. 2

Witnesses:
William H. Wood
Walker Banning

Inventor.
George Reese
By *Banning & Banning*
Attys.

these inventions of Reese and Regenstein were patentable; Mr. Banning's letter of December 16, 1903, to that effect appearing in the Record at R. 268, and is as follows:

“December 16, 1903.

“Mr. Julius Regenstein,
 “135 Adams Street,
 “Chicago, Ill.

“Dear Sir:

“We have looked up the patent on the ‘Outlook’ Envelop, of June 10, 1902, and find that it was issued to Americus F. Callahan, of Chicago. The patent has one claim and it is limited to ‘an envelop having a comparatively opaque face and a display opening therein having a transparent covering,’ etc. From this you will see that there must be an ‘opening’ in the envelop and that it must have a ‘covering’ which is separate and distinct from the body of the envelop. It would appear, therefore, that the envelop shown by yourself and Mr. Reese *will not infringe the Callahan patent*. It has no ‘opening’ and no ‘covering’ for such opening.

“We consider that the envelop which you showed us is patentable over the envelop claimed in the Callahan patent. We further consider that the paper manufactured with opaque portions and transparent portions properly spaced and arranged to permit the envelop blanks to be cut out *is also patentable*. These two patents, however, will have to be applied for and taken out separately, *inasmuch as envelops form one class in the Patent Office and paper another*. Two patents will have to be taken if it is desired

to cover both the envelop and the paper from which it is made.

“Yours very respectfully,

“BANNING & BANNING.”

BY THIS LETTER DEFENDANT-APPELLANT IS ESTOPPED TO DENY THAT THE COHN INVENTIONS DO NOT PRESENT PATENTABLE SUBJECT-MATTER.

The Callahan Patent referred to is No. 701,839, June 10, 1902, introduced in evidence and covers the two-piece “Outlook” envelop which is also in evidence as “Defendant’s Exhibit Callahan Patented Envelop.” The drawing of this patent appears on the opposite page.

Immediate action was taken by Regenstein and Reese on the advice of Messrs. Banning & Banning and accordingly on January 15th, 1904, two applications for U. S. Letters Patent were filed: one which resulted in the Reese patent aforesaid and the other on the single envelop of opaque stock with a transparent portion without a border, which latter application was finally rejected by the Patent Office examiners and became abandoned.

(The file of this abandoned Reese application is in evidence as Complainant’s Exhibit H.)

If we turn to the Reese patent of Aug. 9, 1904, and to the Reese abandoned application, it is immediately manifest how different the inventions therein de-

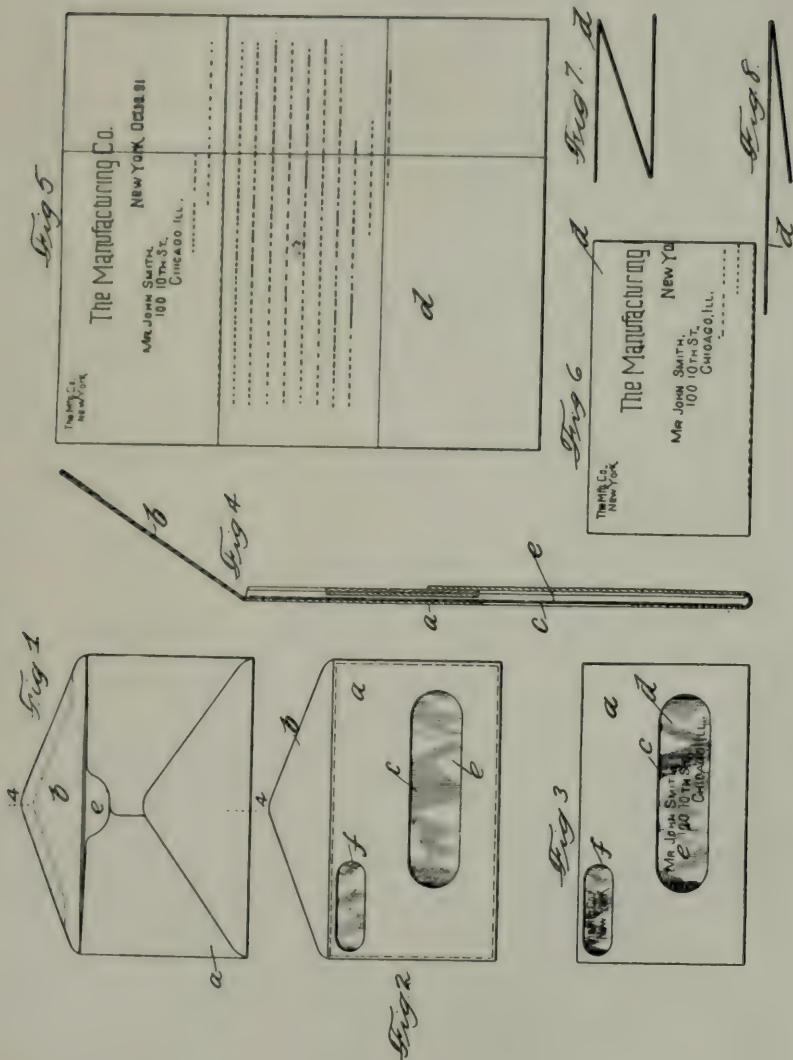
No. 701,839

A. F. CALLAHAN.
ENVELOP

Patented June 10, 1902.

(Application filed Dec. 9, 1901.)

(No Model.)



scribed are from the Cohn inventions, and from the defendant's infringing envelop and also from Regenstein's so-called Jan. 1904 envelop.

In the Reese abandoned application, Reese says, after stating that the object of his invention is to provide an envelop having means for displaying the address written on the enclosure to be legible through the envelop (which of course was the object of the old Callahan "Outlook" envelop) :

"The body and flaps of the envelop, as shown, are formed of opaque paper of any suitable composition, and within the opaque body of the envelop is located a transparent portion F which is formed integral with the substance of the rest of the blank, and *said transparent space may be formed either by making the portion of the envelop constituting the transparent space of less thickness than the rest of the blank or by applying an opaquing substance such as ink, paint, or similar material to the rest of the blank, or by applying a substance, such as oil, to the space desired to be rendered transparent. It is preferred, however, to employ the first method and to make the transparent portion of less density or thickness. By making the blank in this manner the completed envelop will be much stronger and more durable than an envelop from which a portion has been cut away, or than an envelop having a transparent paper pasted over an aperture therein.*"

The paragraph above quoted is paraphrased in the Reese patent No. 766,902, of August 9, 1904, in the following language:

“The body of the completed sheet of paper will be opaque, and the spaces, which are formed integral with the body of the paper, will be transparent or semitransparent in one of the following ways: *first*, by reason of the *less density or thickness* of the paper at the positions indicated due to a greater pressure or to other means being provided in the manufacture of the paper to obtain this result; *second*, by the application of paint, ink, or similar opaqueing substance to all portions of a *transparent paper* with the exception of the intended spaces, which in this case also will likewise be of less density than the remaining portions of the sheet, since the opaqueing substance when applied forms a portion of the substance of the completed sheet, and, *third*, by the application of *oil* or similar substance to an opaque paper at those points which it is intended to render transparent. It is *preferred, however, to employ the first method and form the sheet of paper with a series of spaces therein of less density* than the surrounding material, but integral therewith.”

In the above quotation it will be noted that the method of producing the transparency is expressed in the *future* tense; that is, a sheet of paper “*will be* transparent, or *semi-transparent* in one of the following ways,” etc., thus conjecturally stating how the thing *might* be done, rather than expressing how and what *has* been done; although *Regenstein testified that before these applications were filed on January 15, 1904, he had already produced envelops from transparent stock, having a transparent window portion made by the application of oil, which window portion was surrounded by a border to*

obliterate the tendency of the oil to creep into the surrounding stock. Nevertheless, in the face of these alleged activities, Regenstein not only neglected ever to file any application for a patent on this alleged "early in January, 1904," concrete embodiment, but in the two applications which he was instrumental in having Reese file at that time, he only incidentally and as an alternative method mentioned the use of the application of oil for forming the transparency, but emphasizes his *preference* of the employment of his first method of forming a transparent portion "by reason of the *less density or thickness* of the paper—due to a greater *pressure* or to other means, being provided *in the manufacture of the paper.*" He is evidently undecided as to the choice between *pressure* or "other means" for making the window portion "of less density or thickness." Whatever method he adopted to produce the area of lesser density he expected to accomplish that result "in the manufacture of the paper." It seems sufficient to state that neither Regenstein, nor the Transo Paper Co. had, as far as the evidence shows, ever made any envelops in which the window portions were formed according to his so-called "preferred method" of the first patent. He has offered nothing in evidence showing anything conformable with any of the disclosures in these early Reese applications.

THE REESE PATENT OF AUG., 1904, CANNOT UNDER ANY CIRCUMSTANCES BE CONSIDERED AS PART OF THE PRIOR ART AS IT WAS NOT PUBLISHED (IN FACT NOT

APPLIED FOR) TILL AFTER COHN'S INVENTIVE ACT WAS COMPLETED.

“A patent, to constitute a part of the prior art is judged by its date of issuance; not by its date of filing, nor by the date of its patentee's inventive act. Again, a patent, to be part of the prior art, must bear date of issuance prior to the date of the inventive act, as proven by the testimony of the patentee of the patent in suit.”

Bates v. Coe, 98 U. S. 31;

St. Paul Plow Works v. Starling, 140 U. S. 184;

Diamond Drill and Machine Company v. Kelly Bros., 120 Fed. 282;

Anderson v. Collins, 122 Fed. 451;

Consolidated Ry. Co. v. Adams & Westlake Co., 161 Fed. 343.

Neither is the Reese rejected application sufficient to establish priority of invention under the Statutes.

An abandoned application adds nothing to the sum of human knowledge; is not a publication; and is not an anticipation.

Automatic Weighing Machine Co. v. Pneumatic Scale Corp., 166 Fed. 288, 297, C. C. A.

The Corn Planter Patent, 23 Wall. 181;

Lyman Ventilating & Refrigerating Co. v. Lalor Co., 1 Ban. & Ard., 403 Fed. Cas. 8632;

Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co., 1 Ban. & Ard., 177 Fed. Cas. 10,337.

THIS REESE PATENT AND THE REESE ABANDONED APPLICATION, ASIDE FROM THE BANNING & BANNING LETTER OF DEC. 16, 1903, REPRESENT THE SUM TOTAL OF REGENSTEIN'S DOCUMENTARY EVIDENCE, AND THEY ARE ALL CONTRADICTORY OF REGENSTEIN'S CONTENTIONS.

It is conceded that neither of these Reese-Regenstein concepts anticipate the Cohn inventions. They are interesting merely as showing that the genesis of the perfected Transo envelop was *not* in these earlier conceptions and experiments of Reese and Regenstein.

Turning now to the evidence given by Regenstein: he explains (R. 270) that the envelop showed Messrs. Banning in December, 1903, and referred to in this letter, while made transparent by the use of oil or grease *had no* border and he could not remember the shape of the window, whether it was oval or square.

However, Regenstein attempts to prove that he or Mr. Reese was the first inventor, which one is not

clear from the testimony, of the subject matter of the First Cohn Patent, and has introduced in evidence two envelops identified as the defendants' "1904 envelops." They bear a general resemblance to the regular Transo Stock envelop, except that the ring of the so-called "1904 envelops" is only about *one-half the width* of the regular Transo ring, and about one-half the width that Regenstein says is necessary in order to insure a covering of the creeping tendencies of the oil (R. 277). "The ring should be at least one-quarter of an inch wide to be safe."

Also this so-called "1904 envelop" has the oil printed on the *same side of the sheet with the ring*, while the regular Transo envelop and the defendant's infringing envelop has the ring and oil applied to opposite sides of the sheet, as called for by the Cohn patent. We are frank to say that the testimony relating to the origin and history of these so-called defendant's "1904 envelops" is not satisfactory nor convincing, and in many parts is contradictory and is to be received with caution.

Regenstein called several witnesses, former and present employees to corroborate his date of January, 1904; but their testimony as to dates is wholly unsatisfactory, and with one accord they decide that they saw the '04 envelops prior to the date of a certain strike which took place in the shop of the American Colortype Co.

When witnesses try to remember what took place 7 or 8 years back, concerning *that which Regenstein*

would have us believe was an incident of most trivial and fleeting importance, it is certainly a strain on one's credulity. Of course for Regenstein to magnify the event would be to confess a new discovery. But to most of Regenstein's witnesses a Transo envelop impressed them at the time as something decidedly novel. The idea no doubt did strike them as novel as it unquestionably struck Regenstein, but they no doubt have been mysteriously inspired with one accord to fix the date of the miracle as January, 1904, "before the strike."

Our opinion is, and we wish to impress it most strongly on the Court, that in all probability these so-called "January, 1904, envelops" of defendant, were at the very earliest made in January or February, 1905, and probably about the time that Regenstein left the American Colortype Co. and organized the Transo Paper Co. Not only is this view the most consistent with the facts of the various applications and patents filed by Regenstein and Reese during 1904 in this and foreign countries, and with the fact of the beginning of operations of the Transo Paper Co., but is also consonant with the various occupations followed by Regenstein.

Regenstein says (R. 295) :

"For four years my business was the business of a photo-engraver, making all kinds of printing plates. In addition to this business, I, in 1894, went into the business of making and printing three-color plates. Three gentlemen

and myself started this art of three-color printing in this country in 1894. I supervised and criticised the work and was considered one of the foremost critics and experts on fine plate printing. *Since 1905*, I am actively engaged in the printing and manufacturing of envelopes, and late in 1903 and 1904, in connection with my business as a color-printer, I manufactured and *experimented* in the matter of Transo envelopes."

Mr. Regenstein by a series of grossly leading questions, states that during the "first part of January, 1904," he made envelop blanks transparent by the use of oils (R. 271). That *after* the blanks were made transparent *he discovered* "that no matter what oils we used the oil would bleed or be out of register" (R. 271); that "as soon as we found out early in January that the oil was found to bleed some, as old printers, we decided that we had to go back to our old trick and print a border which was intended to cover such bleeding of the oil which could not be prevented" (R. 271).

It is to be observed that prior to this date evidently *he did not know oil would creep or bleed*.

He also states that he spent some time *experimenting* with various *sizes* and *colors* of blocks.

In other words, in December, 1903, when he submitted the envelopes to his Patent Attorneys as indicated by the above quoted letter, and when they filed their applications for patent January 15, 1904,

neither he nor Mr. Reese realized the necessity, nor had the conception of the patented *combination* of Mr. Cohn.

CREDIBILITY.

In an attempt to corroborate him as to his claims to inventorship and priority, Regenstein calls as witnesses Ernest Sauerman, a pressman in the employ of the Transo Paper Co.; Joseph Wien, an employee of the Regenstein Colortype Co.; Gustaf Olson, an engraver; Max Lau, secretary of the American Colortype Co., of which Regenstein was formerly manager; Adolph G. Voss, cashier of the American Colortype Co.; Behrens, a salesman for the American Colortype Co. Of these, Sauerman is vacillating, and knowing the date to be established in aid of his friend, and that it must be "before the strike" is of course a willing witness. Wien is evidently not telling the truth; and if he is, it is impossible to tell which statements constitute the truth. Olson is shown the sample envelopes of 1904 *face up* with the words written across their face "Defendant's January, 1904, envelopes" and is then asked to remember when those envelopes were made! Lau and Voss both in so far as they *contradict* Regenstein as to the nature of the sheet they saw, prove the year 1905 as the real date, for the so-called January, 1904, envelopes. Behrens, who says he left the employ of the American Colortype Co. the latter part of May, 1904, and returned to them in February, 1906, fixes

no definite time when he first saw the old 1904 envelops, except he says in answer to leading questions that it was before he left his position in the latter part of May, 1904. Under the circumstances and the nature of the giving of all the testimony it is equally believable that he could have seen Regenstein's operations in 1905.

EVIDENCE OF DOUBTFUL PROBATIVE FORCE WILL NOT OVERTHROW THE PRESUMPTION OF NOVELTY AND ORIGINALITY ARISING FROM THE GRANT OF LETTERS PATENT FOR AN INVENTION.

Parker v. Stebler, 177 Fed. 210, C. C. A. 9th Cir.

The testimony of Regenstein and his witnesses comes far from measuring up to the standard of proving priority of invention or prior use beyond a *reasonable doubt*. In spite of the schooling that Regenstein evidently gave all of his witnesses and kindled the spark of recollection by the ever-memorable strike of the pressmen in 1904, which strike by a strange inspiration of unanimity, is referred to by all the witnesses, it is strange to observe how the witnesses fail to agree among themselves on all important particulars except the date, "the early part of January, 1904."

Regenstein says in answer to X. Q. 65, in referring to the old "January, 1904, envelop" Exhibits, "the

envelops I hold in my hand are some of the very first envelops we made in January, 1904."

Sauerman answered when asked Q. 26 (R. 350) if he could tell when he first saw envelops made out of paper that he had printed with oil and rings around the transparency. He answered:

"I can't remember the exact date."

He says (R. 350) that *he cut out some envelops by hand and folded them himself*, and later on he identifies the defendant's old "January, 1904, exhibit envelops" as two of those which *he had printed, cut out and folded himself*.

We would direct the Court's attention to the fact that these so-called "January, 1904, envelops" of the defendant are *die cut* and not hand cut; that they are cut with a steel die and *folded either by machinery or by an expert envelop maker*, as pointed out by Mr. Cohn (R. 159):

"The envelops referred to, defendant's exhibit No. 1 and No. 2, known as January, 1904 envelops, *were cut with a regular envelop die*. Dies of this character are quite expensive and are only kept at envelop factories. The envelops no doubt were folded and pasted by hand; the gum on the sealing flap also being applied by hand. The work, however, was done by an expert envelop maker, as no amateur could have made as perfect an envelop, and when I say a perfect envelop I only refer to the construction of the envelop, and not to the transparent portion,

which I do not consider perfect. It is a very difficult matter for an inexperienced person to fold and paste an envelop by hand, so as to give same a neat and finished appearance. It is still more difficult for an inexperienced person to apply the gum on the flap. The envelopes in the exhibits referred to, were prepared in the manner that is customary with experienced hand-made envelop makers, and is accomplished by taking a series of envelopes with the flaps turned up or opened out, one on top of the other, spacing same apart so as to leave sufficient width exposed along the edge of the flap to take the gum. A brush previously dipped in the gum is then run over the exposed edges by hand, applying the gum to each one successively, with the brush always moving in the direction of the opened up flaps. Any one familiar with the envelop business can immediately recognize envelopes prepared in this manner, because the extreme ends generally show an abrupt square appearance, parallel with the ends of the envelopes. They are further identified on account of the inner edge of the gummed area being parallel with the outer edge of the flap."

Consequently these envelopes now before the Court as "exact specimens" of the "very earliest work" done by Regenstein on his behalf and which he says were "hand made," *are not what they purport to be, but belong to some later date.* Our theory as already expressed is, that these so-called "1904 envelopes" were made probably in the spring of 1905, when the Transo Paper Co. began business, and were probably some of the first envelopes that they turned out. They have not introduced into evidence any *December*,

1903, envelops without the ring, nor any 1905 envelops; but it is manifest that they were doing a good deal of experimenting in 1903, with opaque ink, and narrow and wide borders, and it is to this period of 1905 experimentation that these so-called "January 1904 envelops" undoubtedly belong.

We are told by the witness Wien (R. 368, X. Q. 111) that there were no envelop machines in the factory of the American Colortype Co. The Company had no one connected with it, nor were any of its employees in the envelop business, nor had any of their employees ever been in the envelop business, and none of its witnesses were shown to have been skilled in the art of cutting or folding envelops.

We are constrained to advance the opinion that these so-called "January 1904 envelops" were cut and folded by an expert envelop maker in the factory of the Transo Paper Co. some time *subsequent to January, 1905*, or one year later than claimed by Regenstein. This theory is borne out by the testimony of Max Lau (R. 391 and following) that the envelop he saw Regenstein working on was a blank in *sheet form* (X. Q. 34), and that this sheet was "laid out in such a way to make envelops out of it" (X. Q. 37); "with *several window transparencies* on the one sheet with a border around each transparency" (X. Q. 40); "so that several envelops could be cut out of the printed sheet" (X. Q. 41); "*similar to Complainant's Exhibit 'G'.*"

Regenstein testifies that in 1904 he only made *one envelop blank at a time* on a Universal Press, and that it was not until 1905 when he organized the Transo Paper Co. and purchased *special presses* whereby he was able to print a number of transparencies on a single sheet in one operation (R. 573).

Regenstein says (R. 313, X. Q. 226) "a stock envelop today is printed on a cylinder press; at the time the No. 2 envelop was made we prepared only one envelop in one operation, now in one operation we print twenty-four."

Therefore Lau's testimony is effective only to prove the date of 1905 for these "early" Regenstein operations.

The witness Voss, who after stating that he was attracted to the early work of Regenstein by the unusualness of the work, and the peculiar shape of the ring plate, Q. 19 (R. 408) says also that his recollection is that the sheet was printed with a *group of three or four transparent portions* (R. 413).

Wien, sworn and examined on behalf of the defendant, testifies that he was working in the shop of the American Colortype Co. at the time Regenstein got up these envelopes in 1904. *First* he testifies in answer to Q. 13 (R. 355) that *Sauerman* put on the oil on the envelopes, and *later* in answer to Q. 23, he says:

"*I printed the oil on the paper and later in the afternoon I printed the border around the window.*"

In answer to X. Q. 50 he declines to answer whether he had ever seen before this suit was brought, the two precise envelops before him. He also declined to answer X. Q. 63-64 when asked to state when he joined the Franklin Union, and when he made application therefor. He also declined to answer X. Q. 84, when asked "what was the general comment around the shop when this old envelop No. 1 and No. 2 was produced?"

He also declined to answer X. Q. 75:

"X. Q. 85. You said that one of the difficulties you had in getting up that old envelop, or printing it, rather, was to find a proper opaqueing. Please give us a detailed statement of just the steps you took, or the experiments you made before you arrived at what you thought was a satisfactory result?"

"A. I decline to answer."

Mr. Bann-
ing's Note
See Rec.
372.

Wien having testified that Sauerman printed the oil and then that *he* Wien had printed the oil, again reverses himself, X. Q. 101, when he says that Sauerman printed the two envelops before him, Defendant's Exhibit "1" and "2," and finally in answer to X. Q. 117 he admits he had nothing to do with them.

Certainly such evidence as this does not convince "beyond a reasonable doubt" that Regenstein was the first inventor of the subject matter here in issue.

Olson, the lithographer who is alleged to have made the very first ring plates for Regenstein, and was called to substantiate Regenstein's testimony, is shown the two "1904 envelops" *face up* with the legend printed on them "Defendant's Exhibits January, 1904, No. 1 and 2," and then of course is able to state that it was in January, 1904, that he made the ring and saw these envelops. On behalf of Complainant there was forthwith entered the objection to Q. 45 (R. 381) that it was leading, "in that the witness has just had before him and has carefully examined the two envelops referred to, and has attempted to identify them, or certain work that he did on them, and that on the face of each envelop there is printed, on a typewriting machine the date which it is evidently desired shall be given by the witness in his question."

Of course the effect and mode of asking such a question was to tell the witness the desired date which the witness forthwith proceeded to give.

Therefore, we submit to this Honorable Court that all of this witness's testimony, as far as it relates to this matter of dates, must go out as having been improperly educed.

Giving Regenstein the benefit of the doubt and overlooking the potency of the "strike" as a memory intensifier we have only Sauerman and Behrens to support him whilst Lau and Voss flatly contradict him.

From Regenstein's testimony, it appears he did nothing whatever in the envelop line between January 15, 1904, when he filed the Reese application, and February, 1905, when he organized the Transo Paper Co.

The undisputed evidence shows that it was subsequent by several months to November 8, 1904, (the date of filing of the Cohn application) that Regenstein and the Transo Paper Co. began the manufacture of envelops.

Although Regenstein claims to have had the idea of an envelop made transparent by the use of oils and using a border "early in January," 1904, as represented by his January, 1904, exhibits, *yet long subsequent to Aug. 9, 1904*, (the date of the Reese U. S. patent) they filed other patents in England, France and Canada on the Reese invention, and *never mentioned that they preferred to use oil, nor did they make any mention of the use of a border around the window for any purpose.*

The Reese British patent was filed *December 28th, 1904*, No. 28,592, accepted February 16, 1905. (Complainant's Exhibit "K.")

The Canadian patent was filed *December 16, 1904*, issued March 28th, 1905, No. 92,373.

The French patent is dated *April 5, '05*, if we are to believe Regenstein's imprint. A French, like a British patent, bears the date of its *application* and

not the date of publication or issuance as in the United States.

THE ESTABLISHMENT OF THE EXISTENCE OF THE ALLEGED PRIOR USE OF REGENSTEIN BEYOND A REASONABLE DOUBT IS ON THE DEFENDANT AND MUST BE SUSTAINED WITHOUT REFERENCE TO ANY PROOFS OFFERED BY THE COMPLAINANT IN REBUTTAL.

Cantrell v. Wallick, 117 U. S. 695 (29:1019);

Coffin v. Ogden, 85 U. S. 18 Wall 120, 124 (21:821) 823;

Parker v. Stebler, 177 Fed. 210 (opinion by Judge Gilbert), quoting *Cantrell v. Wallick*:

“The burden of proof is upon the defendants to establish this defense. For the grant of letters patent is prima facie evidence that the patentee is the first inventor of the device described in the letters patent and of its novelty.”

In the “Barbed Wire Patent” case, 143 U. S. 275, also cited by your Honors, the Supreme Court says:

“Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended upon for accurate information. The very fact, which courts as well as the public have not failed to recognize, that *almost every important patent, from the cotton gin of Whitney to the one under consideration, has been attacked by the testimony of witnesses who imagined they had made similar discoveries long before the patentee had claimed to have invented*

his device, has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny. Indeed, the frequency with which the testimony is tortured or fabricated outright to build up the defense of a prior use of the thing patented, goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer."

DISCLOSURE OF THE INVENTIONS IN SUIT TO REGENSTEIN
BY COHN IN 1905.

In the Summer of 1905, shortly after the Transo Paper Co. commenced business, Mr. Cohn wrote to Mr. Regenstein and warned him in regard to his (Cohn) inventions (R. 140) and in September, 1905, sent Mr. Regenstein actual specimen envelops illustrating and embodying the inventions of both patents (R. 143). The defendant, after *denying* the receipt of these envelops, stating they were only "sketches" and not envelops, produces an old "Cremo Cigar" Envelop to impeach their own witness Regenstein (Exhibit FF) and confirm Mr. Cohn. When Mr. Cohn wrote in 1905, Mr. Regenstein characteristically turned Mr. Cohn's proposition down with the excuse that he had just quit the three-color business (The American Colortype Co.) and was tired of "satisfying cranks" (R. 143) and that he doubted Mr. Cohn's ability to get a patent anyhow.

On the issuance of his patents, Mr. Cohn wrote Regenstein as follows:

“12-4-06.

“Mr. Julius Regenstein,
“Chicago, Ill.

“Dear Sir:—

“I beg leave to refer you to U. S. Patent No. 835,850, Nov. 13, 1906, issued to me and to invite you to resume with me the negotiations heretofore suspended by reason of your doubts concerning the patentability of my invention.

“It is important that this matter be given your earnest attention at once, for, now that the delays of the Patent Office are over, I propose marketing my envelopes, and must soon know whether arrangements with you are to be made.

“Of more importance still is the fact that the envelopes you are now manufacturing, a sample of which I enclose, is an infringement of my patent as you will see by reference thereto.

“As matters of this kind can be gone into much more satisfactorily in personal interviews, I believe it would be to your interest to come to San Francisco immediately, so that we may go over the matter thoroughly.

“Please advise me at once whether I may expect you in connection with the above matter.

“Sincerely yours,

(Signed)

“MAX M. COHN.”

To this Mr. Cohn received the following letter from Regenstein:

“Chicago, Dec. 10, 1906.

“Max W. Cohn,
“416 Jackson St.,
“San Francisco, Cal.

“Dear Sir:

“I have your favor of Dec. 4th and in reply wish to state that we have made envelops with a ring to cover the spreading of the oil, at least one year before you handed in your application. The idea, therefore, was not at all novel and was very old as far as we were concerned.

“It is very true that you have a patent which I could have obtained if I cared for it. This feature of a ring is very immaterial and we never considered it of very much consequence. We have made very successful experiments in making envelops without a ring, and expect to have nothing else in the future, on the market, but such envelops as mentioned. We take pleasure in enclosing you a very good envelop which has no ring. If you have anything to offer which is new, and of advantage to us, we would like to hear from you.

“Yours very truly,

(Signed)

“JULIUS REGENSTEIN.”

This was the first time Regenstein ever claimed to Cohn as having been the first or an original inventor of the matter in issue.

Although in 1906 Mr. Regenstein promised soon to have a “ringless” one-piece window envelop on the market, yet six years have gone by and the Transo Paper Co. has never to this day been able to dispense

with a ring (X. Q. 265). The envelop which Mr. Regenstein sent Mr. Cohn in 1906 was a *foreign made envelop and not a Transo Envelop at all* (Mr. Cohn, R. 148).

Premeditated infringement and defiance of the patent is shown by the following letter written since the filing of the suit:

“Transo Paper Company,
“Chicago, Illinois, Sept. 22, 1910.

“Gabriel Meyerfeld Co.,
“311 Battery St.,
“San Francisco, Calif.

“Dear Sirs:

“We have your favor of the 14th inst., referring to notice received from Max M. Cohn with reference to suit pending against H. J. Heinz Co., as users of Transo Envelops.

“This party holds a worthless patent, which he has tried to compel us to buy, but for which we have no use. We are fighting the case for H. J. Heinz Co., and there is no doubt but what we will be able to prove our contention in the matter. In the meantime, you are perfectly safe in continuing to use our envelop, as we will protect you against any possible action on the part of Cohn.

“We are sending you a further letter to this effect today from our patent attorneys, Messrs. Banning & Banning.

“Yours very truly,

(Signed)
“HA.ER

“TRANSO PAPER Co.,
Per Horace Anderton.”

THE LETTER OF MESSRS. BANNING & BANNING OF DECEMBER 16, 1903, AND THE REESE 1904 APPLICATIONS ARE THE ONLY DOCUMENTARY PROOFS OFFERED BY REGENSTEIN TO SUBSTANTIATE HIS CLAIM TO PRIORITY, AND THEY ARE AT VARIANCE WITH HIS ORAL TESTIMONY. THE CONCLUSION IS THAT AS BETWEEN COHN AND REGENSTEIN THE LATTER HAS FAILED TO OVERCOME EVEN THE FILING DATE OF THE COHN PATENTS, AND THAT INDEPENDENT OF ANY REBUTTAL PROOFS OF COHN, THE FILING DATES OF THE COHN PATENTS ESTABLISH COHN AS THE FIRST SOLE AND ORIGINAL INVENTOR OF THE PATENTED ARTICLES AS AGAINST REGENSTEIN.

THE "EXPERIMENTAL" WORK OF REGENSTEIN.

Even if Regenstien did actually develop the invention in January, 1904, to a point represented by his old "1904 envelops," nevertheless, his work was experimental; was not persisted in and was entirely laid aside until a considerable time after Mr. Cohn had put his envelops commercially on the market, and had filed his applications for the patents here in suit.

Regenstein never sent an envelop such as he claims to have got up in 1904 through the mails, nor tried it to see what the public would think of it.

IN OTHER WORDS, HE NEVER PUT HIS INVENTION TO USE UNTIL LONG AFTER COHN HAD DONE SO AND HAD APPLIED FOR PATENTS.

Regenstein's 1904 efforts, whatever they may have been, were not according to Regenstein's own testimony, sufficient under the law to give them any effect as an anticipation of the Cohn inventions.

Regenstein's testimony, as to his 1904 activities is most potent evidence of invention, and also of the fact that the problem, which he was seeking to solve, and which Mr. Cohn had *already* solved, was by no means an obvious one, and that success came to him, as it did to Mr. Cohn, only after months of experimenting.

Regenstein says (R. 573) :

"Q. 7. From January, 1904, when you begun until the present time, has there ever been a period when you discontinued or gave up the work, of making one-piece transparent window envelopes?

"A. We *experimented* during the early months of 1904, and did not *experiment* very much during the latter part of 1904, since we intended and did go actually into business early in 1905, and from *that time on* we *experimented* in various ways to this present day."

It is to be observed that Regenstein side-steps his counsel's query as to "diligence" and thus shows the equivalent of abandonment of the invention, until

after Cohn's envelops were on the market and the Cohn applications filed.

Previously, at R. 295, Regenstein says in answer to Q. 142:

"Since 1905 I am actually engaged in the printing and manufacturing of envelops and late in 1903 and in 1904 in connection with my business as a color-printer, I manufactured and experimented in the matter of Transo envelops."

Again, at R. 341, Regenstein says in answer to R. D. Q. 341:

"Our 1904 experiments stood for an envelop where the ink representing the border was printed on the same side where the oil was put."

Of course such operations and "experiments" have no relation to the subject matter of the second Cohn Patent because Regenstein admits that he did nothing with the advertising feature of the Cohn inventions until 1908 or 1909, X. Q. 149.

The purely *experimental nature* of the early operations of Regenstein is vouched for by his own witnesses who repeatedly speak of the operations as "experiments."

THE LAW AS TO EXPERIMENTAL WORK OR USE.

The rule governing this case, as far as Regenstein is concerned, is expressed by the Supreme Court in

the *American Wood Paper Co. v. Fiber Disintegrating Co.* (known as the Wood Paper patent), 23 Wall. 566; 23 Law Ed. 31, as following:

“The patent of an originator of a complete and successful invention cannot be avoided by proof of any number of incomplete and imperfect experiments made by others at an earlier date. This is true, though the experimenters may have had the idea of the invention, and may have made partially successful efforts to embody it in a practical form.”

See *Gaylor v. Wilder*, 10 How. 477, 13 Law Ed. 504;

Barbed Wire Patent, 143 U. S. 275, 36 Law Ed. 154;

Coffin v. Ogden, 85 U. S. 120;

Cantrell v. Wallack, 117 U. S. 689;

Bell v. People's Telephone Co., 22 Fed. 309,
The Telephone Cases.

Deering v. Winona, 155 U. S. 286, 39 Law Ed. 153;

Brown v. Guild (The Corn Planter Patent),
23 Wall. 181, 23 Law Ed. 161;

Lincoln Iron Works v. McWhirter Co., 142
Fed 967, C. C. A.;

Gamewell Fire Alarm Co. v. Municipal Signal Co., 61 Fed. 948, 952.

Christie v. Seybold, 55 Fed. 69, C. C. A.

Regenstein's experiments by reason of their laying dormant for fourteen months after he says he made them, and before he began business as the Transo Paper Co., were nothing more than "abandoned experiments" during all that period, and they were revived and perfected only after Mr. Cohn had filed his application for patent and made known his invention to the world by using 10,000 of his envelops.

In the *Lincoln Iron Works v. McWhirter Co.*, 142 Fed. 967, C. C. A., the Court said:

"It is not enough to defeat the patent that some one other than Gilmour had conceived the invention before he did, or had even perfected it, *so long as it had not been in public use or described in some patent or publication.* If Gilmour was an original inventor, though a subsequent one, it was his right to obtain a patent unless he 'surreptitiously and unjustly obtained the patent for that which was invented by another who was using reasonable diligence in adapting and perfecting the same.' "

There is nothing in the evidence to show that Cohn ever gained any knowledge of Regenstein's work along these lines until long after he, Cohn, had perfected his invention, put it on the market and filed his applications for patent here in suit. Aside from

that Cohn was the earlier *user*, as well as the first to conceive and disclose to others.

Judge Putnam, speaking of a claim to prior invention, Circuit Court of Appeals, First Circuit, in *Dececo v. Gilchrist Co.*, 125 Fed. 293-296, is interesting:

“Perhaps the matter has never been put more clearly than in the conclusion of a discussion as to the well-worn topic of who was entitled to the credit of the practical discovery or invention of the use of anaesthetics, found in Park’s History of Medicine (2d Ed.) p. 312, as follows:

“ ‘Sir James Paget has summed up the respective claims of our four contestants in an article entitled “Escape from Pain” published in the Nineteenth Century for December, 1879. He says: “While Long waited, and Wells turned back, and Jackson was thinking, and those to whom they had talked were neither acting nor thinking, Morton, the practical man, went to work, and worked resolutely. He gave ether successfully in severe surgical operations, he loudly proclaimed his deeds, and he compelled mankind to hear him.”

“ ‘As Dr. Morton’s son, Dr. J. W. Morton, of New York, says, when writing of his father’s claim: ‘Men used steam to propel boats before Fulton, electricity to convey messages before Morse, vaccine virus to avert smallpox before Jenner, and ether to annul pain before Morton.’ ”

“This contains a line of observation which is ordinarily just and practical, and which, if applied to the present case, would probably enable

us to dispose of the alleged anticipation by Mann without further consideration. It is not now necessary, however, to go into this difficult topic."

In *Coffin v. Ogden*, 18 Wall. 120, 21 L. Ed. 821, the Supreme Court said:

"If the thing was embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon discovery or invention which was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view. The law required not conjecture but certainty. Until his work is done, the inventor has given nothing to the public."

This is an attempt to defeat a meritorious patented invention by proof that something similar had been previously known, though it had never been perfected, and had never been any useful contribution to human knowledge or convenience.

His Honor Judge Van Fleet has succinctly and correctly stated his conclusions on this branch of the controversy in accord with what has been said herein.

II.

THE SO-CALLED PRIOR ART.

This is the second defense. In the answer the defendant set up between seventy and eighty British

and American patents of which are actually introduced in evidence about fifteen or sixteen covering and including in their scope everything from an "imitation stained-glass window" through a gamut of "book covers," "coin bags," "devices for packing hooks and eyes," "needle wrappers," "tobacco cases," and "tablets," to "dressmaking charts," together with a miscellaneous sprinkling of experimental and impracticable types of envelops and wrappers; none of which, however, embody or anticipate the combinations of the claims sued on, or are constructed or operate according to the fundamental idea of the Cohn inventions.

"The citation of a large number of patents as anticipation, tends to strengthen rather than weaken the patent sued upon, by showing that the trade had long and persistently been seeking in vain what the complainants finally accomplished."

Forsyth v. Garlock, 142 Fed. 461-463.

"Forty-odd reference patents were not needed to prove that Dean was not a pioneer in the telephonic art, that he did not originate the granular-carbon type of transmitter, and that he was not the first to provide a means for preventing the packing of the granules. * * * The novelty of none of the claims is gainsaid by *any single prior patent or structure*; but *collectively* the references establish that all of the elements broadly considered, which Dean used in making up his combination, *were old and were commonly used* in transmitter construction. * * * but the concept of such a unitary structure was not

obviously taught nor foreshadowed by anything in the prior art."

International Tel. Co. v. Kellogg Switchboard Co., 171 Fed. 651 (C. C. A.).

Gandy v. Main Belting Co., 143 U. S. 556.

DuBois v. Kirk, 158 U. S. 58.

Hancock v. Boyd, 170 Fed. 600.

Novelty Glass Co. v. Brookfield, 170 Fed. 946.

The defendant has stated that the *Brown patent of 1862* is the nearest approach to the *First Cohn Patent* and the *Bolda British Patent of 1897* is the nearest approach to the *Second Cohn Patent*. (R. 536-8.)

On page 537, Mr. Bond, the defendant's expert, says in referring to this so-called prior art of the defendant: "*There is no one patent which meets the requirements and conditions in all respects of both of the Cohn patents.*"

THE PATENTS TO TUDOR, ET AL.

On page 48 and following, appellant in his Brief refers to the patents to Tudor, Hole, Leigh and to Smith and Browne. It seemed incredible that the appellant would disclose the hopelessness of his case by relying on these patents, which are so remote from the art to which the Cohn invention and the Heinz envelops belong, and in regard to which pat-

ents the defendant's own expert, Mr. Bond has testified so unfavorably. (See Record, pages 519-537, inclusive.)

Mr. Bond devotes *over 20 pages solidly typewritten*, to show the *differences* between the patents relied on by defendant and the Cohn Patent; (practically the same amount of space he devoted on direct examination to show *similarities*).

At R. 519-520, Mr. Bond says:

“THE TUDOR 1878 PATENT.

“The primary object of the Tudor patent is treating a blank sheet of paper so as to produce the appearance of a stained glass window, differing in this respect from treating a blank sheet of paper for the purpose of making an envelop having a transparent window.

“*One difference* between the process employed by Tudor and that employed by Cohn is that Tudor employs a plurality of opaque lines or borders to define a plurality of transparent sections or spaces, while Cohn employs an opaque border to define one transparent section or space in the paper.

“*Another difference* is the lack in Tudor of any permanent printed matter or advertising matter around the border of the transparent section or window, which is specifically required in the Second Cohn Patent.

“*Another difference* is that while Tudor defines various shapes for the transparencies, such

shapes are not characteristic of any symbol of trade, as required in the Second Cohn Patent.

“Another difference is that Tudor uses his prepared paper with its different colored transparent sections as an adjunct to a pane of plain glass, while Cohn uses his prepared paper as an envelop.

“Another difference or dissimilarity is that the paper is treated by Tudor for the production of ornamental window glasses and not for the production of an envelop, as intended by Cohn in treating the sheets of paper.

“Undoubtedly the invention of Tudor would be merchantable for the purpose intended, *but not for use as an envelop*, and likewise the invention of Cohn would be merchantable as an envelop, but not as an ornamental window glass.

“There are other minor differences, such as the shape or outline of the transparent sections of windows, of Tudor, as compared with the transparent section or window of the Cohn Patent; also in the shape of the complete product; also in the laying on of the opaque lines to define the transparent sections of the two articles, namely, the window glass and the envelop.

“These differences are apparent between the article produced by using the Tudor invention and the article produced by using the inventions of the two Cohn Patents.

“These differences result in the production of articles for different purposes and for different conditions of use.”

Aside from the “two best references” the Tudor patent is a fair sample of defendant’s anticipating patents.

The "prior art" has been arbitrarily divided by appellant in its brief into several "divisions"—no doubt according to the degree of remoteness each "division" has to the art of merchantable mailable envelops of the Transo quality.

The appellant occupies several pages of his Brief (pp. 27-44) in an attempt to show the analogy existing between the art of three-color work and the envelop art. The Counsel for appellant frequently refers to the use of borders in three-color work and in printing generally, "to cover or conceal the *running or spreading* of the inks or colors." Such a statement is unwarranted by the evidence, because the only time that any of the witnesses ever referred to "running or bleeding" of the inks was in answer to leading questions by defendant's Counsel in which he attempted to put these words into the mouths of the witnesses.

A glance at the Osborne Art Calendar, or at the *printing* in appellant's brief, or at this printed page, will show that there is absolutely no evidence of "creeping," or "spreading," or "bleeding," although the paper used generally, especially in printing these briefs, is a *soft, absorbent* paper, wholly unadapted to take a *pen*.

The function of the border in the printing art is entirely different from the function of the border in the art of making envelops. Mr. Regenstein's testimony is intended to mislead those not familiar with

the printing art, inasmuch as he attempted to show that a border is resorted to whenever a printed picture shows an irregular or uneven outline. It does not take an expert to prove the fallacy of this contention.

Firstly—It is possible to produce any picture or cut without a border as perfectly *and at less expense* than with a border. This is proven by defendant's own exhibit which shows pictures of the same character and produced by the same process both with and without a border. Defendant's witness (see answer X. Q. 68) testified that a border adds to the expense of a printed job.

Secondly—It would be optional with the purchaser if he would accept a picture with a border when he placed an order with his printer for a picture without a border. It is safe to assume that in the majority of instances such a job would not be accepted. For instance: If a concern that used a label, showing a picture of its trade mark, for many years, placed an order with a printer for a lot of labels to be *exactly the same as a sample submitted*, and this sample label did *not* show a border around the picture of the trade mark, is it reasonable to suppose that the printer would arbitrarily take it upon himself to print a border around the picture of the trade mark? And if he did, would it not be a certainty that the concern ordering the label would reject same on account of it being different from the sample submitted? The facts are, as shown by defendant's own

witnesses and Art Calendar Exhibit, that invariably it is decided *before* any picture is printed, whether or not it is to have a border and the plates are made accordingly.

The testimony submitted to show that borders are used in the printing art in the same manner as in the production of a transparent window envelop is not convincing, nor is it borne out by actual facts. Mr. Regenstein himself admitted that making paper transparent has nothing to do with the printing art. (See answer to X. Q. 253.)

We agree with Mr. Regenstein that there is no similarity in the two arts, envelop making and the manufacture of three-color work. As a matter of fact they are very dissimilar. *In printing*, great care must be taken that the ink does not penetrate the surface of the paper, because in many instances both sides of the paper are printed; but even if only one side is printed, it is essential that the reverse side is kept clean and unmarked.

In rendering paper transparent as practiced by Mr. Cohn and the defendant, an entirely opposite result is sought—it is absolutely necessary to penetrate beneath the surface of the paper. Both sides of the paper must be affected as no transparency would exist if only one side were affected.

“Printing” does not in any way change the character or consistency of the paper, the impression merely appearing on the surface of same, while ren-

dering paper "transparent" changes the character of the paper, as it is absolutely necessary to penetrate every fibre of the paper.

In printing a border around a picture, as the evidence shows and the Court knows, it is invariably printed on the *same* side of the paper as the picture itself, because it is obvious that printing a border on the reverse side would be useless. Mr. Regenstein and his witnesses testified that in making envelopes in 1904 they printed the border on the same side of the paper that the oily preparation was applied. (R. D. Q. 341.) Regenstein says: "Our 1904 experiments stood for an envelop where the ink representing the border was printed on the same side where the oil was put."

It was therefore not until 1905 when Regenstein started to manufacture envelopes commercially that he *abandoned* all of his own experiments and adopted the Cohn method of printing the border on the *reverse* side in this connection. Meanwhile Cohn had his application filed describing this method in November, 1904, and had already scattered broadcast ten thousand envelopes all over the United States, so that in accordance with Regenstein's own evidence Cohn was the first one to print a border on the *reverse* side and on *top* of the irregularities, and the Transo and Heinz envelopes are evidence of the fact that *this is the only way to make envelopes of this sort*.

THE "BEST REFERENCE" ARGUMENT OF DEFENDANT.

By having the defendant single out the Brown and the Boldt patents as being the most in point for the respective Cohn patents, our work, and the work of the Court, is very much simplified.

The case at bar is thus brought squarely within the doctrine of the case of *Waterbury Buckle Co. v. Aston*, 183 Fed. 120, C. C. A., Second Circuit, Judge Coxe speaking for the Court:

"That the patent is not anticipated is conceded by the defendant's expert. He says:

" 'If you wish me to find a single illustration in any single reference which exactly agrees in all particulars with the device of the patent in suit I am free to state that I do not find it and I do not think there can be anything found in my previous testimony to the effect that I have claimed to find it.

" 'X. Q. I understand you to admit that no patent and no exhibit discloses the particular thing set forth by claim 1 of the patent in suit. What I wish you to do now is to state for the information of the court and to simplify the consideration of the case by the court what one patent or exhibit comes the closest on the whole, taking everything into consideration, to meeting claim 1 as you find it? A. The first part of your question is correct, and in reply to the latter part of your question I would again refer to the U. S. patent to La Chappelle, No. 485,104, as coming the nearest, all things considered, to the device of the patent in suit.

“ ‘X. Q. Now, to save time, I will ask the same question as to claims 2, 4, 5, and 6, of the patent in suit? A. On the basis of your question and in my opinion the same reference applies to the other claims.

“ ‘X. Q. Then in your opinion the La Chappelle patent No. 485,104 comes the closest on the whole taking everything into consideration in your opinion to meeting the invention of the patent in suit and the terms of claims 1, 2, 4, 5, and 6 of the patent in suit, out of all the exhibits in the case? A. It does.’

“ *It seems necessary, therefore, to examine only the La Chappelle patent.* A diagram of the device of this patent will be found in the opinion of the Circuit Court. La Chappelle states that his object is—‘to produce an improved form of buckle that is especially adapted for use in suspenders; and it consists, mainly, in improved means of holding the web of the suspender securely without cutting or tearing it and of a secure and simple means for uniting the button-holed ends of the buckle.’

“ ‘Evidently the patentee did not have the Peller *concept*. His was not a rustless buckle and was not designed to be such. A person skilled in the art, familiar with the complainant’s buckle might, by removing the hooked part, reconstruct the La Chappelle device so that it would accomplish in an awkward manner the same result as Peller, but this is not enough. *A patent cannot be invalidated by a structure which can only be altered into an anticipation by the use of inventive skill.* There is nothing in the La Chappelle device to suggest the Peller device to the mechanic. It does not operate and was not intended to operate, in the same way,

and, without radical changes, it is incapable of producing the same result."

As stated by Judge Coxe, it would seem, therefore, necessary only for this Court to examine the Brown patent with respect to the First Cohn Patent and the Boldt patent for the Second Cohn Patent. But evidently, as we will see, neither Brown nor Boldt had the Cohn *concept*. It is true that Mr. Bond, who is manifestly unfamiliar with this line of work, has endeavored to reconstruct and alter the Brown and Boldt patents in an attempt to meet *his* concept of the Cohn patents; but, as was said in *McMichael & Wildman Manufacturing Co. v. Ruth et al.*, 128 Fed. 706, 63, C. C. A. 304:

"The fact that an expert, with a patent before him, might be able to build up the structure covered thereby, by selecting and adapting appliances theretofore known, does not overcome the presumption of invention arising from the granting of the patent, where neither the same combination in its entirety nor the same mode of operation had previously been described or known."

THE BROWN 1862 PATENT.

The drawings of this patent appear on the opposite page.

With regard to the differences between Brown and the Second Cohn Patent, Mr. Bond says (R. 518):

"The envelop of this Brown 1862 patent differs from the envelop of the Cohn Second Pat-

Fig. 2,

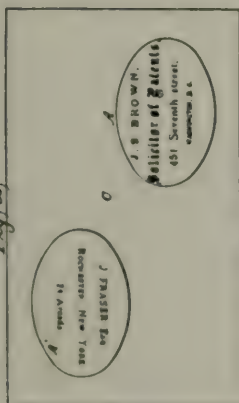


Fig. 5,

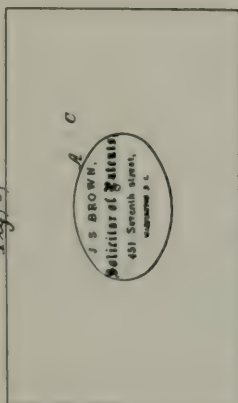


Fig. 6,

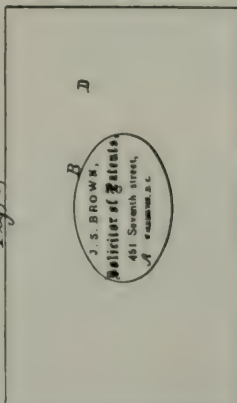


Fig. 1,

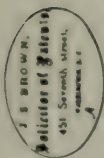


Fig. 3,

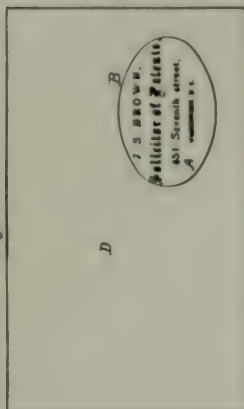
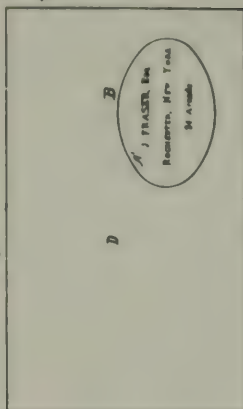


Fig. 4,



J. S. Brown. *Addressing Letters.*

No. 36,393

Patented Sept. 9, 1862.

ent, in *not having the transparent section or window in outline characteristic of some symbol of trade*, and in *not having an opaque border surrounding this specific type of window*.

“A further difference is that the Cohn Second Patent makes provision for *permanent printed matter* or advertising matter on the opaque border around the transparent section or window, and of a character to co-operate with the outline of the window to indicate a particular brand of goods.

“The *difference* between what Brown *intended* and what Cohn intended in the use of printed matter or advertising matter is the difference between placing such matter on the card used by Brown independent of the envelop proper, and placing such permanent printing matter on the face of the envelop outside of the transparent section or window. In the one case, that of Brown, the printed matter, whatever its nature, was not a permanent part of the envelop, while in Cohn such printed matter, whatever its nature, formed a permanent part of the envelop.”

This last statement that Brown “intended” or designed his envelop as an envelop with the printed matter on the enclosure, if it meant any more than the *address on the enclosure*, is entirely misleading. Brown has no suggestion of *advertisement*.

As to the *merchantableness* of the two envelops, Brown and the Second Cohn, Mr. Bond ventures the following (R. 519):

“This same difference, as to merchantableness (i. e., in favor of the First Cohn Patent) is

also applicable to the envelop of the Cohn Second Patent, and in addition to the border, probably having the advertising matter or printed matter a permanent part of the envelop would in some cases make the envelop more merchantable than where such printed matter or advertising matter was on a separate card. This would be the case where the party using the envelop wanted to make prominent the business."

Thus the defense is forced to patentably 'distinguish between the Brown patent and the Cohn patents! As was said in Gormully-Jeffrey Mfg. Co. v. Stanley Cycle Mfg. Co., 90 Fed. 280:

"The English patent shows a clumsy device which apparently never went into successful operation. It seems to be conceded that the English structure can not be used as the Jeffrey structure is used without first making several important changes. The proof leaves no doubt on that subject. It is argued that these changes might have occurred to the skilled artisan. That they did not occur to any one until Jeffrey made the invention is evident. They seem simple enough now, but invention depended upon their being successfully wrought out. *In short, in these changes lies the difference between the commercial failure of the English patent and the widely recognized success of the patent at bar.*"

In the case of *General Electric Co. v. Wise*, 119 Fed. 926, it is said:

"However close the resemblance between some prior alleged invention, even when put into actual use, and the patented invention, if such

alleged prior invention was not operative, and failed to produce the beneficial results sought and produced by the patent, it could not constitute prior invention. In such case the patented invention can not be regarded as old."

Or as epitomized in *The Barbed Wire Patent* case, 143 U. S. 282: "It is the last step that wins"; and that is the step Courts will protect.

BROWN'S IDEA IMPRACTICAL IF NOT IMPOSSIBLE OF REALIZATION.

Turning to the testimony on behalf of complainant as to the differences between Brown and the Cohn inventions, we have a very clear statement and understanding of the same presented by Mr. Cohn (R. 205):

"I find that the only method described intelligently by Brown, is that of taking a piece of envelop, of the proper size and shape and cutting same out of the envelop covering the aperture thus made with transparent paper, or other equivalent transparent covering. This is the only method that is expressed intelligently enough to allow any one to make an envelop; all other description being either too vague in its character or impossible in its execution. To exemplify, Brown states: 'There may be only a transparent portion B large enough to exhibit the "direction" through it, and this may be made either by rendering a portion of the envelop or wrapper itself transparent by the same means or substances as employed for making tracing paper.' As explained before in my testi-

mony, if Brown undertook to do what he says *might* be done in his patent, he would render the *entire envelop transparent*. The only other method described by Brown aside from the two just mentioned, is, as follows:

“ ‘Instead of making only a small portion of the envelop or wrapper transparent the whole envelop, or at least the whole face of it may be made transparent.’ ”

“I can see no method whatever in this last statement of Brown as the specifications contain nothing in reference to this, aside from what I have just quoted, and it is impossible for me to imagine what method he had in his mind.

“As to the means employed by Brown in his patent, the only two means he expresses are that of making paper transparent, ‘by the same means or substances as employed for making tracing paper or any other in the process of manufacturing paper’; the other being the means of cutting out a portion of the envelop and covering same with transparent paper.

“The only *qualities* of paper to be used, expressed by Brown, are as follows: tracing paper, transparent paper, and an opaque wrapper. The transparent paper is to be used in covering a hole in the opaque paper.”

And R. 152:

“It is very evident that Mr. Brown had absolutely no knowledge of the paper business, nor had he tried to manufacture envelopes in accordance with his own specifications. *It is impossible to make paper transparent in spots by the same means as making tracing paper.* It is also

foreign to the art of *paper making* to make a sheet of paper which will be partly opaque and partly transparent. Any one familiar with the *manufacture of paper* knows that a sheet must be uniform from end to end, and cannot be produced with transparent space as Brown evidently thought could be done. The same is true of tracing paper; it being impossible to treat a sheet so that it would be transparent only in certain predetermined places. Mr. Brown further shows his ignorance of the paper business by stating, 'the cost of manufacturing the improved envelops will scarcely, if any, exceed that of ordinary envelops now in use. For while the additional cost of rendering the envelops and wrappers transparent, will be but little, a cheaper quality of paper may be employed, not requiring to be finished so highly as for receiving the pen.' Had Mr. Brown been familiar with the paper business he would not have made a blunder of this kind, because instead of requiring a cheaper paper, it requires a paper costing four or five times as much as ordinary envelop paper in order to render it transparent by 'the same means or substances as employed for making tracing paper.' Summing up, I might state that it would be entirely impractical to make a suitable commercial envelop in the manner described in the Brown patent. This statement is substantiated by the fact that no commercial envelops were ever produced under the Brown patent."

BROWN, THEREFORE, DOES NOT EMBODY EITHER THE TRANSO OR THE COHN CONCEPT.

Mr. Cohn shows, in answer to Q. 76-77, that the samples of Brown proffered by the defense are bogus. In referring to these exhibits Mr. Cohn said:

“As stated by defendant’s counsel on page 374, of the defendant’s testimony, the envelop referred to ‘was made by the Transo Company on the same kind of paper used for their stock envelops and the same printing plates for applying the oil used in making it that is used for the stock envelop, but with the tinted matter omitted from the inner side of the paper, and the ring or border omitted around the window on the outside.’ This statement made by Mr. Banning probably explains, better than I can, the existing differences. *Mr. Brown’s patent is entirely silent as to the use of oil*, he makes no mention in his specifications of using printing plates and I am sure would never accomplish the result here produced in this Exhibit if he followed his own specifications.”

As said in *Kimball v. Waters Co.*, 117 Fed. 239:

“If the questions of identity of operation and results of a patented device and an alleged anticipating device were to be decided upon the contradictory testimony of experts, *preference should be given to the testimony of complainant’s experts who had been engaged in the business to which the patented device pertained as against defendant’s expert who had had no practical experience.*”

THEORETICAL MODIFICATIONS OF THE PRIOR ART ARE NOT PERMISSIBLE UNDER THE LAW TO MAKE OUT ANTICIPATION.

As your Honors said in the case of *Los Alamitos Sugar Co. v. Carroll*, 173 Fed. 280:

“It is not sufficient to constitute anticipation that the devices relied upon might by a process

of modification, reorganization, or combination with each other, be made to accomplish the function performed by the device of the patent sued on."

In speaking of this rule of law, the Court, in the case of *Western Electric Co. v. Howe Tel. Co.*, 85 Fed. 656, said:

"The force of this ruling and the similar ruling in *Clough v. Barker*, 106 U. S. 175, is made manifest in its practical application to the rights of parties, by the reflection that all earlier patents set up in defense against a later patent sued upon are but the record of evidence of the status the art has reached. The rights under such later patent are subject to what this record evidence actually shows. *To change this record by permitting theoretical modifications of these earlier patents, would be the same in principle, as to change, by interpolation or modification any other evidence between the parties.*"

"A patent cannot, as an anticipation of a later patent, have implied into it from necessity more than it fairly shows to make it represent an operative structure. What is required and not so shown is left for later inventors."

Wirt v. Farley, 84 Fed. 891.

At pages 15-16 of Appellant's Brief, appears the following:

"The Brown Patent says: 'By rendering a portion of the envelop' not the whole of it but a *portion*—'transparent by the same means or substances as employed for making tracing paper or any other' transparent. What 'means

or substances' are used for making tracing paper transparent? Oil or oily substances, as everybody knows. The tracing paper in children's picture tracing books used for forty years or more is, as its very appearance shows, rendered transparent by oils or oily preparations. The Century Dictionary, 1890, under the heading of Oils says: 'Oiled paper, paper saturated with oil either to render it transparent and thus *fit for tracing purposes*, or to make it waterproof.' Brown speaks to those skilled in the art of making paper and who knew that oily preparations were used in making 'tracing' paper, and so he tells them that a portion of the envelop, 'large enough to exhibit the "direction"' through it' was to be made transparent by using the appropriate 'means or substances'—any suitable oily preparation."

This identical statement of Counsel was made in the Court below. We make now the same answer we did then:

One fallacy in defendant's line of reasoning lies in the fact that the Brown patent was issued in 1862 and the defendant's Counsel refers to a publication 30 years later to define something which was "fit for tracing purposes" but which later publication does not of itself even describe how "tracing paper" is or was made.

Neither the Brown patent shows, nor is there any publication contemporaneous with or prior to Brown before the Court to show, even how tracing paper *at the time of the Brown invention* was made. Even if

there was such contemporary information, it is manifest that the Brown patent could only be explained by extraneous evidence; and still with nothing whatsoever to communicate to those skilled in the art what was in the mind of Brown or what his *intention* was.

Brown's patent does not teach anyone how to make an envelop such as either the defendant or the complainant produces. As far as disclosing anything to the public is concerned Brown might just as well have said: "by the same means and substances as employed for making glass or celluloid," for producing the window leaving the remainder of the envelop opaque. As pointed out in the testimony, it is just as impossible to render a "portion" of an envelop transparent "by the same means or substances as are employed in making tracing paper" as it would be to render it transparent by the same means or substances as employed for making glass or celluloid.

"A PATENT IS GRANTED FOR SOLVING A PROBLEM, NOT FOR STATING ONE."—COLUMBIA MOTOR CAR CO. V. DUERER & CO., 184 FED. 893, C. C. A. (SELDEN AUTOMOBILE PATENT).

AS SAID BY YOUR HONORS IN ONE OF THE RAISIN SEEDER CASES, 182 FED. 59:

"IT IS ONE THING TO INVENT THE THEORY OF A MACHINE. IT IS QUITE ANOTHER THING TO INVENT A SUCCESSFULLY OPERATING MACHINE."

IF BROWN DESCRIBES A PRACTICAL METHOD SO CLEARLY, WHY HAS REGENSTEIN SPENT \$100,000.00 IN TRYING TO PERFECT HIS TRANSPARENCY?

Why didn't he follow the method which he says Brown so clearly taught. He certainly had the benefit of all Brown's teachings because he learned soon after the filing of the Reese abandoned application in January, 1904, of the existence of Brown. These are strange inconsistencies not satisfactorily explained by the Appellant.

In conclusion, we invite the Court's attention to Judge Van Fleet's careful analysis of Brown as a defense.

BUSCH BRITISH PATENT.

The drawings of the patent are shown on the opposite page.

The Busch patent may be considered in two aspects:

1st—as to what it actually is and shows, and

2nd—as to what the defendant's expert *thinks it shows*.

The Busch envelop is made from transparent paper and not from opaque paper and is substantially like the Cohn & Shipp British patent already referred to and Exhibit R.

(2nd drawing)

Fig:1.

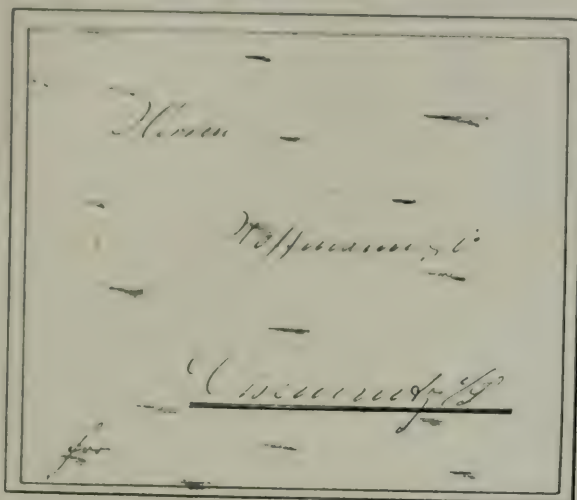


Fig:2.

A

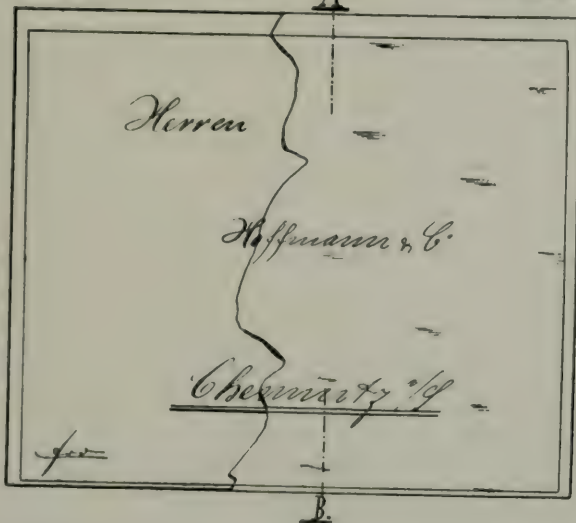


Fig:3 A-B.



This Drawing is a reproduction of the Original on a reduced scale]

The *defense* has imagined that this transparent envelop of Busch showed a *border*. If the Court will but casually examine the drawings of Busch they will see that it does *not* show a border. *As far as the drawings teach, the Busch envelop is a plain, uncolored, unprinted common ordinary transparent envelop.* The fallacy of the defense appearing just as in the Court below, repeatedly in its brief, carries its own refutation.

Mr. Cohn, at R. 155, points out that *Mr. Bond mistook the outline of the enclosure shown in the drawings, Figs. 1 and 2 of Busch, for a border.* A careful inspection however of the drawings in question prove conclusively that there is no border shown. Both Figs. 1 and 2 show the enclosure as is natural in such instances, to rest toward the bottom of the envelop. Fig. 2 shows a broken section of the envelop with the enclosure still remaining in place. Had there been a border on the envelop face it would not have shown in the place that is torn away to show the enclosure.

In Busch *the entire face of the envelop is transparent.*

BUSCH A FAILURE.

“Q. 83. Referring to these envelops, defendant’s Exhibit, Busch, 1896, Nos. 1, 2 and 3, appearing opposite page 400, D. R., are those envelops, or either of them, commercial, practical envelops suitable for the uses to which your en-

velops and the Transo envelops have, or are put, that is, as a mailable commodity?"

Mr. Cohn:

"No. None of the envelops mentioned are practical or salable. In my previous testimony I have explained the undesirable features of an envelop made from transparent stock. All of these objectionable features are present in the Exhibits referred to. *Briefly summarized the objections are as follows: They are brittle and flimsy. They do not seal readily. They do not hold the stamp with sufficient strength. It would be impossible to post mark Busch specimens 2 or 3, owing to the dark background made necessary to kill the transparent nature of the paper. Busch specimen No. 1, when used in connection with a white enclosure, would have all the characteristics and appearance of a 'mourning' envelop. They would not serve as safe closures and would be torn and disfigured in the mail. They would find no sale on the market.*"

Concerning the manufacture of transparent paper and refuting the proposition put forward by the defense that *paraffine* or oil were used in making the Busch envelops, Mr. Cohn says (R. 158):

"The paper used in the manufacture of this envelop was never an opaque paper. It comes from the paper machines in transparent form just as it now appears, and has never been treated with *paraffine* or oil of any description, since it left the paper machine. The process of making this paper transparent has long been confined to some special mills in Germany, and it has only been but very recently, say within

the last two years, that two mills have started manufacturing this character of paper in the United States; the duty having been recently raised on this commodity to such an extent that it has been an inducement for some of the foreign paper makers to undertake the manufacture of this character of paper in the United States. The resultant transparency of this paper is occasioned by the various ingredients that are put in the beaters during the process of its manufacture. The firm of the Zellerbach Paper Company, with whom I am connected, is one of the largest, if not the largest importers of this character of paper in the United States. This paper is used very extensively by the dried fruit packers. Therefore, there is a large sale of this paper in California. There is nothing of an oily or greasy preparation used in the manufacture of this transparent paper. It is known to the trade as a *grease-proof* paper, and, as stated before, is principally used to pack around food stuffs of various kinds; delicatessen stores using it to wrap packages of slices of ham and bacon. It is also used for packing sandwiches, etc. The various ingredients that go to make up a finished paper are mixed with the pulp at the time of manufacturing same and the sheet is then drawn through calendars or rolls, which give it the highly glazed appearance that it has, but no chemical or oil of any kind is applied to the paper from the time it leaves the paper machine. To explain the calendars or rolls in paper making a little more fully, I would state that calendars are pressure rolls, some times run hot and at other times cold and the function of these calendars is to put a surface or glaze on the paper. I spoke of but two mills making this character of paper in the United

States. One of these has been in operation for about eight or nine years in Hartford City, Indiana, operating only in a small way. It has only been within the past two years that they have come into such prominence."

By comparing the foregoing with the "prophetical suggestions" in Busch we will see how far Busch was from foreshadowing the Cohn inventions.

As showing another uncommercial aspect of the Busch envelop, Mr. Cohn further testifies that this envelop could not be made by machinery, because this paper will not take gum or adhesive owing to its glaze (Q. 88).

Cohn says, referring to the Busch samples:

"There is no gum on the sealing flaps. This first became apparent to me when I consulted some envelop makers in reference to making an envelop of this character by machinery. I was informed that it was practically impossible to make envelops of this character by machinery; one reason being that on account of the character of the paper the plungers had a tendency to pick up more than one sheet at a time, but the main objection was that no suitable gum could be found that would work successfully in a machine for making envelops of this character, that is, for gluing the body and gumming the sealing flap."

The objections to and disadvantages of an envelop made from transparent paper have already been pointed out in connection with Mr. Cohn's efforts and experiments with Exhibit R.

As to the suggestion of "tracing paper" for making envelopes, Cohn says:

"The only other form of transparent paper, aside from tissue paper, which would be entirely useless in the manufacture of envelopes, is tracing paper. Tracing paper is also rather brittle, but the main objectionable feature in the use of tracing paper is the cost of the same. Tracing paper is one of the most expensive papers on the market. The cost of tracing paper would prohibit its use, in the manufacture of commercial envelopes.

"To be more exact, the cost of the paper alone, if tracing paper were used, in making envelopes, would be from \$5.00 to \$10.00 per thousand. This price does not include printing or manufacturing the envelopes, and as good commercial envelopes can be sold for less than \$1.00 a thousand, it is very evident that no successful envelopes can be made from tracing paper. One of the reasons that tracing paper is so expensive it has to be made so that a draftsman in using it can apply ink on its surface by the use of a pen, or other drawing instruments. Therefore, *tracing paper cannot be made out of an oily preparation*. One other objectionable feature to tracing paper is that it lacks sufficient transparency to make an address very clearly legible through same. (See Exhibit S.)

The Commissioner of Patents, in upholding the First Cohn Patent disposed of the Cohn & Shipp and Busch patents in the following words:

"The British patents are not regarded as anticipations, as they require, so far as can be understood, that the envelop blank be made from a

transparent sheet of paper, while appellant's start with an opaque sheet of paper."

This excerpt alone is sufficient to show the fundamental difference between the structures of the Cohn patents in suit, and that of the British references.

Independent of the fact that the complainant's British patent is *not identical* with the patents in suit and *are not for the same invention*, the Cohn & Shipp Patent can in no wise be considered as a part of the prior art, *because Cohn had already conceived and developed the inventions of the patents in suit before filing his British application.*

"But in order that the foreign patent may invalidate the patent in suit, it is not sufficient that it ante-dates that patent. If in withstanding such ante-dating, the patentee invented his device prior to the date of the foreign patent, then his patent is not invalidated thereby."

Columbus v. Standard, 148 Fed. 662, C. C. A.

Seymour v. Osborne, 11 Wall. 555.

The Busch Patent is also carefully considered in the opinion of the lower Court and the conclusions therein stated are manifestly correct.

Thus the so-called "best references" of the defendant for the First Cohn Patent are fully answered and disposed of.

1
0
5

-

0
-
t

5
.
.
.
.
.

transparent sheet of paper, while appellant's start with an opaque sheet of paper."

This excerpt alone is sufficient to show the fundamental difference between the structures of the Cohn patents in suit, and that of the British references.

Independent of the fact that the complainant's British patent is *not identical* with the patents in suit and *are not for the same invention*, the Cohn & Shipp Patent can in no wise be considered as a part of the prior art, *because Cohn had already conceived and developed the inventions of the patents in suit before filing his British application.*

"But in order that the foreign patent may invalidate the patent in suit, it is not sufficient that it ante-dates that patent. If in withstanding such ante-dating, the patentee invented his device prior to the date of the foreign patent, then his patent is not invalidated thereby."

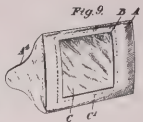
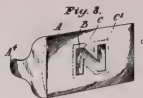
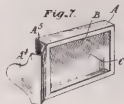
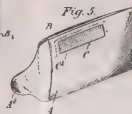
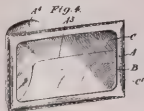
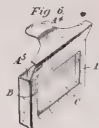
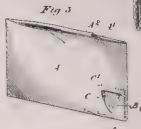
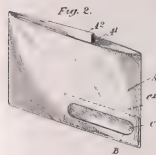
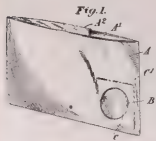
Columbus v. Standard, 148 Fed. 662, C. C. A.

Seymour v. Osborne, 11 Wall. 555.

The Busch Patent is also carefully considered in the opinion of the lower Court and the conclusions therein stated are manifestly correct.

Thus the so-called "best references" of the defendant for the First Cohn Patent are fully answered and disposed of.

2nd Cy. 100



BOLDT BRITISH PATENT OF 1897.

The drawings of this patent appear on the opposite page. Specimen envelopes of Boldt according to Figs. 8 and 9 of the Boldt patent are in evidence as Complainant's Exhibits "DD" and "EE."

This is the so-called "best reference" of the Second Cohn Patent.

In answer to X. Q. 77, Mr. Bond in summing up the difference between Boldt and Cohn as they appear to him from the standpoint of the defendant says (R. 533):

"The primary object or purpose of this Boldt British patent is the making of a packet, wrapper, or envelop, or whatever it may be termed, in such manner as to enable the nature of the contents to be observed, and at the same time have the transparent material employed for inclosing or covering the observation opening represent the initials of the firm, or be otherwise utilized for advertising purposes.

"A difference between the wrapper or envelop of the Boldt British patent and the wrapper or envelop of the two Cohn patents is the difference between a wrapper or envelop in which the transparent window is made by the use of an independent piece of transparent material, as in Boldt, and the window made integral with the paper of the envelop, or, so to speak, the difference between a two-piece transparent window envelop, as designed by Boldt, and a one-piece transparent window envelop, as designed by Cohn.

“Another difference is the lack, in the wrapper or envelop of the Boldt patent, of an opaque border surrounding the transparent window, as set forth in the two Cohn patents.

“Another difference is the lack of any permanent printed or advertising matter on the wrapper or envelop of the Boldt patent, outside of or anywhere on the face of the wrapper or envelop, which permanent printed or advertising matter is a requisite of the Cohn Second Patent.

“Another difference is the lack, in the wrapper or envelop of the Boldt British patent, of an outline characteristic of a symbol of trade, in co-relation with permanent printed or advertising matter, by which a particular brand of goods is indicated.

“Other minor differences can also be found, but the above differences are the most prominent and pronounced ones.

“Minor differences appear in the form and shape of the wrappers or envelops; between the location of the transparent sections or windows; and between the general design for which the transparent windows are employed—Boldt using the transparent window to observe the contents, and Cohn using the transparent window to observe the address of the inclosed letter.

“As a merchantable device for the purpose intended, the Boldt wrapper or envelop is as merchantable as the device of the two Cohn patents, for the purpose intended in either patent, but *as a mailable commodity possibly the device of the two Cohn patents would have more value* than the device of the Boldt patent, though it would be possible to utilize the wrapper or envelop of the Boldt patent for mailing purposes if so desired, subject, however, to any defect that might

pertain to the use of a transparent window of elastic material as compared with the use of a transparent window integral with the body of the envelop."

Manifestly two things cannot be the equivalent which fundamentally differ not only in essentials of construction but do not produce the same result.

In regard to Boldt it may be said as was in *American Graphophone Co. v. Leeds & Catlin Co.*, 170 Fed. 327 (C. C. A.):

"Is not the fact that the patent was never heard of until it was resurrected for the purpose of this litigation, persuasive evidence that it contained nothing of value to the art? * * *

"In short, we are unable to see that Adams-Randall's contribution to the art advanced it a single step. His patents abound in tentative, indeterminate and infeasible suggestions too nebulous to anticipate a patent which has actually shown the art how to make the thing needed. In contemplation of law an invention does not exist until the inventor's ideas have been reduced to practical form. As was said in *Standard Cartridge Co. v. Peters Co.*, 77 Fed. 630, 645, 23 C. C. A. 367, 381: 'The mere existence of an intellectual notion that a certain thing could be done, and, if done, might be a practical utility, does not furnish a basis for a patent, or estop others from developing practically the same idea.' The burden of proving anticipation by clear and convincing evidence rests heavily upon the defendants."

It is rather strange that the defense should put forward the Boldt two-piece envelop as an anticipa-

tion of Cohn, when it admits that the Callahan two-piece envelop does not anticipate a one-piece envelop, omitting the border.

Of course they are estopped by Mr. Banning's letter of December 16, 1903, to claim anticipation by Callahan. Manifestly, the Boldt concept of an advertising envelop is no closer to the Cohn concept of an advertising envelop than was the Callahan envelop to the original Reese-Regenstein concept.

BOLDT NOT PRACTICAL; NEITHER DOES IT EMBODY THE

COHN CONCEPT.

Mr. Cohn says in regard to Boldt (R. 164):

“The main objection in trying to use a wrapper of this kind for a commercial envelop would be the cost of making same. Boldt in his patent explaining that a covering such as mica, gelatine or celluloid could be used as a covering over an opening in an envelop or wrapper. Any one of the substances named are too high in price to be put to practical use in a commercial envelop, and this particular feature has been brought to a much more practical state by A. F. Callahan in his patented two-piece envelop, known as the ‘Outlook Envelop’ Callahan 1902 patent, now in evidence.”

As to the defendant's claim to Boldt delineating a *trade-mark or name*, or other symbol, or any design or symbol *for the purpose of advertising*, Mr. Cohn says:

"I can point out no such feature as the drawings in question do not disclose any. The only drawing shown outside of an ordinary opening intended for the display of merchandise, is Figure 8, which shows a letter N. *This drawing, however, is absolutely meaningless, and does not convey to the mind an advertising feature of any sort, as there is no printed matter in conjunction with same, and the letter used might stand for needles, noodles, necklaces, or any articles which would begin or end with the letter N. It is plain to be seen that an envelop with this shaped opening could not be practically used for an addressing space, owing to the peculiar construction of said opening. I notice in Boldt's specification that he says, 'the same purpose may be effected by painting or embossing or otherwise delineating a trade-mark or a name, or other symbol, or device upon the transparent covering as indicated in Figure 9.'* Inspection however of Figure 9 does not disclose any such matter described by Boldt, and if it did it would entirely defeat the object of my second patent and the Heinz envelop referred to, in making the address on an enclosure unreadable. * * *

"It would defeat one of the objects of my second patent, which object is to have a transparent addressing space, unobstructed by any printing, painting or embossing upon said transparent addressing space, as probably indicated by Boldt in his specifications but not shown in any manner in the drawing Boldt referred to. Boldt's entire object, as disclosed by his specifications was the displaying of various articles of merchandise, and it is very evident from his specifications and description that he had absolutely no other object in mind. While a wrapper such as described by Boldt might be practical to cover

articles of merchandise that retail as low as 5c or 10c a piece, it would never be practical for a commercial envelop, because as explained before, the cost of manufacturing would be entirely too great, nor could a package or wrapper, as described by Boldt, be commercially produced in an envelop machine."

Mr. Regenstein says as to printing anything on the transparency itself (R. 299):

"The trade-mark of the Heinz Company represents a pickle; which shows the word 'Heinz' on the pickle. The only way Heinz would accept the envelop was to show the word 'Heinz' the same as appears on the trade-mark. *It is impractical to print the word Heinz on the transparency, as it would interfere with the clearness of the window, and the only way to bring it out is to print it on the inside of the bottom flap.*

THIS TESTIMONY IS CONVINCING PROOF TO SHOW :

1ST, THAT BOLDT DOES NOT ANTICIPATE COHN ;

2ND, THAT COHN'S STRUCTURE INVOLVES INVENTION ;

3RD, THAT THE HEINZ ENVELOP IS THE MECHANICAL EQUIVALENT IN ALL ITS DETAILS OF THE COHN ENVELOP, AND IS AN INFRINGEMENT OF THE SECOND COHN PATENT.

THE RULE REGARDING ANTICIPATION BY A FOREIGN PUBLICATION OR FOREIGN PATENTS IS STRICTER THAN IN THE CASE OF ALLEGED ANTICIPATING AMERICAN PATENTS AND IS MORE FAVORABLE TO A PATENTEE.

As was said in *Hanifen v. Godlshalk Co.*, 84 Fed. 649:

“It is a well settled and familiar doctrine that an invention *patented here* is not to be defeated by a *prior foreign patent* unless its descriptions or drawings contain or exhibit a substantial representation of the patented invention in such *full, clear and exact terms* as to enable any person skilled in the art or science to which it appertains, *without the necessity of making experiments* to practice the invention.”

In *Consolidated Car Heating Co.*, 85 Fed., at page 665:

“Great stress is laid upon the English patent to Rose as embodying anticipatory features, but the Rose device did not do the thing that this device does. It did not undertake to do it, and, so far as appears, no one ever thought of its being applied to such a situation, and doing the work in the manner in which the device in question does it. Quite likely the Rose patent had some of the ideas involved in the patent in question, as, for instance, the idea of radiating heat by means of coils of wire, but it did not describe, or even suggest the distribution of heat, either in detail or in substance, in the manner and by the means employed in the complainant's device. As was said by the Circuit Court, *under the rules applying to foreign patents* it cannot be viewed as anticipating the McElroy invention.”

The Circuit Court of Appeals of the Second Circuit, in *Westinghouse Co. v. Great Northern Ry. Co.*, 88 Fed. 263, said:

“The *prophetical suggestions* in English patents of what can be done, when no one has ever tested by actual and hard experience and under the stress of competition the truth of these suggestions, or the practical difficulties in the way of their accomplishment, or even whether the suggestions are feasible, do not carry conviction of the truth of these frequent and vague statements, and are insufficient to render a patent void for want of invention.”

That the Brown and British publications were known for many years without leading to the use of the Cohn or Transo envelops, where such an envelop was so much wanted that the public took it at once the instant Cohn and the Transo Paper Co. offered them, is a proof from experience that the publications were not sufficient under the rule of law.

Judge Van Fleet's opinion contains also a careful and correct estimate of the Boldt British patent.

INVENTION

INVENTION.

Concerning invention and validity and the presumptions favorable thereto attaching to every patent your Honors recently said, in *S. F. Cornice Co. v. Beyerle*, 195 Fed. 516:

“The grant of letters patent is *prima facie* evidence that the patentee is the first inventor of the device, or the discoverer of the art or process, described in the letters patent and of its novelty. *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486, 489, 23 L. Ed. 952; *Lehnbeuter v. Holthaus*, 105 U. S. 94, 96, 26 L. Ed. 939. Not only is the burden of proof to make this defense upon the party setting it up, but it has been held that every reasonable doubt should be resolved against him. *Cantrell v. Wallick*, 117 U. S. 689, 695, 6 Sup. Ct. 970, 29 L. Ed. 1017.”

The claims in issue are what are known in law as “combination” claims: i. e., made up of a number of correlated elements.

It is an elementary rule that in combination claims the invention, if any, lies in the *combination*, and not in the novelty of any individual element.

Imhaeuser v. Buerk, 101 U. S. 660;

Griswold v. Harker, 62 Fed. 389.

The United States Supreme Court on this point said in *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U. S. 301, 53 L. Ed. 805:

“A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or noncomposite instrument. Whoever uses it without permission is an infringer of it.”

No one of all the patents relied on by the defense discloses a *combination* containing elements the same or equivalent to the combinations of the patents in suit or either of them, co-operating upon the same principle, performing the same function in substantially the same manner and producing substantially the same results. In judging of “results,” “principles,” “mode of operation,” etc., we are to consider the *combination* as a *whole* and not the individual elements. The combination is for an *envelop*. That envelop constitutes the claimed combination; and the end sought is a novel *merchantable one-piece transparent window envelop*. Nowhere in the prior art do we find such a combination. We do not find any one who has produced such a combination, much less have we any evidence of any such thing ever having been on the market prior to Mr. Cohn. We have Mr. Regenstein’s word that the Transo envelop, as manufactured by the Transo Paper Co., today occupies the field alone and that he believed himself to be the first manufacturer in the United States; and that he has what is “*now considered the most perfect transparent envelop in existence and has a sale in this country as well as in foreign countries.*”

IT IS SHOWN BY THE EVIDENCE THAT THE TRANSO ENVELOPS EMBODYING COHN'S INVENTIONS HAVE GONE INTO MOST EXTENSIVE USE.

This is sufficient evidence of invention to be decisive in a doubtful case.

“When although the patent was not a pioneer and the prior art discloses various apparatuses which employ from one to three of the elements of the combination claimed, though not in one combination, and where the elements as formerly known were modified so materially as that they would co-operate together as a whole in one combination to produce a new character of device in its class, held to be invention.”

Lamson Consol. Store Service Co. v. Hillman,
123 F. 416, 59 C. C. A. 510.

As said by your Honors in *Morton v. Llewellyn et al.*, 164 Fed. 693:

“Apart from the presumption of novelty that always attends the grant of a patent, the law is that when it is shown that a patented device has gone into general use and has superseded prior devices having the same purpose, it is sufficient evidence of invention in a doubtful case. The Barbed Wire Patent, 143 U. S. 275, 292, 12 Sup. Ct. 443, 36 L. Ed. 154; *Keystone Manufacturing Company v. Adams*, 151 U. S. 139, 143, 14 Sup. Ct. 295, 38 L. Ed. 103; *Irvine v. Hasselman*, 97 Fed. 964, 38 C. C. A. 587; *Wilkins Shoe Button Co. v. Webb* (C. C.), 89 Fed. 982; *National Hollow B. B. Co. v. Interchangeable B. B. Co.*, 106 Fed. 693, 707, 45 C. C. A. 544.”

See also

Kitchen v. Levison, 188 Fed. 658.

CONDUCT OF DEFENDANT IN ADOPTING THE PATENTED
DEVICE IS PROOF OF INVENTION.

The presumption of novelty arising from the grant of the patent and the fact *that the defendants think so well of the device that they use it themselves*, has frequently been assigned by the Courts as the principal reasons for holding an invention patentable.

“The fact that a patentee, by his device, produced results which intelligent and ingenious inventors in the same art had sought for years without avail, and that such device went into immediate and extensive public use, *and was furthermore used by the defendant*, tends strongly to show that it was the result of inventive faculties.” *Dowagiac Mfg. Co. v. Superior Drill Co.*; *P. P. Mast & Co., v. Same*, 115 F. 88, 53 C. C. A. 36 (6th Cir.).

“Where, upon suit for infringement, alleged anticipating constructions are set up by the defendant, the fact that he *appropriated the complainant's production as to the foundation of his own business and had been very successful*, is *persuasive evidence* of the advantages of the complainant's structure over the alleged anticipatory constructions.”

A. R. Milner Seating Co. v. Yesbera, 133 F. 916 (6th Cir.).

All these topics of “extent of use,” “appropriation of the patented structure by defendant,” and

“combination patents” are excellently illustrated and applied in the recent decision of the Supreme Court in *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428, 55 L. Ed. 527:

“The utility of the Grant patent, therefore, was not attained in the Willoughby patent. *The rubber company’s conduct is confirmation of this.* It uses the Grant tire, as we shall presently see, not the Willoughby tires. Let it be granted that they afforded suggestions to Grant, and that he has gone one step beyond them. It is conceded, as we have said, that this invention is a narrow one,—a step beyond the prior art,—built upon it, it may be, and only an improvement upon it. Its legal evasion may be the easier (*Chicago & N. W. R. Co. v. Sayles*, 97 U. S. 554, 556, 24 L. Ed. 1053, 1054), and hence we see the strength of the concession to its advance beyond the prior art and of its novelty and utility by the rubber company’s imitation of it.

“*The prior art was open to the rubber company.* That ‘art was crowded,’ it says, ‘with numerous prototypes and predecessors’ of the Grant tire, and they, it is insisted, possessed all of the qualities which the dreams of experts attributed to the Grant tire. *And yet the rubber company uses the Grant tire. It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation, as others have done.* And yet the narrowness of the claims seemed to make legal evasion easy. Why, then, was there not evasion by a variation of the details of the patented arrangement? Business interests urged to it as much as to infringement. *We can find no answer except that given by the tire company: ‘The patented organization must be one that is essential. Its use in the precise form*

described and shown in the patent must be inevitably necessary.'

"That the tire is an invention is fortified by all of the presumptions,—the presumption of the patent by that arising from the utility of the tire. And we have said that the *utility of a device may be attested by the litigation over it, as litigation 'shows and measures the existence of the public demand for its use.'* *Eames v. Andrews*, 122 U. S. 40, 55, 30 L. Ed. 1064, 1069, 7 Sup. Ct. Rep. 1073. We have shown the litigation to which the Grant tire has been subjected. * * *

"* * * *the extensive use which it attained, and more certainly the exclusive use which it attained, could only have been the result of its essential excellence, indeed, its pronounced superiority over all other forms. Here, again, in our discussion, a comparison is suggested between it and other tires, and the inquiry occurs why capital has selected it to invest in and advertise, and not one of the tires of the prior art, if it be not better than they? But the effect of advertising is mere speculation; to the utility and use of an article the law assigns a definite presumption of its character, as we have seen, and which we are impelled by the facts of this record to follow.*

"To what quality the utility of the tire may be due will bear further consideration, if for no other reason than the earnest contentions of counsel. Aside from those contentions and the ability by which they are supported, *we might point to what it does as a demonstration of its difference from all that preceded it, that there is something in it, attribute or force, which did not exist before,—something which is the law.*

of its organization and function, and raises it above a mere aggregation of elements to a patentable combination. And we may say, in passing, the elements of a combination may be all old. In making a combination the inventor has the whole field of mechanics to draw from. *Leeds & C. Co. v. Victor Talking Co.*, 213 U. S. at page 318, 53 L. Ed. 812, 29 Sup. Ct. Rep. 495."

PATENTABILITY OF THE COHN INVENTION AS SHOWN BY THE DIRECT TESTIMONY OF REGENSTEIN.

First—There is the letter of Messrs. Banning & Banning of Dec. 16, 1903, expressing their opinion that an envelop with opaque stock made transparent with grease and *omitting* a border was clearly patentable over the Callahan patent of 1902 for the two-part "Outlook" envelop. This eliminates Boldt as well as Callahan.

Second—An application was filed by Reese and Regenstein for an envelop embodying this idea.

Third—That a "border" was necessary was *not* obvious from the mere knowledge of the fact that oil would render paper transparent. Like Cohn, Regenstein thought first to get a transparent envelop by the use of a suitable oily preparation alone, but as Regenstein says: "After the blanks were made transparent, it showed that *no matter what oils* we used, the oil would bleed or be out of register."

Regenstein thus made *what was to him a new discovery*.

That to overcome this defect of bleed, he even as an "old printer" *experimented* with various sizes and colors of blocks; different sizes of rings; different inks and different transparency forming preparations. This "experimenting" shows that the problem was not a simple or obvious one. If "old skilled printers" like Regenstein and his associates had to consume days "experimenting" to determine that a border was necessary and to find what pigment or ink was best to use, and that it took over a year to find that the border and oil must be applied on *opposite sides of the sheet*, the problem manifestly did involve thought and study; and that is really what *invention* involves, and what mechanical *skill* does not involve.

"A patent is granted for solving a problem, not for stating one."

Colombia Co. v. Duerer, 184 Fed. 893.

Regenstein himself has shown by the *nature of the problems involve'd*, that it required an exercise of the inventive faculties to successfully evolve the patented combination. He has also shown that the problems were such that he *could not lay claim to possession of the invention until long after Mr. Cohn had filed his applications*.

Fourth—Aside from these "problems" which Regenstein admits he had a hard time in solving and

is thereby corroborated by Mr. Cohn, we have Regenstein's voluntary statements made with pardonable pride:

"THE RING ON A TRANSO ENVELOP ADDS IN EVERY WAY TO THE PERFECT AND CLEAN APPEARANCE OF THE ENVELOP." (REGENSTEIN, R. 320.)

"I AM THE ONLY MANUFACTURER (OF TRANSPARENT ENVELOPS LIKE THE ONES IN CONTROVERSY IN THIS CASE) AND HAVE NEVER SEEN ANY ONE-PIECE TRANSPARENT ENVELOPS MADE BY ANY ONE ELSE IN THIS COUNTRY." (REGENSTEIN, R. 279.)

"OUR ENVELOP IS NOW CONSIDERED THE MOST PERFECT TRANSPARENT ENVELOP IN EXISTENCE AND HAS A SALE IN THIS AS WELL AS FOREIGN COUNTRIES." (REGENSTEIN, R. 279.)

"I HAVE NEVER PUT OUT ANY ENVELOPS WITHOUT A RING." (R. 321.)

To quote from Mr. Regenstein's testimony:

"X. Q. 265. Do you put out any envelopes without the ring or border?

"A. We do not.

"X. Q. 287. Have you ever put out any Transo envelopes commercially without a ring or border?

"A. I have not.

"X. Q. 288. Have you ceased manufacturing Transo envelopes with a transparent window or ring or border, since the beginning of this suit?

"A. I have not.

“X. Q. 289. You are still actively seeking new business for these envelops?”

“A. I am.”

Earlier Regenstien had testified on direct examination:

“Q. 81. Without going into details as to the preparation of the oil or whatever it is that you use, you may state what difficulties you found in that matter, if any.

“A. The difficulties in preparing the windows properly were found on account of atmospheric conditions, nonelastic oils, and various other causes.

“Q. 82. You may state what the fact may be as to losses of envelops through the sticking of the sides together, where the transparent windows were formed, or matters of that kind?”

“A. We have found and experienced in 1906 that the transparent window would stick to the back of the envelop, and have spoiled at least forty to fifty million envelops in that manner.

“Q. 83. You may state whether your company has much money invested in the business of manufacturing the transparent window envelops, or has spent much money for that purpose, from first to last?”

“A. The loss to our company in perfecting envelops is over \$100,000.00.

“Q. 84. How far do you consider that your company has brought the manufacture of these transparent envelops to a condition where they are practical and satisfactory to the public?”

“A. Our envelop is now considered the most perfect transparent envelop in existence, and has a sale in this country as well as in foreign countries.

“Q. 85. To whom, in your opinion and from your knowledge of the facts, is due the credit of bringing the manufacture of transparent window envelops, like those in controversy, to a condition where they are practical, useful, and satisfactory to the public?”

“A. The credit is due to Mr. Ernest Sauerman and myself.

“Q. 86. Mr. Sauerman is one of your co-laborers or associates, is he?”

“A. Yes.

“Q. 87. Did you ever know of any envelops like those in question being on the market, that were manufactured by complainant in this case?”

“A. I do not.

“Q. 88. Do you know of any other concern in the country, outside of your company, that is manufacturing the transparent window envelops, like the ones in controversy in this case?”

“A. To my knowledge, I am the only manufacturer, and have never seen any one-piece transparent envelops made by any one else in this country.”

This sounds like the testimony of a patentee.

Fifth—In regard to the advertising envelops of Heinz and Stickney, Regenstein testifies, R. 301: “They are very much admired.” Although in 1905

Regenstein, "told Mr. Cohn that his idea (in regard to an advertising envelop) was *absolutely impossible and impractical*" (in answer to X. Q. 176). This statement of Regenstein's in 1905 followed later by the disproof of its truthfulness by Regenstein himself is *pertinent to show invention* and the absence of obviousness.

Sixth—Regenstein says in effect, (X. Q. 253 and following): that he "never saw paper made transparent by the use of an oily preparation for any *practical or commercial purpose* until Mr. Reese made his first tests in December, 1903, with the ringless specimen."

That bespeaks novelty as it is the opinion of an expert.

Seventh—Mr. Regenstein, who has had many years' experience in the printing business, in an unguarded moment frankly admits in answer to X. Q. 253:

"I do not think that the making of paper transparent has anything to do with the printing art."

Considering Regenstein's manifest bias and his vital interest in defeating the patents, the foregoing admissions mean in effect, that *the manufacture of these envelops* with their transparent portion formed by the use of an oily preparation, *has nothing to do with the printing art*, and thereby sweeps from the

consideration of the Court the mass of immaterial matter introduced by the defendant relating to pictures with gold frames, three-color work, etc.

Eighth—Further evidence of invention is that it required *special machinery*, as Mr. Regenstein found out when he came to go into the business of putting these envelops commercially on the market. Regenstein testifies (R. 573):

“Q. 9. Was there any necessity of preparing or equipping special machinery or presses to enable you to print twenty-four windows at a single operation?”

“A. We were obliged to buy presses for this purpose which in a sense were not special, but a *great many changes were made to adjust* such presses for our purposes.”

This corroborates Mr. Tooker, who testified that in his experimental work for Mr. Cohn he had to rearrange his presses to apply the oil.

THE WITNESSES OF REGENSTEIN RECOGNIZED HIS SO-CALLED “1904 EXPERIMENTS” AS “SOMETHING ENTIRELY NEW”—BEHRENS (R. 423); THAT “THERE WAS MUCH COMMENT AROUND THE SHOP,” AND THAT REGENSTEIN SAID “IF HE COULD MAKE AN ENVELOP WHICH WOULD BE CHEAPER THAN THE ONION SKIN PATENT, IT WOULD BE A GREAT THING,” MAX LAU (R. 394-5); (THE “ONION SKIN PATENT” REFERRED TO THE CALLAHAN “OUTLOOK” TWO-PIECE ENVELOP); THE WITNESS VOSS (R. 409) WAS ATTRACTED BY THE FACT THAT THE RING PRINT-

ING PLATES WERE "PECULIAR" AND "AN ENTIRELY DIFFERENT MAKE-UP TO THE PLATES BEING USED FOR OUR REGULAR PRODUCTS"; OLSON THE LITHOGRAPHER WHO IS ALLEGED TO HAVE MADE THE FIRST BORDER RINGS FOR REGENSTEIN (R. 383): "THAT WAS THE FIRST TIME I HAD MADE ANY PLATES TO COVER ANYTHING EXACTLY LIKE THIS ENVELOP REFERRED TO." WIEN (R. 364), THAT HE HAD NEVER BEFORE SEEN A BORDER PRINTED AROUND ENVELOPS.

And Mr. Cohn says (R. 150) in corroboration of Regenstein's statement, "The ring on a Transo envelop adds in every way to the perfect and clean appearance of the envelop," that:

"I consider the ring of utmost importance, for the reason that it was this feature that made the one-piece, unpunctured, window envelop a commercial success; no one-piece envelop having been used commercially before I put out my envelops with a ring or border in November, 1904. Ever since that date the envelop seems to be gaining in popularity and * * * .

"I wish to state that although Mr. Regenstein has solved the problem of making a proper border he has not solved the problem of making a window envelop without the border, as stated in his letter of December 10th, 1906, and although over four years have passed since I received this letter Mr. Regenstein still adheres to the border. Unquestionably, *Mr. Regenstein has discovered the same as I have, that printing the border entails considerable expense, and if it were possible to produce a salable, commer-*

cial window envelop without this border, Mr. Regenstein would do so. The operation of applying this border requires the utmost care and skill, as the ink used must be just of the proper consistency and applied with utmost care. It is therefore, self-evident that no one would resort to the border if they could accomplish the same result without it, especially as envelops are sold on an extremely close margin of profit and any saving of expense would be gladly embraced by a manufacturer."

As to Regenstein it may be said, as in *Loom Co. v. Higgins*, 105 U. S. 580:

"If the infringer claims to have known of the combination and to have perfected it, why did he not put into general use, and *why did he not apply for a patent upon it?* He was already a patentee of a difficult and inferior apparatus. He knew all about the method of going about to get a patent. He belonged to a profession which is generally alive to the advantages of a patent right. On the hypothesis of his being the real inventor his conduct is inexplicable."

His excuse for not applying for a patent that he was afraid of being "laughed at" is not convincing.

THE FILE WRAPPERS.

The history of these applications in their course through the Patent Office is interesting and shows with what persistence Mr. Cohn held out for his rights and insisted on the protection being given him which he proved he was rightly entitled to. The

evidence in the case taken after several years of actual practical test of the inventions on the market, show how correct the higher tribunals were, to which Mr. Cohn was obliged to appeal, and which ultimately decided in favor of the patentable novelty of the inventions. Mr. Cohn in order to establish the justness and patentability of his claim in the first or original application was obliged to appeal first from the Primary Examiner to the Examiners in Chief, who manifestly misconceived the references; then by later appeal to the Commissioner the claim of the First Cohn Patent was sustained. The Commissioner said concerning the claim in suit:

“While the final result is to enhance the appearance by concealing the irregular outline, *the result is brought about by mechanical features*, namely, the application of the printed border to a portion of the paper to which the oily preparation has been applied. The British patents are not regarded as anticipations as they require, so far as can be understood, that the envelop blank be made from a transparent sheet of paper, while appellant starts with an opaque sheet of paper.”

Mr. E. B. Moore, the Acting Commissioner of Patents who rendered the decision is the present Commissioner.

The testimony shows how much more there is to the First Cohn Patent than was appreciated by or apparent to either the Commissioner or even Mr. Cohn's attorneys at that time.

Mr. Cohn was also obliged to fight his way with his second or divisional application, but the novelty of the invention seemed to have forcibly impressed itself on the Examiners in Chief who held the invention patentable on appeal. In their decision which appears as an exhibit in the case they said:

“The references are:

“*British Cohn & Shipp, No. 14,478, June 27, 1904;*

“*Busch, No. 11,876, June 1, 1896.*

“Of these two patents British No. 14,478 is the more pertinent. That patent describes an envelop having a window through which the addressee's name on an enclosure may show, said window being ‘oval, rectangular, diamond-shaped, or fancifully bordered’ in outline and having a tinted or colored border surrounding and giving distinction to said window, or, as the specification of the patent puts it (p. 2, lines 10, 11), ‘the finished envelop gives the effect of a transparent, light colored area on an opaque, darker colored background.’ The patent also suggests having transparent letters as in figure 5 and lettering ‘Boots and Shoes,’ thus referring to the business of the sender.

“The applicant in the case before us has carried the idea of this patent a little further by making the fanciful shaped opening in the shape of a pickle, cigar or other symbol of trade and instead of merely referring to the business has used some other advertising matter associated with the article whose form has been given to the window or opening. This idea appears to us to be inventive in character and the claims may accordingly be allowed.”

The fact that this Second Patent was granted without further appeal accounts for its issuance first.

Thus by reference to the file wrappers it is seen that the Brown, Busch and Cohn & Shipp patents were among the references cited by the examiner against the First Cohn Patent, application No. 231,886, filed November 8, 1904. The Commissioner, after fully considering all the references cited, including the *Brown*, the *Busch British Patent* and the *Cohn & Shipp British Patent*, decided that the invention of the First Cohn Patent was patentable over Brown, Busch, Cohn and Shipp, and everything else in the prior art. The file wrappers show that this whole subject was carefully considered by the Patent Office, and that these prior patents neither anticipated or limited the claim of the patent here in suit.

It has uniformly been held by the courts that the presumption of validity which attaches to every patent, is *strengthened* by the consideration given the case in the Patent Office before the patent is granted.

“It is evident that the patent in suit, as finally granted, had a long, hard row to travel, as is disclosed by the proceedings in the Patent Office and the length of time that elapsed between the filing of the application and the granting of the patent. The patent is presumed to be valid, and to my mind this *presumption is strengthened by the consideration given the case in the Patent Office before the patent was granted.*

United Shirt & Collar Co. v. Beatie, 138 Fed., 136-137. (Affirmed C. C. A., 149 Fed. 736).

The learned Counsel for Appellant, in his efforts to discredit the Cohn Patents, and to show that they were improperly issued, was led into an unfortunate inconsistency in his brief in the lower Court, in first giving praise to the Honorable Commissioner of Patents, Mr. E. B. Moore, "as a trained expert of over 26 years practical experience in the Patent Office," and as having "risen from the position of a third or fourth Assistant Examiner to the position of Commissioner. * * * His statement is of great weight and should be given consideration in determining the validity of the Cohn Patents," (p. 60, Defendant's Brief below), and then academically stating that the Commissioner was a political appointee lacking "competent legal knowledge and scientific ability."

Appellant's Counsel has in his present brief avoided his former inconsistency by omitting the *facts* concerning the qualifications of Mr. Commissioner Moore and leaving in the more subtle but unsound inuendo of "inexperience," "incompetency" and "politics."

It is most ungenerous of Appellant's Counsel to say at page 81 of his brief that the attorneys for Cohn "evidently succeeded in this case in persuading the Commissioner to pass the question on to the Courts to determine should litigation ever arise under the patent;" or to say at page 156 of his Brief that the Commissioner was "teased" into granting the Cohn Patent and that he was "ignorant" of the

art relating to the subject matter of the Cohn invention.

All we have to say is that defendant's "hypothesis" is again unsupported by the evidence, and the Commissioner, skilled lawyer, judge, technical and scientific man, as he is (conceded in appellant's own previous admission) unqualifiedly stated that the device of the First Cohn Patent involved invention over anything and everything in the prior art.

It is not necessary to consider here whether or not the Cohn claims are or were narrowed in construction by the references cited; first, because the patentee stuck up for his rights and got the claim that he originally asked for, without amendment. In other words, the claims of the patent were allowed as drawn, *after careful consideration by the Patent Office*. It is, therefore, entitled to a liberal construction, independent of the fact that the respondent's structure, as shown by Exhibit C, and which respondent admits having used, exactly fits the invention described in the patent. For, as was said in *Armstrong v. Betting Bros. & Co.*, 172 Fed. 234, 236:

"They (defendant's specifications) appear to fit the invention described by Schroeder with exactness, and I can see no reason for searching into a controversy between Armstrong and the patent examiner to learn what meaning should be attached to the claims when fitted upon the Schroeder disclosures. No such right inheres to an invader of the Schroeder as it was finally ticketed, labeled and issued from the Patent

Office. The claims which appear in the Schroeder patent are, as I have said, perfect fits for the Schroeder disclosure, and that ought to be the claims and what they mean."

As to the suggestion on page 82 of Appellant's Brief, that the Patent Office Officials were not "furnished with exhibits or illustrations of" three-color pictures and lithograph labels "showing the use of borders," it is only to be said that the Patent Office experts were just as much charged with the knowledge of these methods and processes, and were required to take judicial notice of the same, as was the complainant. In the desperate efforts of the primary Examiner to deny these applications it is not to be presumed that he overlooked anything that the printing art would afford.

It is to be presumed that the law was complied with by both the applicant and the Patent Office Officials and the proceedings can only be impeached for fraud.

Seymour v. Osborne, 11 Wall 516, 542.

As said in *Victor Talking Machine Co. v. Leeds & Catlin*, 165 Fed. 931:

"It would seem that if an inventor applies for a patent in the United States and it is granted it is presumed that the Patent Office has inquired into all the facts prerequisite to the granting of the same, and has found that the applicant is entitled thereto."

THE SIMPLICITY OF THE INVENTION IS NO GROUNDS
FOR DENYING ITS PATENTABILITY.

Kitchen v. Levison, 188 Fed. 658 (C. C. A.,
9th Cir.) ;

S. F. Cornice Co. v. Beyerle, 181 Fed. 692,
affirmed by your Honors, 195 Fed. 516 ;

Pelton Water Wheel Co. v. Doble, 186 Fed.
526, affirmed by your Honors, 190 Fed.
761 ;

Expanded Metal Co. v. Bradford, 214 U. S.
366, 53 L. Ed. 1034.

The question of Invention by Cohn was also carefully considered by Judge Van Fleet (notwithstanding the bold statement of Appellant to the contrary) and your Honors' attention is most respectfully directed to the opinion of the Court below.

INFRINGEMENT

INFRINGEMENT.

. ADMISSIONS ON THE RECORD.

1. THAT DEFENDANT HAS USED THE HEINZ ENVELOP (EX. C.) WITHIN SIX YEARS LAST PAST IN THE NORTHERN DISTRICT OF CALIFORNIA, AND BEFORE THE BRINGING OF THE SUIT. (STIPULATION R. 44.)

2. THAT THE HEINZ ENVELOP INFRINGES THE FIRST COHN PATENT (X. Q. 109, R. 551.)

3. THAT THE FIRST CLAIM OF THE SECOND COHN PATENT IS INFRINGED (R. 82).

This admission by Mr. Sullivan was subsequently withdrawn by Mr. Banning, but the admission is entitled to weight as being consistent with common sense and the evidence and as the opinion presumably of an expert.

4. DEFENDANT ADMITS THAT THE HEINZ ENVELOP IS NEARER TO COHN THAN IT IS TO ANY OTHER PATENT BEFORE THE COURT (R. 546).

THE QUESTION OF INVENTION AND MECHANICAL EQUIVALENTS IS OFTEN DETERMINED BY CONSIDERING WHETHER THE INFRINGING DEVICE IS MORE LIKE THE PATENT IN SUIT THAN THOSE DEVICES CLAIMED TO ANTICIPATE THE PATENT.

Dowagiac Mfg. Co. v. Minnesota Moline Plow Co., 118 Fed. 136, *supra*;

National Hollow B. B. Co. v. Interchangeable B. B. Co., 106 Fed. 199.

It is not disputed that Regenstein employs precisely the same method in preparing his Transo and Heinz envelops that is shown and described by Mr. Cohn. That is to say Regenstein like Cohn starts with an opaque stock; he uses an "oily preparation" which "has a tendency to creep or bleed beyond the borders of the space embraced by the stamp or die by which it is applied;" (X. Q. 196, R. 306). "That the effect of such creeping and bleeding is to stain or discolor the rest of the envelop or leave a ragged appearance to the window opening," (X. Q. 197); "that the border or ring is to obliterate such appearance of creep and give definition to the window opening," (X. Q. 198); and "that the ring or border is applied on one side of the sheet, to-wit: on the outside and that the oily preparation is applied on the opposite or inside of the sheet," (X. Q. 202, R. 307)

"In the sense of the patent law the substantial equivalent of a thing is the same as the thing itself."

Winans v. Denmead, 15 How. 330, 342;

Machine Co. v. Murphy, 97 U. S. 120.

"The changes which the appellants have made are immaterial and indeed are but a subterfuge made evidently for the purpose of evading the wording of the claim, they are unavailing."

Hoyt v. Horne, 145 U. S. 302, 308.

As was said by your Honors in *Jensen v. Norton*, 67 Fed. 236:

“Two devices are equivalent when one can be adapted to perform the functions of the other. Rarely can one element be removed bodily from one machine to the other without any change whatever. *Where that can be done, in such cases there can be no doubt of equivalency and infringement.*”

See also—

Alaska Packers Ass’n v. Letson, 119 Fed. 599.

DOCTRINE OF EQUIVALENTS.

Walker on Patents, Sec. 358, says:

“It is safe to define an equivalent as a thing which performs the *same function in substantially the same manner*, as the thing of which it is alleged to be an equivalent.”

At page 146 of Appellant’s Brief, counsel quotes Judge Morrow on the question of infringement and mechanical equivalents as follows:

“To sustain a claim of infringement three things must be found: First, *identity* of result; second, *identity* of means; third, *identity* of operation.”

We have only to say that this case was *reversed* on appeal, see 142 Fed. 141, your Honors holding

that, "the Eldridge device performs the same function as that of the Jordan device, and we are of the opinion that it performs it in *substantially the same way*, that the defense is not sufficient to avoid infringement, and that under the doctrine of equivalency, applicable to this case, the Eldridge device is the equivalent of the bumper or squeezer of the Jordan patent. * * * It is the whole purpose of the doctrine of equivalents to protect the inventor against piracy and to secure to him the benefit of that which he has invented."

EQUIVALENCY OF PARTS AS SHOWN BY THE FACTS.

FIRST COHN PATENT.

As it is admitted by the defendant that the Heinz envelop Exhibit "C" embodies the construction and combination of the claim of the First Cohn Patent, (X. Q. 109, R. 551), further consideration of this claim is therefore unnecessary.

SECOND COHN PATENT.

For convenience these two claims are again here set out and are as follows:

"1. An advertising device comprising an envelop having a window through which the addressee's name on an inclosure may show through said window being in outline characteristic of some symbol of trade, a tinted or colored border

surrounding and giving definition to said window and permanent advertising matter forming no part of the address, appearing on said tinted border, and related to and in juxtaposition with the outline of said window.

"2. As an advertising device, an envelop having a generally opaque face except for a transparent window portion through which an addressee's name on an inclosure may show through, said window being in general outline characteristic of a symbol of trade, and permanent printed matter on the face of the envelop related to and in juxtaposition with the outline of the window and co-operating with said outline to indicate a particular brand of goods."

MR. SULLIVAN'S ADMISSION AS EVIDENCE OF THE OBVIOUS.

At the time of the introduction of Complainant's *prima facie* evidence Mr. Sullivan, representing the respondent, and an attorney of intelligence, integrity and recognized standing, and a member of the bar of this Court, *voluntarily admitted that claim 1 of this Second Cohn Patent* was found in its entirety in the Heinz envelop (R. 82):

"MR. SULLIVAN: We admit that Exhibit C does contain those features; that is, that it has a 'window through which the addressee's name on the enclosure may show, said window being in outline characteristic of some symbol of trade, a tinted or colored border surrounding and giving definition to said window, and permanent advertising matter forming no part of the address, appearing on said tinted border, and related to and in juxtaposition with the outline of said window.' Is that what you want?"

“MR. TOWNSEND: *You concede that the entire combination of claim 1 is shown in Exhibit C?*”

“MR. SULLIVAN: *We concede that the exhibit does show that.*”

In making this statement Mr. Sullivan interrupted the Complainant's witness Mr. Maynard, who was explaining the patents and was offering proofs of infringement of this claim in the usual manner.

While Mr. Sullivan's interruption and admission was unnecessary as far as Complainant was concerned and is claimed to have been unauthorized by the Defendant, nevertheless, his admission of infringement was in good faith and consistent with the justice and common sense view of the case.

Counsel for defendant would have the Court believe that we are relying entirely on the admission of Mr. Sullivan to prove infringement of the Second Cohn Patent.

Unfortunate as Mr. Sullivan's admission was no doubt to the defendant, nevertheless, it is entitled to weight as a voluntary admission of the defendant's own counsel, and it therefore may be taken as the opinion of an expert. In any event the case of *Jones v. Morehead*, 1 Wall. 164, relied on by defendant at page 150 and following of his Brief, is sufficient to fasten on defendant infringement by the use of the one particular envelop introduced in evidence as the Heinz envelop, as Exhibit “C.” As that was

the only infringing envelop before the Court, and all the other infringing envelops are made like it, it is not seen why that one instance would not be sufficient to sustain the prayer of the Bill.

However, as there is no intention or desire to take an unfair or technical advantage of the Defendant, the proofs, independent of the foregoing admission amply substantiate the claim of infringement.

Mr. Bond in trying to show the variation practised by the defendant admits that the combined function of the Heinz window and border is "to present to the eye the outline of a cucumber," which of course is what is done by Mr. Cohn. But he argues that in Heinz the figure of the cucumber lies in the border, whilst in Cohn it lies in the outline of the window. Manifestly that is a distinction without a difference.

Mr. Bond also points out that the "permanent advertising or printed matter" is displayed in a different way or in a little different position in the Heinz envelop than is shown in the drawings of the Cohn Patent.

The chief fallacy of this position of the defendant is that it leaves out of consideration the "doctrine of equivalents."

Of course in this case like in nearly every case of patent infringement there are physical differences between structures which are more or less apparent.

However, Mr. Bond *admits equivalency*. Thus on direct examination (R. 493):

“The border, surrounding the transparent window, in the Heinz envelop, has an edge or outline, around its periphery or outer edge, resembling a cucumber, and on the inside of the back of the envelop is printed the word ‘Heinz.’ The purpose of this representation of a cucumber, and the use of the word Heinz showing through the transparent window, as I *understand the same, is to carry into the envelop the trade-mark* of the Heinz Pickle Company, as used in connection with the receptacles containing articles put up by said Heinz Pickle Company.”

Again, (R. 494), Mr. Bond testifies:

“Q. 52. How is the window, shown in Figure 1 of the drawings of this Second Cohn Patent, considered by itself—in the shape of some article or thing sold and dealt in?

“A. It presents the outline of a cucumber.”

“Q. 53. What is employed in the Heinz envelop to *present the outline of a cucumber?*”

“A. The surrounding border, the outer edge of which is made to present the outline of a cucumber.”

THE COURT WILL APPRECIATE WHAT SHALLOW ICE THE DEFENDANT IS ON BY OBSERVING THAT THE SECOND COHN PATENT SHOWS IN FIG. 1 THAT THE OUTER EDGE OF THE BORDER PRESENTS ALSO THE OUTLINE OF A CUCUMBER. CERTAINLY HEINZ WAS NOT THE FIRST TO MAKE A BORDER IN THE OUTLINE OF A CUCUMBER.

On cross examination Mr. Bond testifies as to *equivalency* as follows, (R. 542):

“X. Q. 90. Look at the drawing, Figure 1 of the Second Cohn Patent, and state what the shape of the border therein shown represents?”

“A. The periphery or outer edge is in outline representing a cucumber, corresponding to the outline of the edge of the transparent window.”

And again:

“X. Q. 93. Looking at the ‘Heinz’ envelop, which I hold before you, with the face presented to your view, what is there displayed which indicates a particular brand of goods?”

“A. The representation of a cucumber formed by the exterior or outside edge of the border surrounding the window; which would be the same, in effect, if the window were omitted.

“X. Q. 94. How about the word ‘Heinz’?”

“A. Inasmuch as ‘Heinz’ or the Heinz Company is known as the manufacturer of pickles, including cucumbers, the border, in and of itself, and with the word ‘Heinz’ imprinted within the border, would indicate the concern just the same if the transparent window was not present. My recollection is that the trade mark of the Heinz Company is the representation of a cucumber, with the word ‘Heinz’ printed thereon, and usually this is accompanied by the words ‘57 varieties,’ forming, however, as I understand it, no part of the trade mark.

“X. Q. 95. So that, in this Heinz envelop, the representation of the outline of a cucumber, as-

sociated with the word 'Heinz,' immediately conveys to your mind the goods or business of the defendant company? Is that true?

"A. Yes; and it would be precisely the same if I should see a label, presenting in outline a cucumber, and having within the body of the cucumber the word 'Heinz'."

And further:

"X. Q. 98. The position of the word 'Heinz' on the envelop, either appearing where the words 'John Doe' appear in Figure 1 of Cohn, or inside of the border, as in Heinz, makes no material difference, or any difference in fact, does it, as far as the collocation of the word and cucumber are concerned, in indicating the particular brand of goods?

"A. No, but it would make a difference in pointing out the manufacturer. If the name of the manufacturer were imprinted on the outside face of the envelop, it would be present whether the envelop contained an inclosure or not, while if printed on the inner face of the back of the envelop it would not appear, when there was an inclosed letter in the envelop. In the one case, as contemplated by Cohn with his envelop, the name is in co-relation to the symbol of trade, and permanent on the face of the envelop where it can always be seen. In the other case, as contemplated in the Heinz envelop; the name of the manufacturer would only appear when the envelop was empty.

"X. Q. 99. By my last question, I meant the envelop pure and simple as an envelop, without an inclosure. In that case, does it make any dif-

ference whether the words appear as they do in the Heinz envelop or as shown in Figure 1 of the Cohn; assuming, of course, that the word 'Heinz' is substituted for the words 'John Doe'?

"A. So far as concerns the word 'Heinz' in co-relation with a cucumber, there would be no difference, whether the word 'Heinz' appeared outside of the representation in outline of a cucumber produced by the configuration of the edge of the cut, or whether such name appeared within the space occupied by the representation of the cucumber.

"X. Q. 100. Which envelop, to your mind, is to be preferred—the Cohn envelop or the so-called Heinz envelop?

"A. Personally, the Heinz envelop would be my preference. Other persons might prefer the Cohn envelop, in which the outline characteristic of a symbol of trade was produced by the transparent window instead of by the border."

Again Mr. Bond testifies:

"X. Q. 104. The word 'Heinz' on the Heinz envelop, which appears inside of the cucumber shape, is on the opaque stock of the envelop, is it not?

"A. Yes, it is on the inner face of the opaque back of the envelop."

And again:

"X. Q. 108. With the Heinz envelop laying flat on the table before you, face up, the word 'Heinz' appears on the face of the envelop in association with the cucumber outline, does it not?

“A. Yes, such outline being produced by the periphery or outer edge of the opaque border and not by the outline of the transparent window.”

Thus Mr. Bond admits that the word “Heinz” printed on the inside of the envelop “appears” to be printed on the face; that it is “permanent advertising matter;” that it is on the *opaque part* of the envelop; is *associated with the window*, and with the pickle outline; and that *the word “Heinz” with the pickle outline represents the defendant’s trade-mark* as it was designed and intended it should be. Obviously the desired result is accomplished by means “substantially like” the means shown and described and claimed in the patent in suit.

If a device performs the *same function*, the fact that it also performs another function is immaterial to any question of infringement. (Walker, p. 309, Sec. 352).

Appellant’s contention of non-infringement of claim 1 of the Second Cohn Patent is, that by a simple *change in location, or form* of one or two of the elements of the claim, yet keeping all the elements in the sequence called for by the claim, and producing all of the results of a successful advertising envelop designed to be secured by the patent, that such colorable differences are sufficient in themselves to avoid infringement. Such refinements, and especially in an invention possessing

the novelty that this one admittedly does, are not encouraged or supported by the law covering the construction of claims.

MERE CHANGE IN FORM, PROPORTION, OR DEGREE, OR LOCATION OF PARTS; DOING THE SAME THING IN SUBSTANTIALLY THE SAME WAY, DOES NOT AVOID INFRINGEMENT.

Walker on Patents, Sec. 363.

It is also a familiar rule that even where a *change of form* somewhat modifies the construction, the action, or the utility of the patented device, non-infringement will seldom result from such a change.

Walker, Sec. 363;

Risdon Iron & Locomotive Works v. Trent,
92 Fed. 375.

But form, location and sequence of elements are all immaterial, unless form or location or sequence is essential to the result, or indispensable, by reason of the state of the art, to the novelty of the claim.

Norton v. Jensen, 49 Fed. 859 (C. C. A. 9th Cir.);

Winans v. Denmead, 15 How. 330, 14 L. Ed.,
717;

Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co., 10 C. C. A., 194, 61 Fed. 958;

Bundy Mfg. Co. v. Detroit Time Register Co., 36 C. C. A., 375, 94 Fed. 524.

After withdrawal by the defendant of Mr. Sullivan's admission of infringement of claim 1, Mr. Cohn was called and testified as follows for the complainant (R. 200):

"In looking at the first claim of my Second Patent, I find the following:

" 'An advertising device comprising an envelop having a window through which the addressee's name on an enclosure may show through.'

"Referring to the Heinz envelop, I find that it is an advertising device comprising an envelop having a window through which the addressee's name on an enclosure may show through. The claim states:

" 'Said window being in outline characteristic of some symbol of trade.'

"Referring to the Heinz envelop we find that it has a window being in general outline characteristic of some symbol of trade, namely, that of a pickle or cucumber, which is specifically shown in the drawing of my patent, Figure 1, and is especially mentioned in the specifications as being 'a cucumber, the trade-mark of a well-known manufacturer of a great many varieties of goods,' and while the drawing referred to shows the name 'John Doe,' this name is purely ficti-

tious, the general public knowing that the name 'Heinz' was intended, and the only reason that it was not used was on account of the limitations in the Patent Office, which bar the real names of persons or firms. The claim states:

“ ‘A tinted or colored border surrounding and giving definition to said window.’

“Referring to the Heinz envelop we find a tinted or colored border surrounding and giving definition to the window.

“The claim further states:

“ ‘And permanent advertising matter forming no part of the address, appearing on said tinted border, and related to and in juxtaposition with the outline of said window.’

“Referring to the Heinz envelop we find permanent advertising matter forming no part of the address appearing through the window and on the face related to and in juxtaposition with the outline of said window.

“In my claim and also in my specifications, I do not limit myself as to the exact location of the permanent advertising matter, the main feature being the *mechanical combination of the advertising matter with the window*. I state in the beginning of my specifications, as follows:

“ ‘The object of this invention is to so design the window opening and to associate with said window such descriptive matter as will offer novel and unique possibilities for advertising.’

“Referring to the Heinz envelop we find that it accomplishes the desired result referred to, and is accomplished by the association of the

printed matter and the pickle-shaped border. The word 'Heinz' taken by itself and not associated with anything else would be meaningless, a pickle-shaped border not associated with any printing matter would have no value as an advertising device because it might mean any pickle manufacturer, but when we take the mechanical combination of these two, namely, the pickle-shaped border or window and the word 'Heinz,' we have, and I will now use the language of the specification, 'a striking advertisement of a particular brand of goods of a particular merchant or firm.' It is therefore, self-evident that the desired object of my patent and the object of the Heinz are identical and produced by exactly the same means. If the person who drew the specifications for my second patent had a Heinz envelop before him, I cannot possibly see how he could have described it more fully or completely, and it is very probable that whoever designed this Heinz envelop had a copy of my specifications before them at the time. Taking the Heinz envelop, I will paraphrase a portion of the specifications beginning at line 37, of the second page, in order to more clearly illustrate my meaning:

“ ‘When there is associated with a window opening of characteristic or peculiar design,’ as in this Heinz envelop, a window in the shape of a pickle,

“ ‘A trade name, or some word,’ in the Heinz envelop, the word ‘Heinz;’

“ ‘Or words,’ and in the Heinz envelop the words ‘H. J. Heinz Company;’

“ ‘Usually associated with or relating to the pictorial feature,’ in the Heinz envelop the pictorial feature being the pickle;

“ ‘Every one seeing the envelop is confronted with a striking advertisement of a particular brand of goods of a particular merchant or firm.’

“In the Heinz envelop we see this striking advertisement, and immediately associate it with the Heinz pickle concern. Summing up I find that every element expressed in claim 1 of my second patent appears in the Heinz envelop, and I find no elements in the Heinz envelop which are not expressed in this claim. The location of the printed matter is immaterial and the fact that the single word ‘Heinz’ is printed on the inside of the envelop but appearing through the window and in association with same, does not in any way *affect the desired result*. *As a matter of fact, any one holding this envelop a few feet away could not tell if the word ‘Heinz’ was printed on the inside or on the face of the envelop. The fact remains that it is clearly related to, ‘and in juxtaposition with the outline of said window.’*

“R. D. Q. 189. In how far, if at all, would the foregoing statement apply or not apply to the combination of the second claim?

“A. The foregoing explanation would apply in its entirety to claim 2. I would like to add however, that in considering the Heinz envelop with regard to claim 1 that the word ‘Heinz’ *appears* (and I wish you would underline the word ‘appears,’ as I wish to emphasize this word) on the face of the envelop, and that I did not limit myself to the fact that it should be

printed on the face, in claim 1; the claim simply stating that it should appear and I had in mind at the time I applied for this patent a combination of this character, as I am fully aware of the fact that the Heinz trade-mark usually shows a pickle with the words, 'Heinz' appearing within the outline of the pickle. Taking the drawing Figure 1, in my second patent, and the Heinz envelop I find nothing in my claims or specifications which limits me to the location of the permanent advertising matter; the object being as I stated before to show the association between the permanent advertising matter and the window or border."

Mr. Cohn was not cross examined on this matter of infringement and his testimony stands admitted on the record, except in so far as Mr. Bond's previous disingenious explanations represent the defendant's viewpoint; *which explanations as we have seen, studiously avoided as far as possible the "doctrine of equivalents."*

The foregoing showing of infringement of claim 1, proves at the same time infringement of claim 2; the defendant maintaining that claim 2 must be limited to a *window* "in general outline characteristic of a symbol of trade," and that the printed matter must be "on the face of the envelop." Of course there is nothing in the prior art requiring any such over refined limitation of the claim and besides the spirit of the claim, if not the exact letter, is manifestly present in the Heinz envelop; and it needs no

great liberality of construction to read the letter of the claim on to the infringing devices.

Mr. Maynard (R. 83), fully sustains Mr. Cohn. He says:

“The location of the word ‘Heinz’ with relation to the outline, or the pickle outline of the window, simply arrives at the same result, as that is, advertisement. * * * The means for arriving at the result—that is, advertisement—are precisely the same. The patent calls for an opaque envelop having a transparent window and in association with said window suitable words, as the name of a firm, and also states that the outline of the window may be shaped into the symbol of trade of a manufacturer. Whether the word ‘Heinz’ is printed at any certain position on the envelop does not affect the results. The instrumentalities for accomplishing the advertising are the same. The patents call for an opaque envelop. The exhibit marked C is an opaque envelop. The patents call for a transparent window made by the application of a suitable preparation on the inside of the envelop and also call for a suitably-tinted outline around the transparent window to cover the effect of creep of the material producing the transparency, and the patents, taken as a whole, involve an envelop of this structure, having associated with the particularly-shaped window suitable words so that the association of the two will form an advertising of the firm distributing the envelop.”

As to the position of the word "Heinz" inside the pickle and envelop Mr. Maynard says (R. 90) :

"Of course it is not *on* the face of the envelop, but it *appears* just as plainly as if it were printed on the face of the envelop, no matter if it is printed on the inside, at the back of the envelop * * *"

From the foregoing we see that any changes which the defendant has made in his infringing Heinz envelop are merely in form, proportion or degree, varying slightly the shape of the window and transparency so as to adapt the window perhaps a little better to allow the sendee's name and address to show through, but still indicating the pickle trade-mark of the defendant; and putting the permanent printed advertising matter "Heinz" inside the envelop instead of *outside*, but still so that it *appears* to be on the outside, and is in "juxtaposition with and related to" the outline of the pickle. That constitutes equivalency.

Smith v. Nichols, 21 Wall. 112, 22 L. Ed., 566;

Belding Mfg. Co. v. Corn Planter Co., 152 U. S. 100, 38 L. Ed. 370.

The doctrine of equivalents may be invoked for all patents, and not merely for pioneer ones, but the range of equivalents depends upon and varies with the degree of invention.

Kitchen v. Lerison, 188 Fed. 658 (C. C. A. 9th Cir.) ;

Paper Bag Cases, 210 U. S. 405, 52 L. Ed. 1122 ;

Hickmott v. Canning Co., 142 Fed. 145 (C. C. A. 9th Cir.).

Judge Van Fleet's Conclusion on Infringement of the Cohn patents is a full and clear statement of the facts and the law of the case.

THE EQUITIES OF THE CASE.

At page 151 and following of Appellant's Brief, it is sought, precisely as in the Court below, to enlist the sympathies of this Court on behalf of Mr. Regenstein because he has spent a lot of money in building up the Transo Envelop business. His patience, and the time and money he has expended, and the extent of his present business bespeaks the novelty of the Cohn inventions and their merit.

But if ever the equities were with an inventor and patentee in a patent suit they would seem to be with Mr. Cohn here.

Counsel's argument seems to overlook *Mr. Cohn's* expenditures and experiments during 1903 and 1904,

culminating in the placing of 10,000 of his envelopes in circulation long before Regenstein or the Transo Envelope Co. were ever heard of. The argument on behalf of defendants overlooks the contemptuous letter of Regenstein of December, 1906, in reply to Mr. Cohn's notice of the issuance of his patents and inviting the opening of negotiations. It also overlooks Regenstein's slavish copying of the Second Cohn Patent in 1908 and 1909 when he had an order for advertising envelopes like the Heinz pickle envelop and the Stickney cigar envelop, although in 1905 he told Mr. Cohn that this advertising idea was impractical and impossible.

WARNING NOTICES.

Furthermore, capital is attempted to be made of the "warning notices" sent out by Mr. Cohn after the filing of this suit. We have only to call attention to the recent case of *Virtue, et al., v. Creamery Package Mfg. Co., et al.*, 179 Fed. 115, Cir. Court of Appeal, 8th Circuit, giving the rule and showing it was an act of kindness on Mr. Cohn's part to notify infringers of the pending suit:

"That the owner of a patent may notify infringers of his claims, and warn them that, unless they desist, suits will be brought to protect him in his legal rights, is sustained by numerous decisions. *Kelley v. Ypsilanti Dress Stay Manufacturing Co.* (C. C.) 44 Fed. 19, 10 L. R. A.

686; *Computing Scale Company v. National Computing Scale Company* (C. C.) 79 Fed. 962; *Farquhar Company v. National Harrow Company*, 102 Fed. 714, 42 C. C. A. 600, 49 L. R. A. 755; *Adriance, Platt & Co. v. National Harrow Company*, 121 Fed. 827, 58 C. C. A. 163; *Warren Featherbone Company v. Landauer* (C.C.) 151 Fed. 130; *Mitchell v. International, etc., Company* (C. C.) 169 Fed. 145; 30 Cyc. 1054.

“The only limitation on the right to issue such warnings is the requirement of good faith. There is nothing in the warnings given in this case to show that the letters or notices were false, malicious, offensive, or opprobrious, or that they were used for the willful purpose of inflicting injury. In such a case it was said, in *Kelley v. Ypsilanti*, *supra*:

“‘It would seem to be an act of prudence, if not of kindness, upon the part of a patentee, to notify the public of his invention, and to warn persons dealing in the article of the consequence of purchasing from others. *Chase v. Tuttle* (C. C.), 27 Fed. 110; *Boston Diatite Company v. Florence Manufacturing Company*, 114 Mass. 69 (19 Am. Rep. 310); *Kidd v. Horry*, 28 Fed. 773.’

“There is nothing in this case to indicate that any of the warnings issued by the defendants were made in bad faith, and they were promptly followed by the institution of the infringement suits. In issuing notices and warnings we think the defendants were acting within their legal rights. If they had the right to bring the suits, they had the right to issue the warnings. It may be, and probably is, true that the pendency of

these suits resulted in some damage to the plaintiffs by lessening the sale of the challenged device; but such damage was an incident of the suits, and cannot be made the basis of a recovery."

CONCLUSION

CONCLUSION.

To summarize: we see that the only methods disclosed by the patents offered by the defense, for the manufacture of envelopes with a transparent panel to disclose the address, are:

(a) to make the envelop of *transparent* paper and to render the face opaque around the transparent panel or window;

(b) the *suggestion* to make the envelop of *opaque* material and to render the panel transparent; and

(c) the *suggestion* to manufacture the *entire envelop of opaque material* and render the panel section transparent by *reducing it in thickness*.

The first method is disclosed, for example, in the English Patent to Busch. The second method is *mentioned* by Brown, U. S., 1862, and the third method is suggested in the patent to Reese, August, 1904. (The latter patent being later than Cohn's inventive act cannot be considered part of the prior art.)

Neither of the above methods, however, contributed to the art, as we have seen, any *practical method* of manufacturing this class of envelopes. The first method is defective, for the reason that the envelop is too light in weight and stiffness and lacks the required stability for the ordinary usage of commercial envelopes and its transmission through the mails, and for the additional reason that any commercial paper,

like tracing paper, for example, which would possibly be used, is too expensive for practical use. The second method, so far as disclosed in the prior art, is merely a *suggestion* that such an envelop could be made from opaque material, with a portion of the face rendered transparent, and Brown suggests that the same method for rendering the panel transparent as now employed in making *tracing paper*, can be used. This suggestion is inoperative for any practical use, for the reasons pointed out that the methods now employed in making tracing paper can only be employed in the manufacture of an *entire sheet* and *cannot be applied to a limited area* of a sheet of opaque paper. To render the panel of the Brown envelop transparent by the application of an oleaginous material would be impracticable from a commercial standpoint according to the testimony of both Cohn and Regenstein, who are in accord that considerable experimenting was required to obliterate the creeping effect of the oleaginous material and to render the outline of the transparent panel sharp and well defined. The third method does not appear ever to have been practiced and it is of very doubtful utility. It is a matter of common knowledge that opaque papers having a pronounced water mark, by which certain portions are rendered thinner, makes the reduced portions of the paper translucent when held up to the light, *but not transparent*.

The first and third methods can therefore be eliminated as making no practical contribution to the art:

The first method because it is too expensive for commercial use, and because the envelop is unfitted by its flimsiness for practical use; the third method for the reason that it is inoperative to produce the desired result and besides is later than the invention of Cohn. *As a matter of fact no window envelops have ever been put commercially on the market manufactured by either the first, second or third method.* The second method, that suggested by Brown, is impracticable and of no commercial value. Brown's idea, so far as disclosed by U. S. Patent 36,393 of September 9, 1862, consists in a mere *suggestion* that a window envelop might be made by using opaque paper and rendering a portion of the face transparent. Brown discloses no method of accomplishing this result, but refers to the *prior art as affording the necessary knowledge*, which, as a matter of fact, the *prior art did not disclose*. The two suggestions made by Brown, namely, that the "tracing paper process" could be used or that an oleaginous substance could be applied, were both impracticable, therefore, Brown, in fact, made no contribution to the art. The mere suggestion that a thing can be done or that the doing would be a benefit to an art, does not involve a patentable invention, nor operate as an anticipation of a practical means for successfully accomplishing the desired result. (Authorities *supra*.).

The production of a perfected window envelop, from opaque material with a panel rendered transparent by the application of an oleaginous material,

was only accomplished by the experiments of Cohn and Regenstein. Both witnesses testify that considerable experimenting was made both in the application of the oleaginous material and in the application of a suitable border to cover the creeping effect and define the outline of the window. All the prior art so far as it relates to envelops does not bear upon the sufficiency of invention exercised by Cohn and Regenstein. All the prior structures other than envelops have no bearing upon the invention disclosed in the claim of the Cohn Patent 835,850. They simply show the application of two colors with one forming a border, while the invention of Cohn had to do with two distinct *processes*; first, the application of *some* preparation which would render the opaque stock of the envelop transparent; and second, to overlay a margin of the transparent portion of the window and the surrounding semi-transparent portion of the envelop with an opaque border. Each of these processes required experiment according to the testimony of both Cohn and Regenstein. The defense, therefore, presents the peculiar attitude of offering testimony to show that the application of the border to the Cohn envelop was anticipated by the prior art, but that it did not anticipate the application of the border to the *Transo envelop, inasmuch as the application of a border to the Transo envelop occupied months of continued experimenting*. In other words, the position of the defense is practically that it did not involve invention for *Cohn* to put a border around the transparent window of an envelop, but that it

did require invention for *Regenstein* to do the same thing. This is certainly blowing hot and cold with the same breath, and is only equaled by the Irish woman's defense for the mutilation of the borrowed kettle. First, that she never borrowed it; second, that it was whole when she returned it; and third, that there was a hole in it when she borrowed it.

THE DEFENDANT'S STRUCTURE IS WITHIN THE CLAIMS SUED ON, AND IT MEETS THOSE CLAIMS AS TO FUNCTION, PURPOSE, MODE OF OPERATION, PRACTICABILITY, COMMERCIAL SUCCESS AND RESULTS GENERALLY SOUGHT BY THE PATENTS IN SUIT; IN SHORT THERE IS COMPLETE EQUIVALENCY BETWEEN THE DEFENDANT'S STRUCTURE AND THE COMPLAINANT'S STRUCTURE, AS A WHOLE, AND BETWEEN THE SEVERAL PARTS OF THE RESPECTIVE STRUCTURES.

Defendant's counsel has tried to belittle the importance of the Second Patent, but when it is taken into consideration that almost every one that can write uses envelopes and that many concerns use a great many thousands daily, it is not as unimportant as he would have it appear.

It requires no argument to prove that an envelop that will fill every requirement of an ordinary envelop and which possesses the additional feature of not requiring an address to be written on its face, *is a labor saving device*. In large concerns where thousands of envelopes are used daily it is a large

item of saving besides insuring accurate addressing, not a day goes by but that hundreds of communications are put in wrong envelops, in many instances causing serious delays and incurring heavy damages.

The Second Cohn Patent contains all the elements of *labor saving* and *proper addressing* belonging to the first patent, with the additional feature of *advertising*.

When it is considered that millions of dollars are annually expended in the United States by various firms advertising their products and trade marks, and that we have in this second patent an article that not only gives the person using the same an excellent advertisement, but also saves him time and money in addressing, etc., we have an article that is in a class by itself.

It is the only advertising device known today that does not cost the user anything; in fact saves the user money.

It must be conceded that it is a striking advertisement and is directly brought to the attention of the recipient.

An advertisement in a magazine or on a billboard may easily be overlooked but an advertisement of this kind forces itself on your attention.

It certainly possesses *every* element of NOVELTY and was so conceded by the largest *advertising firm on this Coast* (see Cohn's testimony re Barnhart & Swasey).

The words of Judge Kohlsaatt in the recent case of Mitchell v. Stevens, 183 Fed. 782, regarding a patent on a "combined letter sheet and envelop" are extremely apt:

"There are a number of combined letter sheet and envelop devices in evidence. This feature of the claims in suit is therefore old. But in all the wide field of advertising mediums no one had ever, before Mitchell, hit upon this feature, which, according to the evidence of a number of skilled and practical advertising men, was a distinctively successful advance in the advertising media. *Anything which will attract the attention of the public in the shape of mail matter is entitled to consideration. Having in mind the pertinacity and ingenuity of those whose life task seems to be the discovery of some way in which to penetrate and quicken the indifference of the public,* it certainly is persuasive that any one should hit upon the device in suit after so many years of aggressive effort in that line, especially in view of the effective commendations of those posted in the advertising line. The record considered, I am of the opinion that the patent should be held valid. * * *

"It is contended that complainant is limited to his one slit in the lower flap. The genius, if it be such, of the Mitchell patent, is found in the combination of the letter effect with the ordinary one cent mail matter. The arrangement of defendant's device in no way adds to its effectiveness as

an advertising medium over complainant's. The card could be securely held on the main or middle sheet of the folder by means of incisions in the sheet only in the manner adopted by defendant. It seems entirely likely that complainant should have considered that method, but preferred his own entirely inclosed card; his main purpose being to provide a one cent mailable folder which should, while open at the ends, still retain much of the advantages of an ordinary letter. *This was his invention. Given that idea, the location on the middle section of the folder cannot be said to involve invention.* Infringement seems to be clearly established."

This whole subject, applicable to both the Cohn patents, may well be concluded by the latest expression of our Supreme Court on the question of Invention, Anticipation and Infringement, in the case of *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428:

"The tire has utility, a utility that has secured an almost universal acceptance and employment of it, as will subsequently appear. It was certainly not an exact repetition of the prior art. It attained an end not attained by anything in the prior art, and has been accepted as the termination of the struggle for a completely successful tire. It possesses such amount of change from the prior art as to have received the approval of the Patent Office, and is entitled to the presumption of invention which attaches to a patent. Its simplicity should not blind us as to its character. Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and, 'in the light of the accomplished result,' it is often a matter of wonder

how they so long 'eluded the search of the discoverer and set at defiance the speculations of inventive genius.' *Pearl v. Ocean Mills*, 2 Bann. & Ard. 469, Fed. Cas. No. 10,876, 11 Off. Gaz. 2. Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration. And it recognizes degrees of change, dividing inventions into primary and secondary, and as they are, one or the other, gives a proportionate dominion to its patent grant. In other words, the invention may be broadly new, subjecting all that comes after it to tribute (*Chicago & N. W. R. Co. v. Sayles*, 97 U. S. 554, 556, 24 L. Ed. 1053, 1054); it may be the successor, in a sense, of all that went before, a step only in the march of improvement, and limited, therefore, to its precise form and elements, as the patent in suit is conceded to be. In its narrow and humble form it may not excite our wonder as may the broader or pretentious form, but it has as firm a right to protection. Nor does it detract from its merit that it is the result of experiment and not the instant and perfect product of inventive power. A patentee may be baldly empirical, seeing nothing beyond his experiments and the result; yet if he has added a new and valuable article to the world's utilities, he is entitled to the rank and protection of an inventor. * * * He must, in-

deed, make such disclosure and description of his invention that it may be put into practice. In this he must be clear. He must not put forth a puzzle for invention or experiment to solve, but the description is sufficient if those skilled in the art can understand it. This satisfies the law, which only requires as a condition of its protection that the world be given something new and that the world be taught how to use it. It is no concern of the world whether the principle upon which the new construction acts be obvious or obscure, so that it inheres in the new construction."

It is respectfully submitted that the decree should be affirmed.

Respectfully submitted,

CHAS. E. TOWNSEND,

Solicitor for Appellee.

United States
Circuit Court of Appeals
For the Ninth Circuit.

Transcript of Record.
(IN THREE VOLUMES)

MORSE S. DUFFIELD and LEWIS A. JEFFS,
Appellants,
vs.

SAN FRANCISCO CHEMICAL COMPANY,
a Corporation,
Appellee.

VOLUME I.
(Pages 1 to 304, Inclusive.)

Upon Appeal from the United States District Court for
the District of Idaho, Southern Division.

FILED

DEC 30 1912

No. 2203

United States
Circuit Court of Appeals

For the Ninth Circuit.

Transcript of Record.
(IN THREE VOLUMES)

MORSE S. DUFFIELD and LEWIS A. JEFFS,
Appellants,
vs.

SAN FRANCISCO CHEMICAL COMPANY,
a Corporation,
Appellee.

VOLUME I.
(Pages 1 to 304, Inclusive.)

Upon Appeal from the United States District Court for
the District of Idaho, Southern Division.

INDEX OF PRINTED TRANSCRIPT OF RECORD.

[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in *italic*; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in *italic* the two words between which the omission seems to occur. Title heads inserted by the Clerk are enclosed within brackets.]

	Page
Amended Bill of Complaint.....	9
Answer and Cross-Complaint.....	23
Answer to Cross-bill of San Francisco Chemical Company	38
Appellee's Designation Under Rule 23 and Ad- mission of Service of Appellants' Statement and Designation Under Rule 23.....	7
Assignment of Errors.. ..	859
Attorneys of Record, Names and Addresses of..	1
Bill of Complaint, Amended.....	9
Bond on Appeal.....	864
Certificate of Clerk U. S. District Court to Rec- ord.....	871
Citation.....	869
Cross-complaint.....	29
Decree.....	849
Examiner's Certificate to Testimony	848

EXHIBITS:

Exhibit: Letter Dated November 19, 1908, Charles C. Dey to Goodfellow & Eells..	170
--	-----

Index.

Page

EXHIBITS—Continued:

Exhibit: Letter Dated November 23, 1908, Goodfellow & Eells to Charles C. Dey.	172
Exhibit: Letter Dated November 24, 1908, Charles C. Dey to Goodfellow & Eells..	173
Exhibit: Letter Dated November 28, 1908, Dey & Hoppaugh to Goodfellow & Eells	174
Exhibit: Letter Dated April 13, 1910, Jos. J. Taylor to M. S. Duffield.....	168
Exhibit: Telegram Dated November 24, 1908, Charles C. Dey to Goodfellow & Eells.....	172
Plaintiffs' Exhibit No. 1 (Map).....	873
Plaintiffs' Exhibit No. 4 (Letter Dated Salt Lake City, Utah, April 15, 1910, from Dey & Hoppaugh to Goodfellow & Eells).....	838
Plaintiffs' Exhibit No. 5 (Letter Dated Salt Lake City, Utah, April 21, 1910, from C. B. Jack to Joseph J. Taylor).....	840
Defendant's Exhibit No. 2 (Map).....	874
Defendant's Exhibit No. 6 (Register's Final Certificate of Entry, Dated May 23, 1911, Authorizing Issuance of Patent to Utah Fertilizer and Chem- ical Manufacturing Company).....	841
Defendant's Exhibit No. 7 (Register's Final Certificate of Entry, Dated May 5, 1911, Authorizing Issuance of Patent to Utah Fertilizer & Chemical Manu- facturing Company).....	843

EXHIBITS—Continued:

Defendant's Exhibit No. 8 (Register's Final Certificate of Entry, Dated De- cember 15, 1910, Authorizing Issuance of Patent to San Francisco Chemical Company).....	844
Defendant's Exhibit No. 9 (Register's Final Certificate of Entry, Dated De- cember 15, 1910, Authorizing Issuance of Patent to San Francisco Chemical Company).....	846
Names and Addresses of Attorneys of Record..	1
Order Allowing Petition on Appeal.....	863
Order to Forward Original Exhibits.....	868
Petition for Appeal.....	858
Replication to Answer.....	49
Replication to Answer to Cross-bill.....	50
Return to Record.....	870
Statement of the Errors on Which Appellants Intend to Rely and Specification of the Parts of the Record Which Appellants Think Necessary for Consideration Thereof	1
Stipulation Concerning Final Hearing and Sub- mission.....	51
Stipulation Concerning Performance of Discov- ery Work, etc., on Certain Claims.....	453
Stipulation in Re Transcript and Exhibits....	867
TESTIMONY ON BEHALF OF COMPLAIN- ANTS:	
DUFFIELD, MORSE S.....	98
Cross-examination.....	129

Index.	Page
TESTIMONY ON BEHALF OF COMPLAIN-	
ANTS—Continued:	
DUFFIELD, MORSE S. (Redirect Exam-	
ination).....	193
Cross-examination.....	196
Recalled.....	203
Cross-examination.....	204
Redirect Examination.....	205
HOFF, CHARLES.....	205
Cross-examination.....	219
Redirect Examination.....	234
Cross-examination.....	236
Redirect Examination.....	240
Cross-examination.....	241
Redirect Examination.....	242
Cross-examination.....	244
Redirect Examination.....	245
PITTS, HARRY J.....	53
Cross-examination.....	80
STERLING, GUY.....	247
Cross-examination.....	285
Redirect Examination.....	389
Cross-examination.....	391
Redirect Examination.....	404
Cross-examination.....	404
Redirect Examination.....	408
WILSON, WILLIAM A.....	410
Cross-examination.....	432
Redirect Examination.....	448
Cross-examination.....	450

Index.

Page

TESTIMONY ON BEHALF OF DEFEND-
ANT:

BELL, ROBERT N.....	754
Cross-examination.....	781
Redirect Examination.....	831
BREGER, C. L.....	662
Cross-examination.....	689
Redirect Examination.....	721
Cross-examination.....	724
GLENN, THOMAS L.....	551
Cross-examination.....	553
GROO, RANDOLPH H.....	455
Cross-examination.....	466
Redirect Examination.....	481
Recross-examination.....	486
SULLIVAN, RICHARD A.....	487
Cross-examination.....	494
Recalled.....	504
Cross-examination.....	506
WEEKS, FRED B.....	507
Recalled.....	555
Cross-examination.....	583
Recalled—Further Cross-examination.....	729
Cross-examination.....	729
Recalled.....	739
Cross-examination.....	747
Redirect Examination.....	752
Recross-examination.....	752

[Names and Addresses of Attorneys of Record.]

A. B. GOUGH, C. B. JACK, A. L. HOPPAUGH
and CHARLES C. DEY, Esqrs., Salt Lake City,
Utah,

Attorneys for Appellants.

Messrs. CLARK & BUDGE, Pocatello, Idaho,
Attorneys for Appellee.

*United States Circuit Court of Appeals, Ninth
Circuit.*

No. —.

MORSE S. DUFFIELD and LEWIS A. JEFFS,
Complainants and Appellants,
vs.

SAN FRANCISCO CHEMICAL COMPANY,
Defendant and Appellee.

APPEAL FROM THE DISTRICT COURT OF
THE UNITED STATES FOR THE DIS-
TRICT OF IDAHO, SOUTHERN DIVISION.

**Statement of the Errors on Which Appellants
Intend to Rely and Specification of the Parts of
the Record Which Appellants Think Necessary
for Consideration Thereof.**

I.

**STATEMENT OF ERRORS ON WHICH
APPELLANTS INTEND TO RELY.**

1. Because the evidence showed that within the exterior boundaries of defendant's alleged placer mining claims, to wit, "Wilmington," "Col-

cock," "Inman," "Winfield," "Winter," "Wonder," "Winslow," and "Wizard," and each of them respectively, the only valuable mineral deposit therein contained is a solid body of mineral found in place in the mass of the mountain within clearly defined walls of a characteristic weight, color and texture, and has a definite dip and strike, and therefore the Court erred in decreeing the defendant to be the owner and entitled to the possession and occupancy of said alleged placer mining claims and each of them, and in not dismissing the cross-bill of complaint of the defendant and adjudging that said alleged placer mining claims and each of them were and are invalid.

2. Because the evidence showed that neither the defendant nor its predecessor in interest had initiated or maintained its said placer locations, to wit, "Wilmington," "Colcock," "Inman," "Winfield," "Winter," "Wonder," "Winslow," and "Wizard," or either or any of them, in compliance with the laws of the United States or the local regulations of the State of Idaho, in that the evidence showed that the ground covered by defendant's said placer locations and each of them, and the ground included within the complainants' lode locations, to wit, "Obey," "Obed," "Jimtown," "Fentress," "Cumberland," "Overton," "Mt. Pleasant," "Arkansas," "Hickman," "Columbia," and "Wayne," and each of them, including the conflict area between said lode and said placer locations was not subject to location, acquisition and purchase by means of placer locations, but only by lode locations; that the valuable mineral deposit contained within defendant's said

alleged placer mining locations and upon which such locations and each of them are solely based, is the one and only valuable mineral deposit therein contained and is the identical mineral deposit sought to be secured by the complainants by virtue of their said lode locations; that said valuable deposit is a solid body of mineral found in place within the mass of the mountain between clearly defined walls of a characteristic weight, color and texture, with definite dip and strike and continuity on dip and strike, and not otherwise; and, therefore, the Court erred in decreeing and holding that the defendant is the owner and entitled to the possession and occupancy of the area described in the decree in conflict between said defendant's placer locations and complainants' said lode locations by virtue of the compliance with the laws of the United States or of the State of Idaho, or otherwise, and in adjudging and decreeing the adverse claim of complainants based upon their said lode locations to the extent of the conflict area between said lode and said placer locations to be invalid or groundless, and in quieting the defendant's alleged title to said conflict area.

3. Because the evidence showed that the complainants had lawfully initiated and maintained their several lode locations, to wit, "Obey," "Obed," "Jimtown," "Fentress," "Cumberland," "Overton," "Mt. Pleasant," "Arkansas," "Hickman," "Columbia," and "Wayne," and each of them respectively, by full compliance with the laws of the United States and the local regulations of the State of Idaho; that the respective parties to this action are

each claiming respectively identically the same mineral deposit, the complainants by virtue of lode locations and the defendants by virtue of placer locations; that in the ground covered by such locations respectively, including the area in conflict, the valuable deposit consists of a solid mass of mineral found in place within clearly defined walls of a characteristic weight, color and texture, in the mass of the mountain with definite dip and strike and continuity on dip and strike, and contains no other valuable mineral deposit; and, therefore, the Court erred in not adjudging and decreeing that all of complainants' lode locations and each of them respectively were valid and that complainants were the owners and entitled to the possession of the conflict area with defendant's said placer locations, as prayed for in their amended bill of complaint herein and described therein and in said decree.

II.

SPECIFICATION OF THE PARTS OF THE RECORD WHICH APPELLANTS THINK NECESSARY FOR CONSIDERATION, AND TO BE PRINTED:

- (1) Amended Bill of Complaint, Record pages 1 to 12, both inclusive.
Answer and Cross-Complaint, Record pages 13 to 26, both inclusive.
Answer to Cross-Bill of Complaint, Record pages 27 to 36, both inclusive.
Replications, Record pages 37 to 39, both inclusive.

Stipulation and Order thereon, Record pages 40 and 41, both inclusive.

- (2) Print all the testimony of Harry J. Pitts, Record pages 46 to 85, both inclusive.

Print all the testimony of Morse S. Duffield, Record pages 86 down to and including the words "separately marked," on the 16th line of Record page 101.

Omit all of Record page 101 after the words "separately marked" on line sixteen thereof, down to and including the word "deputy" on the 9th line of Record page 127 (containing certified copies of Location Notices).

Print all the testimony of Morse S. Duffield commencing with the tenth line on Record page 127 down to and including the first five lines of Record page 139.

Omit all of Record page 139, except the first five lines thereof, down to and including the words "proof read" on the third line from the top of Record page 165 (containing certified copies of Proofs of Annual Labor).

Print all the testimony of Morse S. Duffield commencing with the words "Cross-Examination" on the fifth line from the top on Record page 165 down to and including Record page 233.

Print all of the testimony of Charles Hoff, Record pages 234 to 270, both inclusive.

Omit testimony of Charles P. Brooks, Record pages 271 to 289, both inclusive.

Omit testimony of Charles Hoff, Record pages

290 to 292, both inclusive.

Omit Stipulation, Record page 293, covering the first twenty lines of said page.

Print all of the testimony of Guy Sterline, commencing with the sixth line from the bottom of Record page 293 to Record page 445 inclusive.

Print all of the testimony of William A. Wilson, Record page 446 down to and including Record page 486, both inclusive.

Omit all of Record pages 487 and 488 (containing exhibits of assays); also all of Record pages 489 and 490 (being certificate of notary).

- (3) Print Stipulation commencing with the ninth line of Record page 492 down to and including Record page 494.

Print all the testimony of Randolph H. Groo and other witnesses, together with all exhibits read into the record, commencing with Record page 495 down to and ending with Record page 897.

*Omit Record pages 898 to 906, both inclusive (same being certified copies of Register's final receipts and certificate of special examiner).

Omit Record pages 907 to 915, both inclusive (being opinion on final hearing).

Print Record pages 916 to 922, both inclusive (decree); also Record pages 923 to 938, both inclusive (consisting of Petition for Appeal,

*Printed at request of counsel for appellee.

Assignment of Errors, Order Allowing Appeal, Bond on Appeal, Stipulation in re Transcript and Exhibits, Order re Exhibits and Maps, Citation, Return to Record and Clerk's certificate.

- (4) We would like reduced photographic copies of Plaintiff's Exhibit No. 1 and of Defendant's Exhibit No. 2 of appropriate size made and inserted at the back of printed transcript.
- (5) Omit from printed record all other exhibits.

Dated, November 25th, 1912.

A. B. GOUGH,
C. B. JACK and
CHARLES C. DEY,
Solicitors for Appellants.

[Endorsed]: No. 2203. United States Circuit Court of Appeals for the Ninth Circuit. Appellants' Statement of Errors and Designation under Rule 23. Filed Nov. 29, 1912. F. D. Monckton, Clerk.

Appellee's Designation Under Rule 23 and Admission of Service of Appellants' Statement and Designation Under Rule 23.

Pocatello, Ida., Nov. 27, 1912.

Hon. C. C. Dey,
Kearns Building,
Salt Lake City, Utah.

Dear Judge:

I enclose you herewith, duly signed, acknowledgment of service of statement of errors and specification of parts of the record which appellants think necessary for consideration of such errors. I find

in going over my copy of the transcript of the evidence that the paging does not conform to that mentioned by you in your specification, but from your letter I think that all parts of the record necessary to be printed have been designated save and except that I would be obliged if you would include the register's final certificates of entry. There are not many pages of them and I should like to have them go into the record, and I wish you would instruct the clerk to print them.

Yours truly,

JESSE R. S. BUDGE.

United States Circuit Court of Appeals, Ninth Circuit.

No. —.

MORSE S. DUFFIELD and LEWIS A. JEFFS,
Complainants and Appellants,
vs.

SAN FRANCISCO CHEMICAL COMPANY,
Defendant and Appellee.

APPEAL FROM THE DISTRICT COURT OF
THE UNITED STATES FOR THE DISTRICT
OF IDAHO, SOUTHERN DIVISION.

Service of Statement of Errors upon which appellants intend to rely and specification of the parts of the record which appellants think necessary for consideration thereof, admitted this 27th day of November, A. D. 1912.

CLARK & BUDGE,
Counsel for Appellee.

[Endorsed]: No. 2203. United States Circuit Court of Appeals for the Ninth Circuit. Appellee's Designation Under Rule 23 and Admission of Service of Appellants' Statement and Designation Under Rule 23. Filed Dec. 2, 1912. F. D. Monckton, Clerk.

*In the Circuit Court of the United States in and for
the District of Idaho, Southern Division.*

IN EQUITY—ACTION TO QUIET TITLE.

MORSE S. DUFFIELD and LEWIS A. JEFFS,
Complainants,

vs.

SAN FRANCISCO CHEMICAL COMPANY,
Defendant.

Amended Bill of Complaint.

To the Honorable the Judges of the Circuit Court of
the United States in and for the District of
Idaho:

MORSE S. DUFFIELD and LEWIS A. JEFFS,
respectively, citizens of the State of Utah, bring this
their Amended Bill of Complaint against the San
Francisco Chemical Company, a corporation, organized
and existing under the laws of the State of California,
and a citizen of California, and thereupon
your orators complain and allege:

I.

That your orators, and each of them, are citizens
of the State of Utah, and at all the times hereinafter
mentioned have been citizens of the United States.

II.

That said defendant is a corporation created and existing [1*] under and by virtue of the laws of the State of California and is a citizen of the State of California.

III.

That the value or amount of the matter in controversy herein exceeds the sum of Two Thousand Dollars (\$2,000.00), exclusive of interest and costs.

IV.

That your orators since on or about the 15th day of November, 1907, have been and now are the owners in the possession and entitled to the possession of the following lode mining claims, and each of them, situate in an unorganized mining district, County of Bear Lake, and State of Idaho, to wit: "Cumberland," "Fentress," "Jimtown," "Obed," "Obey," "Mt. Pleasant," "Arkansas," and "Overton," known as the "Cumberland Group" and officially surveyed for patent as U. S. Survey No. 2538, and more particularly described upon the plat hereto annexed and made a part of this Bill of Complaint; also the "Hickman," "Columbia" and "Wayne" lodes, the same being more particularly described upon the plat hereto annexed and marked Exhibit "B" and made a part hereof.

V.

Your orators further allege that they have and claim a legal right to occupy and possess said lode mining claims and each of them, and are entitled to the possession thereof by virtue of full compliance

*Page-number appearing at foot of page of original certified Record.

with the local laws and rules of miners, the laws of the United States and of said State of Idaho by pre-emption and by actual possession as lode mining claims located on the public domain of the United States.

VI.

Your orators further allege that on, to wit, the 11th day [2] of August, A. D. 1910, the said defendant made its application to the United States land office at Blackfoot, in said District of Idaho, for a patent for certain pretended placer mining claims called the "Wilmington," "Colcock," "Winfield," "Inman," "Winter," "Wonder," "Winslow" and "Wizard," and thereupon caused notice to be published, that in and by its said application so made said defendant wrongfully included all of your orators' said "Cumberland," "Fentress," "Jimtown," "Obed," "Obey," "Overton," and a portion of your orators' said "Mt. Pleasant," "Arkansas," "Hickman," "Columbia," and "Wayne" lode mining claims; as shown by plats filed on the 8th day of October, A. D. 1910, in the land office of the United States at Blackfoot, in said State of Idaho, with the adverse claim of your orators, duly verified, against the entry of said pretended "Wilmington," "Colcock," "Winfield," "Inman," "Winter," "Wonder," "Winslow" and "Wizard" placer mining claims. That attached to the original Bill of Complaint herein are copies of said plats so filed as aforesaid, and correctly show the nature, boundaries and extent of your orators' aforesaid lode mining claims and each of them, and

of the aforesaid adverse claims, to which reference is hereby made.

VII.

Your orators further show that its said adverse claim was filed in said land office within the period of sixty (60) days of the publication of notice for application for patent for said pretended "Wilmington," "Colcock," "Winfield," "Inman," "Winter," "Wonder," "Winslow" and "Wizard" placer mining claims, and this suit is brought before the expiration of the period of thirty (30) days after the filing of said adverse claim.

VIII.

That said pretended "Wilmington," "Colcock," "Winfield," "Inman," "Winter," "Wonder," "Winslow," and "Wizard" placer mining [3] claims, conflict with said "Cumberland," "Fentress," "Jimtown," "Obed," "Obey," "Overton," "Mt. Pleasant," "Arkansas," "Hickman," "Columbia" and "Wayne" lode mining claims to the extent of 148,416 acres. The conflict in the lines of said pretended placer claims, and each of them, is fully shown and described by the said plats annexed to the original bill of complaint, herein, and marked exhibits "A" and "B." That the exterior boundaries of the ground in conflict as aforesaid being described as follows, to wit:

(a) Beginning at corner No. 1 of the Cumberland lode claim, according to said official survey No. 2538, which is identical with corner No. 1 of the Overton lode claim, and from said common and identical corner the $\frac{1}{4}$ section corner of the south boundary of

section 31, township 12 south, range 45 east, Boise base and meridian, bears south 35 degrees 28 minutes east 182.3 feet; thence running from said common and identical corner aforesaid south 42 degrees 07 minutes west 1374 feet to the intersection with line 4-1 of the Mt. Pleasant lode claim; thence north 49 degrees 43 minutes east 1346.6 feet to corner No. 1 of the Mt. Pleasant lode claim, which is identical with the aforesaid $\frac{1}{4}$ section corner; thence south 30 degrees 51 minutes east 600 feet to corner No. 2 of the Mt. Pleasant lode claim; thence south 49 degrees 44 minutes west 12.7 feet to intersection with line 1-2 of the Arkansas lode claim; thence south 57 degrees 49 minutes east 823.9 feet to intersection with the easterly side line of the so-called Wizard placer claim; thence south along said easterly side line of said so-called Wizard placer claim 545.3 feet to intersection with line 3-4 of the Arkansas lode claim; thence south 31 degrees 22 minutes west 530.8 feet to corner No. 4 of the Arkansas lode claim; thence north 57 degrees 49 minutes west 453.8 feet to intersection with the westerly side line of the so-called Wizard placer claim; thence north along said westerly side line of [4] said so-called Wizard placer claim 162.2 feet to intersection with line 5-6 of the Arkansas lode claim, thence north 55 degrees 01 minute east 257.6 feet to corner No. 6 of the Arkansas lode claim; thence north 16 degrees 15 minutes west 915.5 feet to intersection with line 2-3 of the Mt. Pleasant lode claim; thence south 49 degrees 44 minutes west 1263.4 feet to intersection with subdivision line between lot 3 and the southeast $\frac{1}{4}$ of the north-

west $1/4$ of section 6, township 13 south, range 45 east, Boise base and meridian; thence along said subdivisional line south 89 degrees 51 minutes west 215.2 feet to intersection with line 3-4 of the Mt. Pleasant lode claim; thence north 30 degrees 51 minutes west 459.2 feet to corner No. 4 of the Mt. Pleasant lode claim; thence north 49 degrees 43 minutes east 6.7 feet to intersection with line 2-3 of the Overton lode claim; thence north 45 degrees 22 minutes west 507.8 feet to corner No. 3 of the Overton lode claim; thence north 39 degrees 13 minutes east 1499.9 feet to corner No. 4 of the Overton lode claim which is identical with corner No. 2 of the Cumberland lode claim; thence north 41 degrees 08 minutes east 1461.5 feet to corner No. 3 of the Cumberland lode claim which is identical with corner No. 2 of the Fentress lode claim; thence north 12 degrees 42 minutes east 694 feet to intersection with line 1-2 of the Jimtown lode claim; thence south 77 degrees 43 minutes west 158.8 feet to corner No. 2 of the Jimtown lode claim; thence north 14 degrees 17 minutes west 1421 feet to corner No. 3 of the Jimtown lode claim which is identical with corner No. 2 of the Obed lode claim; thence north 22 degrees 56 minutes west 1492.2 feet to corner No. 3 of the Obed lode claim which is identical with corner No. 2 of the Obey lode claim; thence north 17 degrees 09 minutes west 1491.8 feet to corner No. 3 of the Obey lode claim; thence north 77 degrees 43 minutes east 600 feet to corner No. 4 of the Obey lode claim, thence south 14 degrees 29 minutes east 1487.4 feet to corner No. 1 of the Obey lode claim, [5] which is

identical with corner No. 4 of the Obed lode claim and from said common and identical corner the aforesaid $1/4$ section corner bears south 0 degrees 08 minutes west 5178.2 feet; thence running from said common and identical corner aforesaid south 24 degrees 28 minutes east 1500.4 feet to corner No. 1 of the Obed lode claim which is identical with corner No. 4 of the Jimtown lode claim and from said common and identical corner the aforesaid $1/4$ section corner bears south 9 degrees 26 minutes west 3864.9 feet; thence running from said common and identical corner south 14 degrees 53 minutes east 775 feet to intersection with line 3-4 of the Fentress lode claim; thence south 45 degrees 22 minutes east 523.7 feet to corner No. 4 of the Fentress lode claim; thence south 15 degrees 07 minutes west 1465.5 feet to corner No. 1 of the Fentress lode claim which is identical with corner No. 4 of the Cumberland lode claim and from said common and identical corner the aforesaid $1/4$ section corner bears south 32 degrees 44 minutes west 1522.8 feet; thence running from said common and identical corner aforesaid south 39 degrees 23 minutes west 1465 feet to the place of beginning. From corner No. 1 of the Jimtown lode claim the aforesaid $1/4$ section corner bears south 22 degrees 17 minutes west 2635.5 feet, and from corner No. 1 of the Arkansas lode claim said $1/4$ section corner bears north 29 degrees west 589.3 feet. Said conflict area containing 142.044 acres.

(b) Beginning at corner No. 3 of the Hickman lode claim from which post No. 2 of said Hickman

lode claim bears north 6 degrees 37 minutes west 258 feet and from said post No. 2 of the Hickman lode claim post No. 1 of said Hickman lode claim bears south 83 degrees 15 minutes west 50 feet; whence the 1/4 section corner on the south [6] boundary of section 31, township 12 south, range 45 east, Boise base and meridian, bears north 7 degrees 14 minutes west 2032 feet; thence running from said corner No. 3 aforesaid north 83 degrees 23 minutes east 239.9 feet to corner No. 4 of the Hickman lode claim; thence south 0 degrees 31 minutes east 991.6 feet to corner No. 5 of the Hickman lode claim; thence south 83 degrees 23 minutes west 248.9 feet to corner No. 6 of the Hickman lode claim; thence north along the westerly side line of the so-called Wizard placer claim 992.6 feet to corner No. 3 of the Hickman lode claim and being the place of beginning. Said conflict area containing 5.532 acres.

(c) Beginning at corner No. 4 of the Columbia lode claim and running thence south 44 degrees 29 minutes west 29.4 feet to intersection with line 1-2 of the Wayne lode claim, said point of intersection being south 62 degrees 08 minutes east 25 feet from corner No. 1 of the Wayne lode claim from which the 1/4 section corner on the south boundary of section 31, township 12 south, range 45 east, Boise base and meridian, bears north 3 degrees 17 minutes west 5503.9 feet; thence north 62 degrees 08 minutes west 1.8 feet to intersection with westerly side line of the so-called Wizard placer claim; thence north along the westerly side line of the so-called Wizard placer claim 25.1 feet to point of intersection with line 3-4

of the Columbia lode claim; thence south 77 degrees 22 minutes east along said line 3-4 of the Columbia lode claim 22.7 feet to the place of beginning. Said conflict area containing 0.007 acres.

(d) Beginning at corner No. 2 of said Wayne lode claim, which is south 62 degrees 08 minutes east 50 feet from corner No. 1 of said Wayne lode claim, and from said corner No. 1 the $\frac{1}{4}$ section corner [7] on the south boundary of section 31, township 12 south, range 45 east, Boise base and meridian, bears north 3 degrees, 17 minutes west 5503.9 feet; thence running from corner No. 2 aforesaid south 27 degrees 52 minutes west 50.8 feet to intersection with westerly side line of the so-called Wizard placer claim; thence north along the westerly side line of the so-called Wizard placer claim 57.4 feet to intersection with line 1-2 of the Wayne lode claim; thence south 62 degrees 08 minutes east 26.8 feet to corner No. 2 of the Wayne lode claim and being the place of beginning. Said conflict area containing 0.016 acres.

(e) Beginning at the point of intersection of line 7-8 of said Wayne lode claim with the westerly side line of the so-called Wizard placer claim, said point of intersection being south 52 degrees 54 minutes east 274.5 feet from corner No. 8 of the Wayne lode claim, which said corner No. 8 is south 27 degrees 52 minutes west 425 feet from corner No. 1 of said Wayne lode claim, whence the $\frac{1}{4}$ section corner on the south boundary of section 31, township 12 south, range 45 east, Boise base and meridian bears north 3 degrees 17 minutes west 5,503.9 feet; thence running from said point of intersection aforesaid north along the west-

erly side line of the so-called Wizard placer claim 62.6 feet to intersection of line 3-4 of the Wayne lode claim with the westerly side line of the said so-called Wizard placer claim; thence south 52 degrees 54 minutes east 236.2 feet to corner No. 4 of the Wayne lode claim; thence south 12 degrees 57 minutes east 519.1 feet to intersection of line 4-5 of the Wayne lode claim with the south line of said so-called Wizard placer claim; thence south 89 degrees 51 minutes west along said south line of said so-called Wizard placer claim 51.2 feet to intersection of line 6-7 of the Wayne lode claim with south line of said so-called Wizard placer [8] claim; thence north 12 degrees 57 minutes west 489.6 feet to corner No. 7 of the Wayne lode claim; thence north 52 degrees 54 minutes west 180.5 feet to the place of beginning. Said conflict area containing 0.817 acres.

IX.

That said defendant asserts and claims an interest in said premises and the ores and minerals therein contained. That the alleged claims and assertions of said defendant are false and untrue and unfounded in fact, and cast a cloud upon the title and possession of your orators to said above-described premises and to the whole and each and every part thereof.

X.

Your orators further allege that said defendant sometimes alleges and pretends that under the act of Congress relating to the acquisition from the United States of lands valuable for minerals, the mineral deposit found and existing within the exterior boundaries of your orators' said lode mining claims, and

each of them, is not subject to location, acquisition and patent under the provisions of the laws of the United States for acquiring veins or lodes of quartz or other rock in place bearing valuable deposits of mineral, but, on the contrary, is subject only to location and acquisition under the laws of the United States in the manner provided for acquiring placer mining claims or deposits, because the mineral deposit is of sedimentary origin and the sole element of value in the vein is phosphorus; and at other times said defendant alleges and pretends that it is and has been in possession of the conflict area hereinbefore described under and by virtue of its said pretended placer locations, and that your orators by virtue of said lode mining claims and the compliance by them with [9] the laws of the United States and the laws, rules and regulations of the State of Idaho, and of miners, are not in possession or entitled to the possession of their said lode mining claims, or either of them, and particularly to the extent the said lode mining claims, or each of them, conflict with the defendant's pretended placer locations aforesaid.

WHEREAS, your orators charge the contrary thereof to be the truth and allege that within the exterior boundaries to your orators' said lode mining claims, and each of them, there is a vein or lode of mineral-bearing rock in place, containing prosphorite and valuable only for the said mineral contents thereof. That said vein or lode in its course and strike extends nearly parallel to the side lines of your orators' said lode mining claims, and each of them, and throughout the entire length thereof, and lies

in place in the mountain between true walls and has a well-defined dip and strike; that neither within the exterior boundaries of your orators' said lode mining claims, and each of them, nor within the exterior boundaries of defendant's pretended placer mining claims, or either or them, nor within the aforesaid conflict area between your orators' said lode mining claims, and each of them, and said defendant's said pretended placer mining claims, and each of them, there is no form of mineral deposit excepting said vein or lode, containing phosphorite in place, between defined walls and with defined dip and strike, and no mineral deposit subject to location, entry and patent as placer mining claims, under the laws of the United States, as your orators are advised, informed and believe.

That your orators, without opposition from the defendants herein, or otherwise, peaceably and in good faith, entered upon said veins or lodes and made their several lode locations aforesaid, and performed all the acts required by law to acquire and maintain their said lode mining claims and each of them, as hereinbefore alleged, and [10] that to the extent of their aforesaid lode claims and each of them, including the aforesaid conflict areas, the said defendant has had, and has, no lawful right to the possession of the same, or any part thereof, but, on the contrary, your orators, by virtue of their full compliance with the laws of the United States and the local laws and regulations, have been and now are in the possession and entitled to the exclusive possession of their said lode mining claims, and each of them, including said

conflict areas hereinbefore described.

In consideration whereof, and forasmuch as your orators have no sufficient remedy at law for the wrongs done and threatened to be done, and that the remedy at law is inadequate and can afford no protection to your orators against the wrongful and unlawful claims and assertions of said defendant for the reasons hereinbefore stated, and is only relievable in a court of equity, where matters of this kind are properly cognizable and reviewable.

Your orators, to the end that they may obtain the relief to which they are justly entitled in the premises:

First. Pray that said defendant make a full disclosure and discovery of all the matters aforesaid, and according to the best and utmost of its remembrance, knowledge, information and belief full, true and perfect answer make to the matters hereinbefore stated and charged, but not under oath, an answer under oath being expressly waived.

Second. That it be required to set forth any and every adverse claim, interest or demand in and to the above-described conflict area and premises hereinbefore described, to the end that the same may be justly adjudicated and declared null and void as against your orators, and that the title, ownership and possession and right of possession of your orators in and to said "Cumberland," "Fentress," [11] "Jimtown," "Obed," "Obey," "Mt. Pleasant," "Arkansas" and "Overton," and the "Hickman," "Columbia" and "Wayne" lode mining claims, including said conflict area hereinbefore described, be established and

confirmed as against any and all claims of the said defendant, and all clouds thereon forever removed.

Third. That your orators have such other and further relief as the equity of the case may require and as to your Honors may seem meet, and for their costs of suit in this behalf most wrongfully expended.

A. B. GOUGH,

C. B. JACK,

A. L. HOPPAUGH and
CHARLES C. DEY,

Solicitors for Complainants.

United States of America,
District of Utah,
County of Salt Lake,—ss.

Morse S. Duffield, being first duly sworn, deposes and says: That he is one of the complainants herein, that he has read the above and foregoing Amended Bill of Complaint and knows the contents thereof; that the same is true of his own knowledge except as to those matters therein stated upon information and belief and as to those matters he believes it to be true.

MORSE S. DUFFIELD.

Subscribed and sworn to before me this 20th day of December, A. D. 1910.

[Not. Seal]

ARTHUR E. MORTON,

Notary Public.

[Endorsed]: Filed Dec. 22, 1910. A. L. Richardson, Clerk. [12]

In the Circuit Court of the United States for the District of Idaho, Southern Division.

IN EQUITY.

MORSE S. DUFFIELD and LEWIS A. JEFFS,
Plaintiffs,

vs.

SAN FRANCISCO CHEMICAL COMPANY, a
Corporation,
Defendant.

Answer and Cross-Complaint.

This defendant now and at all times hereafter saving to itself all and all manner of benefit of exception or otherwise, that can or may be had or taken to the many errors, uncertainties and imperfections in complainants' bill of complaint contained, for answer thereto, or so much thereof as this defendant is advised it is material or necessary for it to make answer to, answering says:

I.

Admits the allegations contained in paragraph one.

II.

Admits the allegations contained in paragraph two.

III.

Admits the allegations contained in paragraph three. [13]

IV.

Denies that complainants since on or about the 15th day of November, 1907, or at any other time since said date, have been or that they now are the owners, or in the possession or entitled to the posses-

sion of the alleged lode mining claims, or any or either of them, situate in an unorganized mining district, County of Bear Lake, State of Idaho, to wit: "Cumberland," "Fentress," "Jimtown," "Obed," "Obey," "Mount Pleasant," "Arkansas," and "Overton," known as the "Cumberland Group," and particularly described upon the plat annexed to complainants' bill of complaint; or that complainants at any time since said date have been or now are the owners, or in the possession, or entitled to the possession of the "Hickman," "Columbia" and "Wayne" alleged lodes, or any or either of them, the same being situate in the said unorganized mining district, and being more particularly described upon the plat annexed to said bill of complaint and marked exhibit "B." But this defendant alleges the facts to be in that regard that at all times since said date, and particularly at the time of the commencement of this action, it, the said defendant, was and now is in the exclusive possession of the entire area alleged to be in conflict as stated in complainants' said bill of complaint, and as shown by the said plats attached thereto.

V.

Denies that complainants have a legal right to occupy or possess said alleged lode mining claims, or any or either of them, or that they are entitled to the possession thereof by virtue of full compliance with the local laws and rules of miners, or the laws of the United States, or of the State of Idaho, by pre-emption or by actual possession as lode mining claims located on the public domain of the United States, or

otherwise, or at all.

VI.

Answering paragraph six defendant admits that on, to wit, the 11th day of August, 1910, it made its application to the United States Land Office at Blackfoot, in said District of Idaho, for a patent for certain placer mining claims called the "Wilmington," [14] "Colcock," "Winfield," "Inman," "Winter," "Wonder," "Winslow" and "Wizard," and thereupon caused notice to be published. Denies that in or by its said application so made defendant wrongfully included all or any part or parcel of complainants' said alleged lode mining claims "Cumberland," "Fentress," "Jimtown," "Obed," "Obey" and "Overton," or any portion of complainants' said "Mount Pleasant," "Arkansas," "Hickman," "Columbia" and "Wayne" alleged lode mining claims, or any portion of any or either of them, as shown by the plats filed on the 8th day of October, 1910, in the Land Office of the United States at Blackfoot in said State of Idaho, with the adverse claims of complainants against the entry of said "Wilmington," "Colcock," "Winfield," "Inman," "Winter," "Wonder," "Winslow" and "Wizard" placer mining claims.

Further answering said paragraph six, defendant says that it has no knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in the last sentence of said paragraph, and basing its denial upon that ground, denies that attached to the original bill of complaint herein are copies of said plats so filed in the Land Office as

aforesaid, or that said plats, or alleged copies attached to said bill of complaint, correctly show the nature or boundaries or extent of complainants' aforesaid alleged lode mining claims, or any or either of them, or of complainants' adverse claims.

VII.

Admits the allegations contained in paragraph seven.

VIII.

This defendant does not know and has not sufficient information on which to base a belief as to the matters alleged in paragraph eight, and basing its denial [15] upon that ground, defendant denies that its said "Wilmington," "Colcock," "Winfield," "Inman," "Winter," "Wonder," "Winslow" and "Wizard" placer mining claims conflict with said "Cumberland," "Fentress," "Jimtown," "Obed," "Obey," "Overton," "Mount Pleasant," "Arkansas," "Hickman," "Columbia," and "Wayne" alleged lode mining claims to the extent of 148.516 acres or to any other extent or at all. Upon the same ground denies that the alleged conflict in the lines of said placer claims, and each of them, with said alleged lode mining claims is fully or otherwise shown or described by said plat annexed to the original bill of complaint herein, marked exhibits "A" and "B." Upon the same ground denies that the exterior boundaries of the ground alleged in said bill of complaint to be in conflict are as set forth in subdivisions "A," "B," "C," "D" and "E" of said paragraph eight.

IX.

Admits that defendant asserts and claims an in-

terest in said premises, and to the ores and minerals therein contained, but denies that the claims and assertions of said defendant are false or untrue, or unfounded in fact, or that they cast a cloud upon the title or possession of complainants to said premises described in said bill, or to the whole or to each or any part thereof.

X.

Answering paragraph ten, defendant admits that it alleges and claims that under the Act of Congress relating to the acquisition from the United States of lands valuable for minerals, the mineral deposits found and existing within the exterior boundaries of complainants' said alleged lode mining claims, and each of them, is not subject to location, acquisition or patent [16] under the provisions of the laws of the United States for acquiring veins or lodes of quartz or other rock in place bearing valuable deposits of mineral, but, on the contrary, is subject only to location and acquisition under the laws of the United States in the manner provided for acquiring placer mining claims, or deposits, because the mineral deposit is of a sedimentary origin, and the principal (not the sole) element of value therein is phosphorous; but alleges that it also makes said claims because said deposit is not in the form of a vein or lode.

Further answering said paragraph ten, defendant admits that it alleges and claims that it is and has been in possession of the alleged conflict areas described in said bill of complaint under and by virtue of its said placer locations, and that complainants are

not by virtue of their alleged compliance with the laws of the United States, or the laws, rules or regulations of the State of Idaho, or of miners or otherwise, in possession or entitled to the possession of their said alleged lode mining claims, or any or either of them, or to any part or parcel of any or either of them wherein they conflict with defendant's said placer locations.

Further answering said paragraph ten, defendant denies that within the exterior boundaries of complainants alleged lode mining claims, or any or either of them, there is a vein or lode of mineral-bearing rock in place containing phosphorite, and valuable only for said mineral contents thereof; denies that said alleged or any vein or lode in its course or strike extends nearly parallel to the alleged side lines of complainants' said alleged lode mining claims, or any or either of them, or throughout the entire length thereof, or lies in place in the mountain between true walls, or has a well-defined dip or strike. Denies that neither within the exterior [17] boundaries of complainants' said alleged lode mining claims or either of them, nor within the exterior boundaries of defendant's said placer mining claims, or either of them, nor within the alleged conflict areas between said alleged lode mining claims, and each of them, and defendant's said placer mining claims and each of them, there is no form of mineral deposit excepting said vein or lode containing phosphorite in place between defined walls, and with defined dip and strike, and no mineral deposit subject to location, entry and patent as placer mining claims under the

laws of the United States.

Further answering paragraph ten, defendant denies that complainants without opposition from defendant, peaceably or in good faith entered upon said alleged veins or lodes, or in such manner or otherwise made their several alleged lode locations aforesaid, or performed all or any of the acts required by law to acquire or maintain their said alleged lode mining claims, or any or either of them as in said bill of complaint alleged, or that to the extent of their said alleged lode claims, or any or either of them, including the said alleged conflict areas, the said defendant has had or has no lawful right to the possession of the same, or any part thereof, but defendant alleges in this regard that its claims to the premises within the boundaries of said placer mining claims, including said alleged conflict areas, are as hereinafter set forth in its cross-complaint; defendant denies that by virtue of their full compliance with the laws of the United States, or the local laws and regulations, or otherwise, complainants have been or now are in the possession or entitled to the exclusive possession, or to the possession at all of their said alleged lode mining claims, or any or either of them, including said alleged conflict areas described in said bill of complaint. [18]

Cross-Complaint.

For cross-complaint and affirmative relief your orator, the San Francisco Chemical Company, a corporation organized and existing under the laws of the State of California, and a citizen of said State of California, respectfully shows to the Honorable

Judges of the Circuit Court of the United States in and for the District of Idaho:

I.

That your orator is a corporation organized and existing under the laws of the State of California, and a citizen of said State of California.

II.

That said complainants, Morse S. Duffield and Lewis A. Jeffs, and each of them, are citizens of the State of Utah, and as your orator is informed and believes, and therefore alleges, are residents of Salt Lake City in said State.

Your orator further alleges that counsel of record and the solicitors for said complainants are, A. B. Gough, Esq., Montpelier, Idaho, and C. B. Jack, A. L. Hoppaugh and C. C. Dey of Salt Lake City, Utah.

III.

That the value or amount of the matter in controversy herein exceeds the sum of Two Thousand Dollars, exclusive of interest and costs.

IV.

That from on or about the 8th day of July, 1904, to on or about the 28th day of August, 1906, William S. Goodfellow, Hugh Goodfellow, Arthur W. Goodfellow, R. W. Hart, John Shepard Eells, H. L. Atkinson, Richard M. [19] Lyman and Joseph J. Taylor, the predecessors in interest of your orator, were the owners in fee (except only as against the paramount title of the United States) in possession and entitled to the possession of the following named placer mining claims, and each of them, situate in the unorganized mining district of Bear Lake

County, State of Idaho, to wit:

"Winfield," described as follows, to wit: The northeast quarter of Section Thirty-one (31), Township Twelve (12) South, Range Forty-five (45) East, Boise Meridian.

"Winter," described as follows, to wit: The southeast quarter of Section Thirty-one (31), Township Twelve (12) South, Range Forty-five (45) East, Boise Meridian.

"Wonder," described as follows, to wit: The southwest quarter of Section Thirty-one (31), Township Twelve (12) South, Range Forty-five (45), East Boise Meridian.

"Winslow," described as follows, to wit: The north half of northwest quarter of Section Six (6), Township Thirteen (13) South, Range Forty-five (45) East, Boise Meridian, consisting of Lots 3 and 4 of Section Six (6), Township Thirteen (13) South, Range Forty-five (45) East, Boise Meridian.

And your orator further alleges that from on or about the 22d day of August, 1904, to on or about the 28th day of August, 1906, said above-named predecessors in interest of your orator were also the owners in fee (except only as against the paramount title of the United States), in possession and entitled to the possession of the following named placer mining claim situate in said unorganized mining district of Bear Lake County, Idaho, to wit: [20]

"Wilmington," described as follows, to wit: The southeast quarter of Section Thirty (30), Township Twelve (12) South, Range Forty-five East, Boise Meridian.

V.

That from on or about the 11th day of June, 1904, to on or about the 28th day of August, 1906, Charles C. Jones, E. C. Jones, M. C. King, L. P. King, M. J. Bringier, C. O. McLaughlin, N. K. McLaughlin and J. T. Bringier, the predecessors in interest of your orator, were the owners in fee (except only as against the paramount title of the United States), in possession and entitled to the possession of the following named placer mining claims, and each of them, situate in the unorganized mining district of Bear Lake County, State of Idaho, to wit:

“Colcock,” described as follows, to wit: The southwest quarter of Section Thirty (30), Township Twelve (12) South, Range Forty-five (45) East, Boise Meridian.

“Inman,” described as follows, to wit: The northwest quarter of Section Thirty-one (31), Township Twelve (12) South, Range Forty-five (45) East, Boise Meridian.

VI.

That from on or about the 3d day of December, 1905, to on or about the 8th day of April, 1910, William S. Goodfellow, Hugh Goodfellow, Joseph J. Taylor, R. W. Hart, John Shepard Eells and Richard A. Sullivan, the predecessors in interest of your orator, were the owners in fee (except only as against the paramount title of the United States), in possession and entitled to the possession of the following named placer mining claim, to wit:

“Wizard,” described as follows, to wit: The west half of the northwest quarter of the northeast quar-

ter, [21] consisting of the west half of Lot 2, and the west half of the southwest quarter of the northeast quarter and the west half of the west half of the southeast quarter, all of Section Six (6), Township Thirteen (13) South, Range Forty-five (45) East, Boise Meridian; and the west half of the northwest quarter of the northeast quarter of Section Seven (7), Township Thirteen (13) South, Range Forty-five (45) East, Boise Meridian.

VII.

That said predecessors in interest, respectively, of your orator, had and claimed a legal right to occupy and possess said placer mining claims, and each of them, and were entitled to the possession thereof during the respective periods aforesaid by virtue of the discovery of beds or deposits of carbonaceous limestone and lime phosphate within the boundaries of each of said claims, and by virtue of full compliance with the local laws and rules of miners, the laws of the United States, and of the State of Idaho, by pre-emption and by actual possession as placer mining claims located on the public domain of the United States.

VIII.

That since on or about the said 28th day of August, 1906, your orator has been and now is the owner in fee (except only as against the paramount title of the United States), and at all times since said date has been and now is in the exclusive possession and entitled to the possession of said "Winfield," "Winter," "Wonder," "Winslow," "Wilmington," "Colcock" and "Inman" placer mining claims herein-

before described, and each of them, and the whole and every part and parcel thereof. And that since on or about the 13th day of April, 1910, your orator has been and now is the owner in fee (except only as against the paramount title of the [22] United States), and at all times since said date has been and now is in the exclusive possession and entitled to the possession of said "Wizard" placer mining claim hereinbefore described, and the whole thereof; and your orator has and claims a legal right to occupy and possess said placer mining claims, and each of them: (a) By virtue of deeds of conveyance of date of August 28, 1906, conveying all of said placer mining claims except the said "Wizard" placer mining claim, and by virtue of deeds of conveyance executed April 8, 1910, April 11, 1910, and April 13, 1910, conveying said "Wizard" placer mining claim, all of which said deeds were executed to your orator by its said predecessors in interest, the respective locators of said claims, and conveying to your orator all the right, title and interest of said locators and predecessors in interest in and to said above described mining claims, and each of them; and said deeds were duly acknowledged so as to entitle the same to be recorded, and the same were duly recorded, and are now of record in the office of the County Recorder of Bear Lake County, State of Idaho; (b) By virtue of full compliance with the local laws and rules of miners, the laws of the United States, and of the State of Idaho, and by actual possession as placer mining claims located on the public domain of the United States.

IX.

Your orator further alleges that complainants, Morse S. Duffield and Lewis A. Jeffs, assert and claim an interest in the premises hereinbefore described, and to the ores and minerals therein contained, which said claim is false, untrue and unfounded in fact and casts a cloud upon the title and possession of your orator to the said above described premises; that said complainants base their said claim upon the wrongful assertion that the [23] deposit or bed of carbonaceous limestone and lime phosphate contained within the boundaries of your orator's said placer mining claims is not subject to location as placer, but, on the contrary, is subject to location as lode only, which assertion your orator alleges is unfounded in fact. Your orator further alleges that the deposits found within the boundaries of your orator's said placer mining claims, and each of them, consists of sedimentary formations or beds of phosphoric limestone, and said deposits are not in the form of a lode or vein, and that there is no mineral found within the limits of said placer mining claims, or any or either of them in the form of a vein or lode, or that is subject to location and acquisition under the laws of the United States by virtue of lode locations.

WHEREFORE, defendant and cross-complainant having fully answered, confessed, traversed and avoided or denied all the matters in complainants' said bill of complaint material to be answered, according to its best knowledge or belief, all of which matters and things this defendant is ready and will-

ing to aver, maintain and prove as this Honorable Court shall direct, and having cross-complained against complainants as aforesaid, humbly prays:

First: That as to said complainants' bill this defendant be hence dismissed with its reasonable costs and charges in this behalf most wrongfully sustained.

Second: That upon its said cross-complaint may it please your Honors to grant unto your orator a writ or writs of subpoena issued out of this court, and under its seal directed to said Morse S. Duffield and Lewis A. Jeffs, complainants herein, commanding them to appear herein and to show, if they can, why your orator, San Francisco Chemical Company, should not have the relief prayed, and make a full disclosure and discovery of all [24] the matters aforesaid and according to the best and utmost of their remembrance, knowledge, information and belief, full, true and perfect answer make to the matters in said cross-complaint stated and charged, but not under oath, an answer under oath being expressly waived. And inasmuch as said complainants are nonresidents of the State of Idaho, your orator prays that an order be immediately made and entered herein directing the Marshal of this District, or of the District of Utah, to serve the writ or writs of subpoena when issued herein upon said complainants Morse S. Duffield and Lewis A. Jeffs by substituted service thereof upon their said attorneys of record in this court, viz.: A. B. Gough, Esq., Montpelier, Idaho, or C. B. Jacks, A. L. Hoppaugh and C. C. Dey of Salt Lake City, Utah, or upon either of them, and that the same when made be deemed good service.

Third: That said complainants, Morse S. Duffield and Lewis A. Jeffs, be required to set forth any and every adverse claim, interest or demand in or to the above premises hereinbefore described, to the end that the same may be justly adjudicated null and void as against your orator, and that the title, ownership, possession and right of possession of your orator in and to said "Winfield," "Winter," "Wonder," "Winslow," "Wilmington," "Colcock," "Inman" and "Wizard" placer mining claims, and to each of them, and to every part and parcel thereof, be established and confirmed as against any and all claims of said complainants Duffield & Jeffs, and all clouds thereon forever removed.

Fourth: That your orator have such other and further relief as equity may require, and as to your Honors may seem meet, and its costs of suit in this behalf most wrongfully expended.

CLARK & BUDGE,

Solicitors for Defendant and Cross-complainant.

[25]

United States of America,
Northern District of California,
County of San Francisco,—ss.

Charles P. Eells, being first duly sworn, deposes and says: That he is Vice-President of the above-named defendant and cross-complainant, San Francisco Chemical Company, and that he makes this certification for and on its behalf; that he has read the foregoing answer and cross-complaint, and knows the contents thereof, and that the same is true of his own knowledge, except as to matters therein stated to be

upon information or belief, and as to these matters he believes it to be true.

CHARLES P. EELLS.

Subscribed and sworn to before me this 27th day of February, 1911.

[Seal]

M. V. COLLINS,
Notary Public.

[Endorsed]: Filed March 9, 1911. A. L. Richardson, Clerk. [26]

*In the Circuit Court of the United States in and for
the District of Idaho, Southern Division.*

No. —.

MORSE S. DUFFIELD and LEWIS A. JEFFS,
Complainants,

vs.

SAN FRANCISCO CHEMICAL COMPANY, a
Corporation,

Defendant.

**Answer to Cross-bill of San Francisco Chemical
Company.**

These defendants in the cross-bill, Morse S. Duffield and Lewis A. Jeffs, reserving to themselves all right of exception to the said cross-bill of complaint of said San Francisco Chemical Company, for answer thereto say:

1. Admit the allegations contained in paragraphs I, II and III of said cross-bill.

2. Answering paragraph IV of said cross-bill, they deny that from on or about the 8th day of July,

A. D. 1904, to on or about the 28th day of August, A. D. 1906, or at any time, or at all, William S. Goodfellow, Hugh Goodfellow, Arthur W. Goodfellow, R. W. Hart, John Shepard Eells, H. L. Atkinson, Richard M. Lyman and Joseph J. Taylor, or either, or any of them, were the owners in fee, except only as against the paramount title of the United States, or otherwise, [27] or at all, or in possession, or entitled to the possession of said alleged and so-called "Winfield," "Winter," "Wonder" and "Winslow" placer mining claims, or either, or any of them, as described in said cross-bill, or any part or portion thereof whatsoever. Also deny that from on or about the 22d day of August, A. D. 1904, to on or about the 26th day of August, A. D. 1906, or at any other time, or at all, said persons above named, or any or either of them, were the owners in fee, except only as against the paramount title of the United States, or otherwise, or at all, or in possession, or entitled to the possession of said alleged and so-called placer mining claim designated as the "Wilmington" as described in said cross-bill, or any part or portion thereof whatsoever.

Further answering said paragraph IV of said cross-bill, these defendants in the cross-bill say, that they have been informed that said San Francisco Chemical Company has succeeded to the alleged claim of the several persons mentioned in said paragraph, and that the allegation that said several persons are the predecessors in interest of said San Francisco Chemical Company may be true for anything these defendants know to the contrary, but these defend-

ants are strangers to all and every such matter and cannot form any belief concerning the same, and therefore call upon said complainant in the cross-bill to make such proof in respect thereto as it may be advised.

3. These defendants deny that on or about the 11th day of June, A. D. 1904, to on or about the 28th day of August, A. D. 1906, or at any other time, or at all, Charles C. Jones, E. C. Jones, M. C. King, L. P. King, M. J. Bringier, C. O. [28] McLaughlin, N. K. McLaughlin and J. T. Bringier, or any or either of them, were the owners in fee, except only as against the paramount title of the United States, or otherwise, or at all, or in possession, or entitled to the possession of the alleged placer mining claims designated as the "Colcock" and "Inman" as described in paragraph V of said cross-bill, or otherwise, or to any part or portion of said alleged placer claims, or either of them. That as to whether or not said last mentioned named persons were the predecessors in interest of said San Francisco Chemical Company in and to said alleged and pretended placer mining claims, or either of them, these defendants are utter strangers to all and every such matter and cannot form any belief concerning the same, and therefore leave the said complainant in the said cross-bill to make such proof in respect thereto as it may be advised.

4. Answering paragraph VI of said cross-bill, these defendants deny that from on or about the 31st day of December, A. D. 1905, to on or about the 8th day of April, A. D. 1910, William S. Goodfellow,

Hugh Goodfellow, Joseph J. Taylor, R. W. Hart, John Shepard Eells and Richard A. Sullivan, or any or either of them, were the owners in fee, except only as against the paramount title of the United States, or otherwise, or at all, or in possession, or entitled to the possession of the alleged and so-called placer mining claim described in said cross-bill as the "Wizard," or any part or portion thereof whatsoever, and as to the said last mentioned persons, or any of them, being the predecessors in interest of said San Francisco Chemical Company, these defendants in the cross-bill being utter strangers to all and every such matter have not and cannot form any belief concerning the same, and therefore [29] call upon the complainant in the cross-bill to make such proof in respect thereto as it may be advised.

5. Answering the VII paragraph of said cross-bill, these defendants deny that said or any, predecessors in interest, respectively, or otherwise, of said complainant in the cross-bill had any legal right to occupy or possess said alleged placer mining claims, or either or them, or any part or portion thereof. Also deny that said alleged predecessors of said complainant in the cross-bill, or either, or any of them, or said complainant in the cross-bill, were entitled to the possession of said alleged placer mining claims, or either of them or any part or parcel thereof, at any time, or at all, by virtue of any discovery of mineral within the boundaries of any of said alleged and pretended placer mining claims, as alleged in said cross-bill, or otherwise, or at all, or by virtue of full, or any, compliance with the local laws, or rules of

miners, or laws of the United States, or of the State of Idaho, or by pre-emption, or by actual possession as placer mining claims, or in any other manner whatsoever, or at all.

6. Answering paragraph VIII of said cross-bill, these defendants in the cross-bill deny that on or about the 28th day of August, A. D. 1906, or any other time, or at all, said complainant in the cross-bill has been, or now is, the owner in fee, except only as against the paramount title of the United States, or otherwise, or at all, or at any time, or times, since said date, or otherwise, or at all, has been, or now is in the exclusive possession, or any possession, or entitled to the possession of said pretended and so-called "Winfield," "Winter," "Wonder," "Winslow," "Wilmington," [30] "Colcock" or "Inman" placer mining claims, as described in said cross-bill, or otherwise, or at all, or to the whole or any part or portion thereof whatsoever. Also deny that on or about the 13th day of April, A. D. 1910, or at any other time, or at all, said complainant in the cross-bill has been, or now is, the owner in fee, except only as against the paramount title of the United States, or otherwise, or at all, or has been at all, or at any time, or times, since said date, or now is, in the exclusive or any possession, or entitled to the possession of said alleged "Wizard" placer mining claim, described in said cross-bill, or to any part or portion thereof whatsoever. Also denies that said complainant in said cross-bill has any legal right whatsoever to occupy or possess said alleged placer mining claims, or either of them, or any part or portion

thereof by virtue of the alleged deeds of conveyance referred to in said cross-bill of complaint, or by virtue of compliance with the alleged laws, or rules of miners, or any of them, or by actual, or any possession, as alleged in said cross-bill, of compliance, or otherwise, or at all.

7. Further answering said VII and VIII paragraphs of said cross-bill in respect to the alleged claims of said complainant in the cross-bill, these defendants say, it may be true, for anything these defendants know to the contrary, that said complainant in the cross-bill does claim, and its alleged predecessors in interest have claimed, any legal right to occupy and possess said alleged and pretended placer mining claims and each of them, but whether or not such claim or claims have been made, these defendants have no knowledge or belief and have never been informed, save by said complainant's cross-bill, and cannot set forth as to their belief or [31] otherwise, except to allege that if any such claim or claims were or are made the same are unfounded, and that in fact and in law, as the said cross-complainant well knows, it has no legal right to occupy or possess said pretended placer mining claims, or either of them, or any part or portion thereof whatsoever.

Further answering said paragraphs VIII of said cross-bill, these defendants deny that the said complainant in the cross-bill, or its alleged predecessors in interest, or either or any of them, have ever made any compliance with the local laws, or rules of miners, or laws of the United States, or of the State of Idaho, in respect to said alleged placer mining

claims, or either, or any of them, or now have, or ever had, actual possession as placer mining claims, or otherwise, or at all, of the premises described in said cross-bill, or any part or portion thereof.

8. Answering paragraph IX of said cross-bill, these defendants in the cross-bill admit that they assert and claim an interest in a portion of the premises described in said cross-bill, hereinafter more specifically stated, and to the ores and minerals therein contained. They deny that their said claim is false or untrue or unfounded in fact, or casts any cloud upon the alleged title or possession of said complainant in the cross-bill to the premises described in the cross-bill, or any part or portion thereof. Also deny that they base their claim upon any wrongful or unfounded assertion whatsoever, or any assertion unfounded in fact, as alleged in said cross-bill, or otherwise. Or that they have ever claimed that there is any deposit or bed of "carbonaceous limestone or lime phosphate" within the boundaries of said cross-complainant's alleged [32] placer mining claims, or either or any of them, but, on the contrary, what these defendants in the cross-bill have claimed, and do claim, as the said complainant in the cross-bill well knows, is that at the time the so-called placer locations referred to in said cross-bill were pretended to have been made there was contained within the alleged exterior boundaries of said so-called placer mining claims, and each of them, a known vein, or lode, of mineral-bearing rock in place called phosphorite, and valuable only for the said mineral contents thereof. That said lode, or vein,

lies in rock in place in the mass of the mountain between true walls, and has a well-defined dip and strike, and that the same was well known to exist in the manner and form aforesaid at the time of attempt to make said pretended placer mining locations, as alleged in said cross-bill of complaint. These defendants further deny that the said deposits or deposit so found are not in the form of a lode, or vein; also deny that there is no mineral found within the alleged limits of said pretended placer mining claims, or any of them, in the form of a vein, or lode, or that is subject to location or acquisition under the laws of the United States by virtue of lode locations. Also deny that said mineral deposits or deposit consists, as in said cross-bill alleged, or otherwise, than as hereinbefore expressly alleged.

9. Further answering said cross-bill, these defendants in the cross-bill allege that they have made no claim whatsoever as to any of the ground, or alleged mineral, contained within the alleged exterior boundaries of said so-called "Wilmington" placer mining claim, as described in said cross-bill of complaint.

That on the 14th day of November, A. D. 1907, these defendants in the cross-bill, then respectively being citizens [33] of the United States, entered upon the vacant and unoccupied mineral lands of the United States, subject to location, and thereupon made a discovery of a vein, or lode, of rock in place, known and called phosphorite, and thereupon on the 14th, 15th and 16th days of November, A. D. 1907, by virtue of discoveries of a vein, or lode, of phosphorite as aforesaid, and by virtue of full compliance

with the laws of the United States, and of the State of Idaho, and of the rules and regulations of miners, duly located the several lode mining claims, situate in an unorganized mining district in the County of Bear Lake, State of Idaho, known and called as the "Cumberland," "Fentress," "Jimtown," "Obed," "Obey," "Overton," "Mount Pleasant," "Arkansas," "Hickman," "Columbia" and "Wayne" lode mining claims. That said "Cumberland," "Fentress," "Jimtown," "Obed," "Obey," "Overton," "Mount Pleasant," and "Arkansas" have heretofore been officially surveyed for patent as United States Survey No. 2538, to which and to the plat attached to the amended bill of complaint herein these defendants in the cross-bill refer for a more particular and definite description of said lode mining claims, and each of them. That said "Hickman," "Columbia," and "Wayne" lode mining claims have heretofore been officially surveyed for patent and included in United States Survey No. 2537, to which and to the plat attached to the amended bill of complaint herein these defendants in the cross-bill refer for a more particular and definite description of said lode mining claims, and each of them.

That ever since the location of said several lode mining claims, and each of them, these defendants in the cross-bill have performed at least One Hundred Dollars' (\$100.00) worth of work upon, or for the benefit of said lode mining [34] claims, and each of them, each and every year since the location thereof up to and including the year, A. D. 1910.

That the extent of the claim of these defendants

in the cross-bill to the ground alleged to be covered by said pretended "Winfield," "Winter," "Wonder," "Winslow," "Colcock," "Inman," and "Wizard" placer mining claims, and each of them, is specifically set forth and alleged in paragraph VIII of the amended bill of complaint of the complainants herein (who are the defendants in said cross-bill), and to which reference is hereby made the same as if here again repeated and set forth in full. That the claim, and the sole claim, and the extent of the claim, made by these defendants in the cross-bill to the ground described in said cross-bill of complaint is as found and set forth in said amended bill of complaint herein, and to which reference is hereby made the same as if again herein repeated and set forth.

Further answering said cross-bill, these defendants in the cross-bill allege that within the exterior boundaries of complainants' said thirteen lode mining claims, and each of them, there is no mineral lands subject to location as a placer mining claim, and that ever since the location of said lode mining claims these defendants in the cross-bill have been, and now are, the owners, except only as against the paramount title of the United States, in the possession, and entitled to the possession, of the said lode mining claims, and each of them, and the whole thereof, and that said complainant in the cross-bill has no right, title or interest in or to the ground included within the exterior boundaries of said lode mining claims, or either, or any of them, or any part or portion thereof.

And these defendants deny all and all manner of unlawful [35] combination and confederacy where-

with they are by said cross-bill charged, without this, that there is any other matter, cause, or thing in the said cross-bill of complaint contained, material or necessary for these defendants to make answer unto and not herein and hereby well and sufficiently answered, confessed, traversed, and avoided or denied, is true to the knowledge or belief of these defendants; all which matters and things these defendants are ready and willing to aver, maintain and prove, as this Honorable Court shall direct, and humbly pray to be hence dismissed with their reasonable costs and charges in this behalf most wrongfully sustained.

A. B. GOUGH,
A. L. HOPPAUGH,
C. B. JACK and
CHARLES C. DEY,

Solicitors for Morse S. Duffield and Lewis A. Jeffs,
Defendants in the Cross-Bill.

United States of America,
District of Utah,
County of Salt Lake,—ss.

Lewis A. Jeffs, being first duly sworn, deposes and says: That he is one of the defendants to the Cross-Bill herein. That he has read the above and foregoing Answer to the Cross-Bill of Complaint, knows the contents thereof and that the same is true to his own knowledge, except as to those matters therein stated upon information and belief, and as to those matters he believes it to be true.

LEWIS A. JEFFS.

vs. San Francisco Chemical Company. 49

Subscribed and sworn to before me this 22d day of
March, A. D. 1911.

[Seal]

ARTHUR E. MORETON,
Notary Public.

[Endorsed]: Filed March 24, 1911. A. L. Rich-
ardson, Clerk. [36]

*In the Circuit Court of the United States, in and for
the District of Idaho, Southern Division.*

No. —.

MORSE S. DUFFIELD and LEWIS A. JEFFS,
Complainants,

vs.

SAN FRANCISCO CHEMICAL COMPANY, a
Corporation,

Defendant.

Replication to Answer.

The replication of Morse S. Duffield and Lewis A. Jeffs, complainants, to the Answer of San Francisco Chemical Company, defendant.

These replicants saving and reserving unto themselves all and all manner of advantage of exception to the manifold insufficiencies of said Answer, for replication thereunto say that they will aver and prove their said bill to be true, certain, and sufficient in the law to be answered unto, and that the said Answer of the said defendant is uncertain, untrue, and insufficient to be replied unto by these replicants; without this, that any other matter or thing whatsoever in the said Answer contained, material or effect-

ual in the law to be replied unto, confessed and avoided, traversed, or denied is true; All which matters and things these replicants [37] are and will be ready to aver and prove as this Honorable Court shall direct, and humbly pray as in and by their said bill they have already prayed.

A. B. GOUGH,
A. L. HOPPAUGH,
C. B. JACK and
CHARLES C. DEY,
Solicitors for Complainants.

[Endorsed]: Filed March 24, 1911. A. L. Richardson, Clerk. [38]

*In the Circuit Court of the United States for the
District of Idaho, Southern Division.*

IN EQUITY.

MORSE S. DUFFIELD and LEWIS A. JEFFS,
Complainants,

vs.

SAN FRANCISCO CHEMICAL COMPANY, a
Corporation,

Defendant.

Replication to Answer to Cross-Bill.

This repliant, saving and reserving to itself all and all manner of advantage of exception which may be had and taken to the manifold errors, uncertainties and insufficiencies of the answer to its cross-bill made by the defendants therein, Morse S. Duffield and Lewis A. Jeffs, for replication to said answer saith;

That it doth and will aver, maintain and prove its said cross-bill to be true, certain and sufficient in law to be answered unto by the said defendants, and that the answer of said defendants is uncertain, evasive and insufficient in law to be replied unto by this replicant; without that, that any other matter or thing in the said answer contained, material or effectual in law to be replied unto, and not herein and hereby well and sufficiently replied unto, confessed or avoided, traversed or denied, is true; all of which matters and things this replicant is ready to aver, maintain and prove as this Honorable Court shall direct, and humbly prays as in its cross-bill it hath already prayed.

CLARK & BUDGE,
Solicitors for Cross-Complainants.

[Endorsed]: Filed March 31, 1911. A. L. Richardson, Clerk. [39]

*In the Circuit Court of the United States, in and for
the District of Idaho, Southern Division, Ninth
Circuit.*

MORSE S. DUFFIELD and LEWIS A. JEFFS,
Complainants,

vs.

SAN FRANCISCO CHEMICAL COMPANY,
Defendant.

**Stipulation Concerning Final Hearing and
Submission.**

WHEREAS, said cause is now ready to be submitted for final determination; and

WHEREAS, the Judge of said Court is not willing to hear said cause; and

WHEREAS, Hon. William B. Gilbert, Circuit Judge, has heretofore assigned Hon. William C. Van Fleet, District Judge for the Northern District of California, to hear said cause; and

WHEREAS, it is more convenient for all concerned to have the final hearing of said cause at San Francisco, California.

NOW, THEREFORE, it is hereby stipulated and agreed by and between the solicitors for the respective parties to the above-entitled cause that the final hearing and submission of said cause before Hon. William C. Van Fleet, District Judge, be had at the City of San Francisco, California, in said Ninth Circuit, on the 5th day of January, A. D. 1912, at the opening of court on said day or as soon thereafter as counsel can be heard. [40]

IT IS HEREBY FURTHER STIPULATED AND AGREED that the final hearing, submission, decision and determination of said cause, before the Judge and at the place herein named, shall have the same force and effect in all respects the same as if the hearing and final determination of said cause were had within the District of the state of Idaho.

Dated this 13th day of December, A. D. 1911.

CHARLES C. DEY,
C. B. JACK and
A. L. HOPPAUGH,
Solicitors for Complainants.
CLARK & BUDGE,
Solicitors for Defendant.

[Endorsed]: Filed December 16, 1911. A. L. Richardson, Clerk. [41]

* * * * *

[Testimony of Harry J. Pitts, for Complainants.]

HARRY J. PITTS, a witness produced by the complainants, being first duly sworn, testified:

Direct Examination.

(By Mr. DEY.)

Q. What is your full name? A. Harry J. Pitts.

Q. What is your business?

A. A Deputy United States Mineral Surveyor.

Q. For the District of Utah? A. Utah, only.

Q. For Idaho? A. No; not for Idaho.

Q. How long have you been engaged in the practice of your profession? A. About ten years.

Q. In Utah?

A. Mostly in Utah. I have been in a number of states on short visits.

Q. You have been in Idaho, I suppose?

A. Yes, sir.

Q. Did you prepare the plat marked for identification "Exhibit 1, J. W. C."? A. Yes, sir.

Q. From what data did you prepare that plat?

A. From the official notes of survey for patent of the lodes, and—

Q. From what knowledge or information, I mean—

A. —from the advertisements or publications of certain placers which are thereon shown—yes; from the advertisements only as to all of the placers.

(Testimony of Harry J. Pitts.)

Q. And from the description given in the pleadings? You were given the amended bill of complaint as to the conflicting area—

A. Yes, sir; I checked them from those afterwards, yes, sir.

Q. You afterwards checked them from the descriptions in the pleadings in the case? A. Yes, sir.

Q. Now, what does Exhibit 1 purport to show?

A. It shows section 31, and part of section 30, township 12 south of range 45 [46] east of Boise base and meridian.

Q. What county and State?

A. Bear Lake county, I believe.

Q. In the State of Idaho? A. State of Idaho.

Q. All right.

A. Section 6, and part of 7 in township 13 south of range 45 east. In the sections named it shows the location of certain lodes and placers, and the location of—

Q. Hold on. Name the lodes.

A. Beginning at the north and running southerly, we have the Obey, Obed lode, Jimtown lode, Fentress lode, Cumberland lode, Overton lode, Mt. Pleasant lode, Arkansas lode, Tennessee lode—that is not in the suit but it is shown on the map—Hickman lode, Maury lode, Columbia lode, and the Wayne lode. Also beginning at the north end of the map it shows the Colcock placer, Inman placer, Winfield placer, Wonder placer, Winter placer, Winslow placer, Waterloo placer and Wizard placer. It shows the Montpelier Canyon Creek, and most of the outcrop,

(Testimony of Harry J. Pitts.)

prominent outcrop. It shows the courses and distances on the lodes—

Q. Where did you get the outcrop from?

A. In the course of the survey of the claims.

Q. It is drawn to a scale of 200—

A. It is made on a scale of 200 feet.

Q. To the inch; and north is shown by the arrow?

A. Yes, sir.

Q. In what color are the boundaries of the placers shown?

A. They are in green. The lodes are shown in black.

Q. The boundaries are? A. Yes, sir.

Q. Are the corners marked in any way, or identified? A. The corners of the placers?

Q. No, no; the corners of the lodes. Were they identified in [47] any way upon the map?

A. They are given in black figures at their proper places.

Q. The figures indicate what?

A. Indicate the corners as given in the survey.

Q. According to the numbers?

A. Yes, sir; the number of the post is shown in black, as they are returned to the United States Surveyor General's office. For convenience in reading, I have marked the various improvements of any considerable size with small red figures consecutively, beginning at 1, and running to 56. Those improvements, I believe, belong to, or were made by not only this company, but—

Q. Do you know?

(Testimony of Harry J. Pitts.)

A. Only as I have had them identified to me.

Q. Now, what workings are in red? What are they?

A. No; the workings are in black, but the numbers referring to the several workings are in red and placed near them on the map.

Q. Is the character of the working indicated in any manner, and if so, how?

A. Yes, sir; a stripping on the vein is marked so: "stripping," and tunnels are shown in the usual conventional manner, and cuts—

Q. Describe it, what you mean by "usual."

A. Well, the black lines indicate the tunnels and the cuts are by double or parallel lines. Some of the larger cuts have coarse hatching, showing their extent. The top of the principal ridge is shown in brown ink, with hatched lines, and the gulches and roads are also shown in brown in the conventional way.

Q. Any elevations shown?

A. I have not shown any elevations upon the map. The ground rises towards the north.

Q. Describe that canyon or creek.

A. Montpelier Canyon [48] Creek and Gertch Hollow are shown in blue, and the road up Montpelier Canyon is shown in brown.

Q. And marked? A. Marked "road."

Q. The workings, and everything are to the scale you have mentioned? A. Yes, sir.

Q. When were you on the ground—oh, just one question before that. I understand you to say that

(Testimony of Harry J. Pitts.)

you have compared the descriptions and data given on this plat with the amended complaint and answer in this case? A. Yes, sir.

Q. And they are correct? A. Yes, sir.

Q. Now, when were you upon the ground?

A. I first visited the ground on July 13, 1910, and was there about ten or twelve days.

Q. July what? A. July 13, 1910.

Q. (By Mr. BUDGE.) How long did you say?

A. I will see in a moment—until July 27, 1910.

Q. What was the object of your going there?

A. The primary object was to see that the corners of those claims were standing, and to make them so that they would stand for sometime.

Q. Did you survey them at that time?

A. Yes, sir; I made a regular survey of them.

Q. Have these lode claims, shown on Exhibit 1, been officially surveyed? A. Yes, sir.

Q. Who by?

A. By Mr. Brooks, Charles P. Brooks.

Q. Was that subsequent or prior to your going there?

A. That was subsequent. I acted as his assistant while he was making the survey.

Q. You went with him when he made the official survey? [49] A. Yes, sir.

Q. When was that?

A. That was about the last four days that I was there.

Q. In 1910? A. Yes, sir.

Q. And you and Mr. Brooks were both there?

(Testimony of Harry J. Pitts.)

A. I was there alone first, until the corners had been established, then he came out and made the official survey, and went all over them, and surveyed to every post and marked the posts for patent.

Q. Have you, Mr. Pitts, compared the conflicting area described in the amended bill of complaint here with the plat marked "Exhibit 1"? A. Yes, sir.

Q. Is it correctly shown—how did you find it as to being correct or otherwise?

A. It was just the same; the figures of all of the intersections, I think are shown on this map.

Q. And the conflicting area as described in the amended bill of complaint you found to be correct?

A. Yes, sir.

Q. Now, when you went there, where did you start in?

A. I started on the southwest corner of the Overton lode, marked "3" on this map.

Q. Will you please give us what you found and what you did at that time?

A. At corner 3 of the Overton, marked so on this map, being the southwest corner, I found a 4 by 4 sawed pine post and pole 5 inches in diameter, 6 feet long in a mound of stone, marked for the Overton.

Q. Where was the marking on it?

A. Marked "southwest corner of the Overton."

Q. Whereabouts on the post was the marking?

A. As I remember it, it was pointing towards the hill here, southeasterly. [50]

Q. Marked what, southwest—

A. Southwest corner of the Overton. I haven't

(Testimony of Harry J. Pitts.)

written that, or kept any notes of them if they were marked, but if they were not marked, I have noted it. That is why I say it was marked. Then, I went to the southeast corner of the Overton. I found a mound of stone, and Mr. Hoff said it was a part of the original monument at that point.

I went to the northwest corner of the Overton, which was marked also for the southwest corner of the Cumberland. I found a 4 by 4 post lying in a small draw, just below the point here mentioned. It had rolled down the hill, and at a point where the corner is set, as shown upon this map, there was the remains of the mound where it originally stood, and we put it back in that mound.

Q. How long was that 4 by 4 post?

A. I have not a note of it, but my recollection is about 4½ feet long

Q. And marked how?

A. Marked for the southwest corner of the Cumberland and northwest corner of the Overton.

Q. Explain where the marking was on the post?

A. The pole was lying down and was marked on the side. I found it in the draw down below the point where it was set.

Q. Were all those markings you have given on the same side of the post?

A. I don't recollect whether they were or not.

Q. Or on different sides? The post had four sides of it? A. Yes, sir; I don't recollect that.

The southeast corner of the Overton lode—the northeast corner of the Overton lode, which is in

(Testimony of Harry J. Pitts.)

Montpelier Canyon Creek, according to the location notice, I did not find. I re-established [51] it. That was what I was sent up there for, to re-establish those corners if I found them missing.

Q. What did you put up there?

A. I put up a 4 by 4 by 4 post in a very substantial mound of stones, and marked the post for the Overton and Cumberland lodes. The discovery of the Overton lode I found as marked here standing in the—

Q. “Marked here” does not state anything. When you say marked here and there, it don’t sound right in the record. You know what to say, Mr. Pitts, don’t you? When you say here, say marked on exhibit 1. Now, go ahead in that manner.

A. The discovery of the Overton, as marked on exhibit 1, the south end of a large cut, I found in the place indicated on the map, and it was a pine pole 6 feet long and 6 inches in diameter set with a notice in a can on the pole. The discovery of the Cumberland—

Q. No; we will finish that one first. Is that all the marking on the Overton that you found?

A. Yes, sir.

Q. Any center end line stakes? A. No, sir.

Q. Any angles in the side lines in the Overton?

A. No, sir.

Q. Now, you have given everything that you found in connection with the Overton, have you, in the way of markings on the claim at the discovery and the boundaries? A. Yes, sir.

(Testimony of Harry J. Pitts.)

Q. Now, you may proceed to the next. What is the next one?

A. The next claim in order going northerly, and which I surveyed in that order, was the Cumberland. I found at the discovery two hewn posts, side by side in a mound and notice of location there in the mound, and it set alongside of a large cut.

Q. Can you give any better description of the mound or post? [52]

A. No, sir; only from my memory. I have no note put down. My recollection is that there were two posts each about $3\frac{1}{2}$ inches in diameter, and standing about 4 feet out of the ground with something of a mound at the base of the posts.

Q. The notice was there, was it?

A. Yes, sir; I saw that notice. The northwest corner of the Cumberland was a 4 by 4 by 5 feet long, of which I cut off 1 foot, in order to be able to set my instrument over it, and set it more firmly in the ground, not moving it, however.

Q. Marked how?

A. Standing in mound, and it was properly marked, otherwise I should have noted it.

Q. It is not for you to say whether it was properly marked or not. What were the marks on it?

A. Marked for the northwest corner of the Cumberland, and the southwest corner of the Fentress.

Q. Now, will you tell me with relation to the discovery point, or the discovery place where this mark was made; you can do that, can't you? What side of the post, in other words, with reference to the dis-

(Testimony of Harry J. Pitts.)

covery was the marking on it?

A. My recollection is that it was marked on the east side.

Q. Would that be facing the discovery?

A. It would be facing the interior of the claim.

Q. Facing the interior of the claim?

A. Yes, sir.

Q. Very good. Go ahead. Dispose of all of each one as you go along so that I won't have to interrogate on them.

A. The northeast corner of the Cumberland, which equals the southeast corner of the Fentress, marked for that, showing that it was meant for that purpose, was a hewn post 4 by 4 feet [53] standing, which I changed, and put in a 4 by 4 sawed pine post in its place, which post was properly marked,—or was marked—I won't say properly marked, but marked.

Q. How marked and where?

A. For the southeast corner of the Fentress and northeast corner of the Cumberland.

Q. Where marked, on the face? Where was it with reference to the discovery?

A. Facing up the hill; it would be towards the interior of the claim for which it was placed and marked.

Q. Respectively?

A. Respectively, yes, sir. The Fentress lode. The discovery was a 4 by 4, 5 feet long—

Q. Have you gone through the Cumberland?

A. Yes, sir. The south end line of the Cumberland equals the north end line of the Overton.

(Testimony of Harry J. Pitts.)

Q. You have given how many corners of the Cumberland?

A. Four corners, three of which I found and one of which I did not.

Q. Any angles in the side lines? A. No, sir.

Q. Any end stakes, center end stakes?

A. No, sir; not that I could identify.

Q. Now, you passed on to what?

A. The south end line of the Fentress is the north end line of the Cumberland, which I have described. From thence I went to the discovery of the Fentress which I found to be a 4 by 4, 5 feet long sawed pine, notice in mound and standing.

Q. How was the notice put on there?

A. It was put in a can, near the post, as most of them were. I then went to the northwest corner of the Fentress, which is marked "corner No. 3" on this exhibit No. 1, and I found it to be 4 inches square, 4 feet out of the ground, sawed pine. [54] I set it a little more firmly and did not change it in the position as shown on this map.

Q. (By Mr. BUDGE.) Which corner is that?

A. The northwest corner of the Fentress. And then near the center end of the claim I found a pole 4 inches in diameter, 5 feet long, and marked, marking the center of the north end of the Fentress lode, and at the northeast corner of the Fentress lode, I found a 4 by 4 post, 4 feet out of the ground, sawed pine, standing, and properly marked.

Q. Please state what the marking is.

A. Marked for the northeast corner of the Fentress.

(Testimony of Harry J. Pitts.)

Q. Whereabouts?

A. Marked on the side looking down the hill, and the mark was facing the inside of the claim. The next lode as I proceeded north, and which I surveyed next, was the Jimtown lode. I found the southwest and southeast corners to be 4 by 4 post, 4 feet out of the ground.

Q. (By Mr. BUDGE.) What corners?

A. The southwest and southeast, marked "2" and "1" respectively, on Exhibit No. 1.

Q. You found what?

A. Each were 4 by 4, 4 feet out of the ground, sawed pine in mound. They occupied exactly the same position as shown upon this map.

Q. Any markings?

A. They were marked for the southwest and southeast corner of the Jimtown lode.

Q. Whereabouts?

A. In the corner, so that they faced the inside of the claims.

Q. Marked facing the inside of the claims?

A. Yes, sir. At the discovery of the Jimtown lode I found an old discovery post marked, with the notice can on top, lying in the bushes [55] below the phosphate exposure. I reset it on the phosphate and as Mr. Hoff identified its original position as being on the phosphate. That is the best I could do.

Q. Where did you find it lying upon the ground as shown by Exhibit 1, and where did you set it?

A. It was lying just east of the position which is shown, or a little northeast in the bushes, near a

(Testimony of Harry J. Pitts.)

place marked here as "cut."

Q. How far away?

A. About fifteen feet, I should say. The north-west corner of the Jimtown equals and is the south-west corner of the Obed. I found a 4 by 4 post 4 feet long, pine post lying up the hill from the present position as set by me. There was no marking upon the post, but I took it to be the post which had been originally set there.

Q. No marking?

A. It is the only evidence I could find on the corner at that point.

Q. The corners were identified to you by whom?

A. Mr. Hoff was with me and he had been over the ground at a previous time.

Q. What did you do?

A. I run out 300 feet from the point where the discovery was, which was not as far out as this old post was lying, but which distance was called for in the location notice, and set a post there on a line parallel with the other end, which I had found.

At the northeast corner of the Jimtown, which is the southeast corner of the Obed, I found a 4 by 4 post 4 feet long, a sawed pine, lying in the bed of the creek. It was knocked down in the bed of the creek, so I set it up just outside of the creek, but did not set it three hundred feet away from the point [56] where I had the mark of the discovery; I came within that distance. The location notice calls for 300 feet.

Q. To make it plain upon the Exhibit 1, where did you find it, and where did you put it up, in relation

(Testimony of Harry J. Pitts.)

to that corner as it appears on Exhibit 1?

A. The corner post was lying in the creek at the point where Gertch Hollow intersects the north line of the Jimtown, or nearly there, as I remember; I had surveyed to find it, and I picked it up and set it up, set it easterly of the creek so as to get it above the action of the water, and so that it would not be washed down a second time.

Q. Were there any markings on it?

A. No; the markings were washed off, as I remember it; no marks. It had been lying there for some time.

Q. Nothing legible? A. No, sir.

Q. Go on.

A. The Obed lode, which is next north of the Jimtown, I found the discovery, or at the discovery, a 4 by 4 hewn post, 4 feet long out of the ground, set in mound, but I did not find a notice or any marks on the post, but it was identified by Mr. Hoff.

Q. At the discovery?

A. I did not disturb it at all.

Q. What?

A. I did not disturb it at all. It is there now as I found it.

Q. Any notice?

A. No notice or markings, but Mr. Hoff identified it to me as the discovery.

Q. What did you find?

A. A 4 by 4 hewn post, 4 feet out of the ground, set in mound.

The northwest corner of the Obed lode, which is the

(Testimony of Harry J. Pitts.)

southwest corner of the Obey, I found no traces of the old corners, [57] and I set it according to the calls of the location notice.

The northeast corner of the Obed, which is the southeast corner of the Obey, I found an old corner 4 by 4 inches, 4 feet long, sawed pine, marked for the Obed and Obey, the post lying near a clump of bushes. I set this corner in as nearly the present position, or the position it originally occupied as I could in a mound, and after a diligent search could not find any traces of the Government's stone at that place.

Q. What kind of a stone?

A. Of the Government stone. The location notice, as I remember it, called for this corner to be set at the quarter section corner on the north side of section 31, but I was not able to find this stone, and afterwards Mr. Brooks and I looked carefully for it. We were unable to find it.

Q. You set the post yourself?

A. At the point there it was lying.

Q. Is that at the point shown on Exhibit 1?

A. Yes.

Q. Go on.

A. The Obey lode lies next northerly. The northwest corner of the Obey lode was a hewn post, 4 inches square and 4 feet out of the ground. I used this corner post for the final corner, and I took out the post and reset it more firmly, adding a large mound of stone.

Q. Did you give the dimensions of it?

(Testimony of Harry J. Pitts.)

A. Yes, sir; 4 inches square, 4 feet out of the ground.

Q. Marked?

A. It must have been marked on, I would have noted it. I did not note it and I did not pass any that were not marked, but it is set now in about the position I found it. [58]

Q. You haven't any recollection?

A. Not as to the marking, but that it was marked, I am sure.

At the north center end I found a pine pole, 4 inches in diameter, 5 feet long lying on the ground about 100 feet beyond and north of the center end as I established it.

Q. And marking?

A. Marked on the side for the Obey lode, center end. The northeast corner—

Q. (By Mr. BUDGE.) How was that marked?

A. I cannot give you the exact markings on it, because I did not note them, but it was marked as the center end of the Obey lode, and was lying down about 100 feet northerly of the center end as shown upon this Exhibit No. 1.

The northeast corner of the Obey was a 4 by 4 pine post, 5 feet long, standing about 200 feet northerly from the corner as I set it. In other words, the claim was staked out a little bit long, and I drew it in about that much and reset the corner at the present position of corner 4 as being within the calls of the location notice.

The discovery of the Obey lode was a 4 by 4 by 4 foot

(Testimony of Harry J. Pitts.)

pine post lying as I located it here, and is shown on Exhibit 1. I set it up on the dump, and built a mound around. It is marked for the Obey lode.

Q. Marked how?

A. Marked in pencil for the discovery of the Obey lode, is my recollection of it.

Q. How long was that post?

A. It was 4 feet long; 4 inches square and 4 feet long, lying on this dump. I picked it up at the place where I found it, and that point is marked "discovery" on Exhibit 1. [59]

Q. Now, were there any angles in the side lines of any of the claims that you have described so far?

A. No, sir.

Q. Proceed.

A. I next went to the Arkansas lode, and I found the northwest—no; I went to the Mt. Pleasant lode first. On the Mt. Pleasant lode I found the northeast and northeast corners each 4 by 4, 4½ feet long, pine posts, which I firmly set. There was a small mound at the northeast corner. There was no mound, as I remember it, at the southwest. At the northwest corner I found an old post marked for the Mt. Pleasant, and also the northeast corner, and I cut off a little of the post at the northwest corner, so that I could set my instrument over it, but I did not change its position as I found it set. At the discovery was a 4 by 4 pine post, 4 feet out of the ground, standing at the mouth of the discovery and tunnel, as shown on Exhibit 1. I could not find the southeast and southwest corners. At the southwest corner, that

(Testimony of Harry J. Pitts.)

position, as I set it, was identified to me and agreed approximately with the location notice.

The Arkansas lode, northwest corner, as I found it, was as located on Exhibit No. 1. It was a 4 by 4 pine post, 4 feet long, lying down. I stood it up and added a mound to it. There was a sign of where it had been standing there, and I stood it up and set it firmer. The northeast corner I could not find any traces of. I established it from what evidence I could get on the south end and location notice.

The east center side line there was as I found it 2 inches by 4 inches by 4 feet long, or 4 feet extending out of the ground on a cliff of rock adjacent to where I set the new corner marked "3" on Exhibit 1.

Q. Was that a center side line? [60]

A. Yes, sir.

Q. An angle in the side line there?

A. That was an angle there, yes.

Q. And marked so?

A. I don't know whether there had been any other part to this when I found it.

Q. Have you given the markings on that stake?

A. Only as east center side line, which I think was the original mark. I have usually designated here the way I found it marked upon the post, and if it was not marked, why, I have not noted it here.

Q. That was lying down?

A. No; that was standing.

Q. Now, where was the marking with reference to the discovery of the claim?

A. There was only one way you could see it, which

(Testimony of Harry J. Pitts.)

was from down the hill.

Q. Where was the mark?

A. The mark was on the side looking down the hill into the Arkansas claim.

Q. I don't know downhill, or uphill on your map there.

A. It looked westerly. On the west center side there was an old 4 by 4 post standing 4 feet out of the ground, about 150 feet westerly from the one which I set, which is marked on Exhibit 1 as "6."

Q. Any marking?

A. No marking. I am not sure it was the correct one. I set a new post 150 feet further in. On the Arkansas claim there were some corners which I could not identify. I found the southwest corner of the Arkansas, a 4 by 4, 4 feet long, pine post, marked for the southwest corner of the Arkansas way down the gulch near the center of the Tennessee lode, evidently washed down in the spring. I set a [61] new post about 300 feet from the discovery, but I could not identify the end line to the west. The location notice called for the end line being 30 feet away from the discovery, which I found and 600 feet in width of the lode, and I mapped out on the ground the Arkansas lode as best I could. After a diligent search I could not find the original southeast corner. This claim is now bounded as Mr. Hoff thinks it should be, taking in work put on by the Duffield and Jeffs Company in green.

Q. You are done with the Arkansas now, are you?

A. Yes, sir.

(Testimony of Harry J. Pitts.)

Q. What corners were missing there?

A. As marked on exhibit 1, corner 2 and corner 4. Corner 5 I found, but down by corner 3 of the Tennessee, down in the gulch, but I don't think it was set originally there.

Q. It was lying down?

A. It was lying down in the gulch. The discovery of the Arkansas was a hewn post 3 inches in diameter, 5 feet long, with stone mound, and the notice was in the mound. I don't remember that this post was marked. It was a good-sized mound with the notice in the can, and this post stuck up there.

I next went to the Hickman lode. The southwest corner of the Hickman was located in the position marked for 2 Maury lode on Exhibit 1, an unhewn post in mound of stone marked for southwest corner of the Hickman, also for the northeast corner of the Maury.

Q. (By Mr. JACK.) That is the southwest corner of the Hickman, you say? A. Yes, sir.

Q. (By Mr. JACK.) And the northeast of the Maury?

A. Yes, sir. At the southeast corner of the Hickman I did not find any post, but I found a substantial mound of stone, which [62] was identified as being the southeast corner of the Hickman.

Q. Did that mound have the appearance of having had a post in it?

A. Yes, sir; built by hand without a doubt. The rock remained there in a good substantial mound, but

(Testimony of Harry J. Pitts.)

I could not find any markings to make sure of it, and that was located about four or five hundred feet easterly of the southwest corner of the location corner as I found it.

Q. How many feet?

A. About 500 feet, I think, but I can tell you. It was directly south 0 degrees 31 minutes east of corner 5 of the Hickman lode as marked on Exhibit 1. It was on that line and that is how that line was determined.

Q. How far south?

A. That claim was surveyed in two different ways. The first time it was laid out it was made square and afterwards drawn into the odd shape in which it now appears, but the shape in which it now appears is within the corners as they were found to exist as it was surveyed first.

Q. I am asking you to make clear just what you found on the ground in the way of markings with respect to the Hickman claim, and where they were, and what you did.

A. It was 425 feet easterly of corner No. 2.

Q. —when the question was asked you was away from corner No. 5?

A. I cannot give that without some considerable calculation.

Q. Now, mark on there about where it was as nearly as you can.

A. It is approximately where I put the black pencil dot and marked it "L. C. Hickman, southeast corner"; and the northeast corner of the location was

(Testimony of Harry J. Pitts.)

standing at a point which is marked on here— [63]

Q. On Exhibit 1?

A. On Exhibit 1, "L. C. Hickman, northeast corner," approximately at that point. Now, I have got the description of it. The northeast corner was a 4 by 4 post, sawed pine post, in a substantial mound of stones, marked for the northeast corner of the Hickman, and the markings were pointed southwesterly, pointed up from the gulch. The south center end of the Hickman lode I found on a line with the two south boundary posts of the Hickman, and about midway between. I did not make a record of how far it was in there, but there was a post standing marked for the south center end of the Hickman lode.

Q. Give the dimensions and where it was marked.

A. It was an unhewn post, and I have no mention here, but I remember it was about 3 inches in diameter, and something of a pole. This post stood up some distance.

Q. Was it not hewed for marking?

A. No; it was not hewn; just written on the side of the pole.

The north end center of the Hickman lode I found a 4 by 4 post 4 feet out of the ground, found in mound of stone, marked for north and center of the Hickman lode, or northwest corner.

Q. Hold on a minute. Where was that mark, and where was that post located? Identify it on Exhibit 1 where you found it.

A. I have not the notes here from which I could locate it exactly. It was about at the point marked

(Testimony of Harry J. Pitts.)

for 6 of the Hickman in its present form of survey, about 300 feet from the northeast corner. It was standing on the west side of a small draw which drained down from the discovery.

Q. (By Mr. BUDGE.) Are you talking now about the north center end.

A. I did not find the northwest corner, or any traces of it. [64]

Q. Now, have you completed the corners of that claim as originally found?

A. I have completed the corners with the exception of making a note of the discovery which I found.

Q. All right. The discovery of the Hickman was a 4 by 4 post, 5 feet, alongside of another post in a mound, marked "Discovery of the Hickman."

Q. Is that shown on Exhibit 1?

A. I don't remember that I found a notice there, though there might have been one.

Q. Is that shown on Exhibit 1?

A. The discovery is shown on Exhibit 1 at a place marked D. I S.

Q. At the same place shown on Exhibit 1?

A. Yes, sir.

Q. Now, did you draw in the Hickman claim to the present position before Mr. Brooks made his survey?

A. No; that was recent, and I was not present when it was drawn in to its present shape, but he was familiar with the posts as I set them; and originally, at the time I assisted him, he surveyed it making it a square claim, and afterwards changed it before the notes were sent to the Surveyor General's office.

(Testimony of Harry J. Pitts.)

Q. And angles in the Hickman side lines?

A. In the calls of the location notice or certificate there were none, but at present it has a very angular appearance.

The Wayne lode, I think, is the next one here in its order. Do you wish me to describe all the other claims which are shown on here?

Q. You have got the Columbia and the Wayne left?

A. The corners which are involved, I believe, in this case of the Columbia are corners 4 and 5 as marked.

Q. Give us the lay of the Columbia. Never mind what is involved here. [65]

A. All right. For the Columbia lode, the corner of which is marked "No. 8" on Exhibit 1 was found in place, an unhewn post 7 feet long in a mound, identified to me by Mr. Hoff, identical with the southeast corner of the Maury lode.

Q. Marked how?

A. I don't remember the markings. I don't think it was marked; it was just a long hewn post in a good substantial mound of stone. The northeast corner marked "1" on Exhibit 1 was not found, but falls in the gulch as near as I can make out from the location notice—it would have been placed in the gulch at the turn of the much used road at the base of, or near the ore bin of the phosphate company which was working there.

Q. How are the ore bins shown on Exhibit 1?

A. The bin is shown by the rectangular black spot.

Q. Give us the two markings, and the side that the

(Testimony of Harry J. Pitts.)

markings were on.

A. That one was not found. I found the discovery post in the mound above the cut shown here on Exhibit 1.

Q. Shown how on Exhibit 1?

A. Shown so on Exhibit 1 as being just above a cut. I did not find the location notice. The post was identified to me by Mr. Hoff, and no markings that I remember.

Q. Did you give the dimensions?

A. I haven't them noted, but I remember them to be about 4 inches square and about 4 feet out of the ground. Did not find corner No. 2; it falls on the side of the dump on which it was hard to make it stand. I don't know that the corner I put up would stand there although, I took particular care to make it solid.

Q. Corner No. 7 was found in a place located here. (Pointing.) [66]

Q. That is an angle in the side line?

A. Yes, sir. It was a crooked pole marked at angle in Columbia lode, set in mound of stones.

Q. Give the dimensions.

A. I did not take the dimensions. It was not larger than 3 inches in diameter, and just a crooked pole standing in the mound.

Q. How long?

A. About $4\frac{1}{2}$ feet long, as I remember it; stood up quite high. Did not find corners 3 or 6, but the posts were identified by the lode line angle poles which stood midway between the positions as shown on Ex-

(Testimony of Harry J. Pitts.)

hibit 1, and at the turn in the lode line, and were marked "Columbia"; I have forgotten the exact marks. At any rate it indicated to me it was the bend in the lode line.

Q. (By Mr. BUDGE.) You say there was no post there?

A. There was a post midway between posts 6 and 3, which, as I say, was so marked as indicated to me that it was the bend in the lode, but not a bend in the side line. Corners 4 and 5 were substantial stone monuments without posts in them, and they were identified to me as being the southeasterly end line of the Columbia.

Q. By Mr. Hoff?

A. By Mr. Hoff, yes, sir. I think that is all of the Columbia lode.

The first thing I have on the Wayne lode is regarding the south end. The southwest, the southeast corner and the south center end poles were lying down alongside of small mounds.

Q. (By Mr. BUDGE.) What corner now?

A. The southwest corner, marked "6" on Exhibit 1; Southeast corner, marked "5" on Exhibit 1, and south center end were lying alongside of a small [67] mound. The poles were marked in pencil for the Wayne, and just inside of the fence to a pasture. Corners No. 4 and 7, angle corners, were monuments of stone identified to me by Mr. Hoff. They stood near the summit of a small ridge, and could be plainly seen from the adjacent hill. The mounds were of good size with no posts in them.

(Testimony of Harry J. Pitts.)

Corners No. 3 and 8, angle corners, I found a post on the angle of the lode line between the two corners, found standing; identified by Mr. Hoff. There was a mound with a small pole as I remember set in it midway between corners 3 and 8, and that bend was identified to me by Mr. Hoff as being a turn in the center line.

Q. (By Mr. JACK.) What number is that?

A. Between 3 and 8.

Q. (By Mr. JACK.) What is the number of the ones you are talking about?

A. Corners 3 and 8, and this mound I speak of stood midway between the two points here shown on Exhibit 1. The discovery post shown hereon was a 4 by 4 post, standing 4 feet out of the ground in a mound of stone, and in pencil "discovery" alongside of an old post unhewn, identified to me as being the discovery of this claim, by Mr. Hoff.

Q. "This claim" don't mean anything in the record?

A. The Wayne lode. Corners No. 1 and 2 were not found. Their *loci* were determined from the calls in the location notice. I think that is all the notes I have in the book.

Q. Were any changes made in any of the other claims, besides the Hickman, from the way you found them and re-established them on Exhibit 1?

A. I think the only one would be the drawing in of the Obey, slightly.

Q. Drawing it in to the south?

A. Yes, sir; the end line [68] run more north-

(Testimony of Harry J. Pitts.)

easterly than it is shown here.

Q. You did not draw them in at that time you were surveying there?

A. Yes, sir; I set a post in at a point as marked here. I did not see the original corner, and I set a corner at the point marked on Exhibit 1, "4" and marked it at that time "northeast corner Obey," and the others were a considerable distance out.

Q. You mean northeast or northwest?

A. Northeast corner. The northwest corner is as I found it, a large hewn post and stood as here indicated.

Mr. DEY.—You may cross-examine.

Cross-examination.

(By Mr. BUDGE.)

Q. Mr. Pitts, was this the first survey that you made at the time you were up there in July, 1910, of this ground?

A. Yes, sir; I think that was the first time I was ever upon the ground.

Q. You never had anything to do with any other surveys prior to 1910?

A. Of this particular ground?

Q. Yes. A. No, sir.

Q. And were there two surveys made at that time?

A. I made a preliminary survey identifying the corners, and in setting them firmly, and afterwards an order was issued by the Surveyor General to Mr. Charles P. Brooks, who is a deputy in Idaho, and he came up there and went all over the ground, and examined the evidence that I had of various corners,

(Testimony of Harry J. Pitts.)

if there was a question regarding them, and made the survey which was sent in to the Surveyor General.

Q. You made a survey then first without the aid of Mr. Brooks? [69] A. Yes, sir.

Q. And who assisted you?

A. Mr. Hoff and Mr. Cousins, and another gentleman, whose name I don't recollect, but he is working for this company.

Q. Any other surveyor?

A. Oh, there was Mr. Guio, in our office; he was with me at the time.

Q. Now, did you assist in the official survey that was made by Mr. Brooks?

A. Yes, sir; I assisted as a chain man in measuring and marking of the corners.

Q. Did you assist in any of the calculations?

A. Yes, sir; I afterwards assisted in the calculations also.

Q. Now, does this map marked "Exhibit 1" purport to represent the preliminary survey which you made?

A. With the exception of the Hickman lode, the two surveys agree, I think.

Q. You don't answer the question.

A. It does purport to show the condition of affairs that I found as I interpreted it to the best of my ability.

Q. In other words, this map represented what you found by your preliminary survey?

A. Yes, sir; with the exception of the Hickman lode. I did not assist in changing its boundaries.

(Testimony of Harry J. Pitts.)

Q. So far as the Hickman lode is concerned, the representation on this map does not accord with the preliminary survey which you made?

A. It falls wholly within the ground—

Q. Please answer my question.

A. No; it does not. The courses and distances of the boundaries are not the same.

Q. This map, was it made from the notes which you took of your preliminary survey?

A. No, sir; this map was made from [70] Mr. Brooks' notes, and those notes which were sent to the Surveyor General together with notes which were made by myself. The improvements were not returned.

Q. This map was not made from your notes?

A. No; I think my notes were not consulted in the making of it.

Q. Well, have you made any comparison to determine whether or not this map conforms to the notes you took at your preliminary survey?

A. Yes, sir; I am sure that it does.

Q. Just answer the question.

A. I don't think that I have taken out my notes and compared it, no.

Q. You have made no comparison?

A. The comparison—I will qualify that a little. There was a comparison made at the time, the course of certain lines were determined, and certain angles returned in the field, to see if they agreed with me, and I do not remember that they were any different.

Q. I asked you if you made a comparison.

(Testimony of Harry J. Pitts.)

A. No.

Q. Between this map and your notes? A. No.

Q. So that, as a matter of fact, you don't know whether this map conforms to your preliminary survey or not?

A. Well, I do know that it does, because I have in the time I spent with it in connection with the notes, I became familiar with the ground.

Q. You know that, that this map conforms to it, and you would be in a position to testify to it as a surveyor, that it does conform to it, without any comparison of your notes?

A. I could only say this in the survey made by Mr. Brooks—

Q. Can't you answer that question?

A. No, sir; not by yes or no. I would have to tell you how it was. I know we did not disagree as to the courses and distances and angles turned, and therefore his notes and my notes must be practically the same; it was from his notes I made this map.
[71]

Q. Did you compare your notes with his?

A. On the ground at the time they were being taken, yes, but not since the map has been made.

Q. Did you do it with every course and distance?

A. Where he followed my lines, and in most cases he did.

Q. Did you compare them?

A. Yes, sir; compared them in the field.

Q. And you compared them in all instances?

A. I think in every instance.

(Testimony of Harry J. Pitts.)

Q. And every claim?

A. Yes, sir; I went from one to another.

Q. Every line you ran and every line Mr. Brooks ran was compared, was it?

A. When a course and distance was measured, yes, sir.

Q. The corners,—location corners also?

A. Yes, sir; I accompanied him to each corner.

Q. Mr. Pitts, were the notes compared of those two surveys? A. No.

Q. No; they were not compared either on the ground, or off of it, were they?

A. In what regard?

Q. Your notes, and Mr. Brooks' as to the courses and distances and the location corners and discovery points.

A. Yes, sir; on the ground he followed the line I followed, I think, almost exactly, and wherever an angle was turned or the distance measured, the course and the distance was checked between our notes to make doubly sure.

Q. In other words, when you were running the north boundary line of the Obey lode, for example, or rather when Mr. Brooks ran it did you compare your notes with Mr. Brooks' survey or his notes to [72] ascertain if they agreed?

A. As to the distance and course between two corners, yes.

Q. And you had your notes present there when the Brooks' survey was made?

(Testimony of Harry J. Pitts.)

A. Yes, sir; I had just finished the preliminary survey.

Q. And consulted them? A. Yes, sir.

Q. And that was true when you run every line as to all of these lodes?

A. With the exception of the Hickman in its present shape.

Q. And that was true as to the location, for the location of what you call the discovery points on each of these claims?

A. Yes, sir; and I took pains to communicate to him the conditions in which I found each corner and what changes, if any, had been made, so that he was perfectly familiar with what had gone on on the ground.

Q. Have you made any—did you say that you made this map up from Mr. Brooks' notes?

A. Yes, sir; the official notes as he returned them to the Surveyor General, and they are now on file in the Surveyor General's Office of Idaho, except the improvements—

Q. Except what?

A. Except the improvements, the cuts and tunnels, which are from his notes, and which I assisted him in taking.

Q. Now, Mr. Pitts, calling your attention to this Overton lode claim, as marked upon this Exhibit 1, you say you commenced at the northeast corner?

A. The southwest corner.

Q. You meant the southwest corner?

A. Yes, sir.

Q. The southwest corner. Now, was there any

(Testimony of Harry J. Pitts.)

mark there? [73]

A. Yes. Do you wish me to read it again? It is already in the record.

Q. In my notes I thought you had made a mistake, but I find in the notes I had the wrong corner. The southwest corner, I want to know what the mark was?

A. The southwest corner was a 4 by 4, 4 feet out of the ground, sawed pine and a pole, 5 inches in diameter, 6 feet long, which was marked for the Overton, and, as I stated, I believe it is marking the southwest corner of the Overton.

Q. Now, were both posts marked?

A. I have it that each was marked.

Q. How were they marked?

A. Marked in pencil.

Q. What was on each post?

A. Southwest corner of Overton, is all I can remember.

Q. Were they both standing together?

A. Yes, sir; they were in a stone mound.

Q. Nailed together?

A. No. I took out the large pole when I fixed the corner up.

Q. Did you make a measurement of these poles?

A. I used the 4 by 4; not the pole for the final corner.

Q. Did you make any measurements of those poles?

A. You mean to measure the sizes of them?

Q. Yes.

A. Yes, sir; I have measurements of them.

Q. How did you measure them?

(Testimony of Harry J. Pitts.)

A. Why, I had a tape with me and I suppose I used this tape.

Q. It is not what you suppose that I want. Did you measure them with a tape?

A. I can't remember now whether I did or not.

Q. Do you remember whether you measured them at all, or not? [74]

A. Only from my notes which I have taken, giving the sizes of them.

Q. Yes; but haven't you any distinct recollection. It hasn't been so very long ago, Mr. Pitts. Haven't you any distinct recollection as to whether or not you made any measurements of those poles.

A. You mean to ascertain the absolute size of the pole?

Q. Yes; and the length and diameter and width, and all about them?

A. No, sir; it is not customary, but I probably did observe it.

A. I am not asking you what is customary. I asked you what you did, Mr. Pitts?

A. I probably observed it.

Q. Well, did you do it? A. I don't know.

Q. Did you find any notice there?

A. At the corner?

Q. Yes. A. No, sir.

Q. Find any notice at the discovery point?

A. Well, I say "pine pole six feet high, six inches in diameter in cut, set with notice."

Q. With notice? A. Yes, sir.

(Testimony of Harry J. Pitts.)

Q. Have you any distinct recollection as to that notice?

A. No, sir. Since the time I was over there I have been over at least a hundred claims, and all those details have not become fixed in my mind; unless I put it down. I have certain methods of writing those things down which indicates to me, whether there was or was not.

Q. And there were no center end line posts to this claim at all?

A. I have none noted, but I have in mind there was a mound of stone at the center end of this, but I won't state—I won't make a positive statement in regard to it.

Q. Now, what did you find at the other corners?

A. At the [75] northwest corner of the Overton?

Q. Yes.

A. The northwest corner, which is the southwest corner of the Cumberland, I found lying in a small draw below the present position, that is the position in which I find it marked—

Q. Found what?

A. I have this note: "Northwest corner equal to southwest corner of Cumberland," which would indicate to me that I found it marked. Otherwise, I would not have filled it out that way. "Found lying in a small draw below present position," that is the position which is marked on Exhibit 1. I reset it in its original position in mound of stones that was higher up the hill.

(Testimony of Harry J. Pitts.)

Q. Now, what did you find in the small draw?

A. I haven't a note, but I remember that as a 4 by 4 post, 4 feet long.

Q. Measure them?

A. I make the general statement, I don't remember of making any measurements of them absolutely.

Q. So that when you say a post 4 by 4, 4 feet long, that is just your guess at it as to the length and dimensions of it?

A. Yes, sir; I am used to seeing them.

Q. And that is true of all of them?

A. Yes; I will say that is true of all. Where I say 3 inches it was when I observed it was less than the ordinary size of a post as we usually set them up.

Q. And the others might have been less for that matter?

A. A trifle less. Where a sawed pine post is used it is a quarter of an inch less each way, usually, than the dimensions called for; that is, dimension of lumber is usually smaller than it is named, and a 4 by 4 post is often $3\frac{3}{4}$ by $3\frac{3}{4}$. [76]

Q. Now, when you say that the post was 4 feet out of the ground, did you make any measurement to determine that?

A. Not absolutely; no, sir. I judge that by my instrument usually.

Q. That was just your guess at that also?

A. Yes, sir.

Q. Now, in these corners that you established when you were making this preliminary survey, did you establish them according to the survey which you

(Testimony of Harry J. Pitts.)

made, or according to the identifications which were made by Mr. Hoff?

A. There was a different condition at each corner, and if there was no post found at the corner, I used the best material I had at hand to re-establish it. For instance, when I did not find the southeast corner of the Cumberland and the northeast corner of the Overton, I had the course of the south line of the Overton, and the distance called for in the notice of the Overton, and I had a reasonable—I was reasonably sure of the corner at the northwest corner of the Overton, therefore, I drew a line parallel with the south line and gave it the distance called for in the location notice.

Q. So that you established that corner according to the survey?

A. Yes, sir; and that was the reason, I will say that was the reason I was sent there, to get the corners in permanent shape from the best knowledge of the conditions that I could secure.

Q. Now, I am asking you whether or not your establishment of these corners ever varied by the identifications given to you by Mr. Hoff from the survey which you made?

A. In the case of the Wayne, between corners 8 and 3 Mr. Hoff identified the bend in the lode line, and from that and the courses running to the other angles of the claim, I established by survey, the corners. He [77] did not show me where he thought 8 or 3 was, but he did show a corner midway between them.

(Testimony of Harry J. Pitts.)

Q. He showed you where corners 4 and 7 were?

A. Yes, sir; I could see those plainly, but he identified them to me as being at that angle.

Q. As being those corners? A. Yes, sir.

Q. Did they agree with your survey?

A. They are just as I have them here exactly.

Q. Did you survey it out to see whether the corners were actually the distances which they were supposed to be from certain other corners?

A. Not in that case. Where monuments were found I took them to be in their proper places.

Q. You did not run any line?

A. I run lines to make them all agree.

Q. Did you run any lines down to these corners pointed out to you on the Wayne? A. Yes, sir.

Q. Between corners 4 and 7? A. Yes, sir.

Q. Did they agree with your notes?

A. The location notice, you mean?

Q. Yes.

A. I don't remember whether they did or not.

Q. And did the distance running to these corners from some other given point, did the distance agree with where Mr. Hoff said they should be? For example, running down on the Wayne lode where is corner 3 and corner 4? (Witness points.)

Q. Now, if you were running from corner 2 to corner 3 according to the notice, you had a certain distance to run, didn't you?

Q. Did that distance, running that distance from 2 to 3, take you to where Hoff said this corner was?

A. I don't remember. [78] now. I compared it

(Testimony of Harry J. Pitts.)

at the time, and I think they were in all cases approximately right; a man who makes a location of a claim is not supposed to be a surveyor.

Q. Answer the question. Can't you remember whether they all agreed, or did not agree?

A. No, sir. If you have the notice I can tell you by comparing the courses. The courses are all plainly stated on here as I established and found the monuments.

Q. Well, then, does this map, Mr. Pitts, represent the corners which were established by your survey, or does it represent the corners which were identified by Mr. Hoff in the cases where he did identify the corners?

A. Yes; he identified the corners with the exception, as I say, of these corners up here.

Q. The corners up where?

A. At the north end of the Obey; that is, at the northeast end.

Q. The northeast corner, and the north center end represents the corners there as you found them, or as they were identified by Mr. Hoff?

A. Well, I would have to go through then and specifically show each one. I found these two corners at the south end of the Jimtown standing exactly as shown and I found the north end line of the Fentress, and the south end line of the Fentress, and the south end line of the Overton, or north end line of the Mt. Pleasant—

Q. You do not evidently understand what I am

(Testimony of Harry J. Pitts.)

trying to get from you, Mr. Pitts; I am trying to find out whether these corners which are marked on this Exhibit 1 are the corners which you [79] found or established by running the actual line to the corner, or whether you have marked on this map the corners which were identified by Mr. Hoff independently of your survey? A. I can give you—

Q. Answer that question.

A. Yes, sir; all the corners which were standing and which I found and identified myself, are represented on here as I found them. There were certain signs of corners which showed them to be corners, being mounds assembled by hand, and which I could not identify, but which Mr. Hoff identified to me. Those corners are shown on here in the positions in which I found the evidences of them. After that when there was no mound and Mr. Hoff could not identify to me the original place of the corner, then from the location notice, or the nearest material at hand, I re-established it.

Q. Now, then, where Mr. Hoff pointed out corners to you, various corners, and identified them as particular corners—

A. Yes.

Q. Of particular claims, did your survey agree with those corners which he pointed out? A. Yes, sir.

Q. In all instances?

A. Yes, sir. The claims show that they are not all 1500 by 600 feet, in regular distances; they show irregular distances.

Q. Did they agree in all instances with Mr. Hoff's

(Testimony of Harry J. Pitts.)

identification on your survey?

A. Yes, sir; generally, approximately with the location notice.

Q. I don't ask you approximately. Approximately is a very uncertain statement. Let us have something definite about it. Did [80] they agree?

A. I don't seem to catch the exact question. I am trying to answer it for you. State it again.

Q. I am asking you whether or not when Mr. Hoff pointed out to you a corner as a particular corner of a particular claim— A. Yes.

Q. Whether your survey showed the corner to be where Mr. Hoff pointed it out?

A. I don't remember any instance of any corner that he showed me that would not seem to agree approximately or nearly, with the calls in the location notice. I never do expect a location notice to give the exact courses and distances between monuments, and I never found one to do so, unless it was made by a surveyor.

Q. The best you can say then is that it agreed approximately?

A. With the calls in the location notices.

Q. What do you mean by approximately?

A. For instance, running to the south end line, they usually call for a distance of 1500 feet, and in some of the courses it was 80 feet short of being 1500 feet.

Q. In other words, you would find the mound which Mr. Hoff said was a particular corner, 80 feet short of where the survey would be?

A. Yes, sir; making a 1500 foot claim.

(Testimony of Harry J. Pitts.)

Q. Or taking the location notice?

A. Yes, sir; that is correct. The claims, I think, in all cases were 600 foot claims, and the call is for 600 feet, but in many cases the distance is short from 30 to 50 feet.

Q. In other words, the map represents the 600 claim short of what the location notice would estimate it to be? Not 600 feet?

A. Narrower than the location notice called for, yes, sir. [81]

Q. Therefore, if you took the mound pointed out to you by Mr. Hoff, it would make the claim smaller than the location notice called for. Is that true?

A. Yes, sir; if there was any case where it called for a longer distance; I can't remember any of them now.

Q. Have you a distinct recollection that all these posts which you say were marked were marked facing the interior of the claim?

A. I have no recollection of where I found a post standing that it is marked otherwise, or where it was facing, other than towards the interior of the claim, and when I put down in my notes that it was properly marked, I mean that it was marked as a certain corner for a certain claim, and that the markings were facing towards the claim.

Q. Now, calling your attention to the Jimtown claim, you say at the northwest corner of the Jimtown you found a 4 by 4, 4 feet long in the bed of the creek?

A. Yes, sir.

Q. And that you set it out of the creek to prevent it from being washed away again? A. Yes, sir.

(Testimony of Harry J. Pitts.)

Q. Now, there were no marks on that post, were there?

A. I think the marks were all washed off.

Q. Why do you say "washed off"? How do you know it?

A. My recollection of the post is that it had been there for some time.

Q. What?

A. My recollection of the post is that it had been there for some time, and that the water was running over it.

Q. Do you know whether any marks on it were washed off or not?

A. I can't state that there were any marks at all, if there [82] were any marks on it. I could not say if there had been any marks on it previously.

Q. Then you don't know whether any marks were washed off or not?

A. Only that it was similar to other posts I found in the neighborhood.

Q. When you say that corner, where you found the post in the creek, did that bring the corner down into the bed of the creek, the other corner?

A. The bed of the creek is about 230 feet horizontally from the discovery, and I think it must have been set out further originally, and I set it up on the far side from the discovery on the creek.

Q. Where would have been the true corner with reference to the creek?

A. It would have been 300 feet out and about 40 feet easterly of the point as I state, probably more than 40 feet.

(Testimony of Harry J. Pitts.)

Q. And so you drew your corner in some?

A. I did not wish to put it out when I had no more evidences than that.

Q. Now, when you reset these posts, did you use the same posts that you found there?

A. I think I noted, and it is in the record where I found the 4 by 4 posts, sawed pine, they were usually too long, longer than the Government requires them to be set, and I had to take off a foot or so from the top, and then I made them more firm by setting them further in the ground and building a good mound of stone around them.

Q. How far out of the ground would they extend?

A. We usually leave 3 to 3½ feet out of the ground.

Q. From the base of the mound?

A. No; from the ground. [83] I set them about 18 inches in the ground on the average, unless they fell on solid rock, which prevented me from doing so. We usually set them 18 inches in the ground, and put a mound of stone around them of about 2½ feet base.

Q. The stakes were originally how long before they were set?

A. The stakes in many cases were 5 feet long. I have one particular one—

Q. You say you sawed some of them off?

A. I say I have one particular one in mind, which is the northwest corner of the Cumberland. I sawed off a foot and reset it.

Q. Leaving it what length?

A. Leaving it about 4 feet long.

Q. And then you set that 18 inches in the ground?

(Testimony of Harry J. Pitts.)

A. Yes, sir. I think all of the corners as they now stand, after having been set, stand about 3 feet on an average out of the ground in the mound of stone.

Q. You don't know, Mr. Pitts, of your own knowledge, when any of these posts were placed on this ground that you found lying down or standing?

A. No, sir. As I say, my first visit there was in July, 1910.

Q. Now, in some places, and I call your attention particularly to the Columbia, you say at the corners 4 and 5 you found stone monuments. Is that correct?

A. Yes, sir.

Q. Now, just describe them.

A. About 2½ feet base and about 18 inches high.

Q. And is that true as to all of the stone monuments which you found? Is that about the size of them, or the height of them? A. Yes, sir. [84]

Mr. BUDGE.—I think that is all.

Mr. DEY.—That is all.

H. J. PITTS. [85]

[**Testimony of Morse S. Duffield, for Complainants.**]

MORSE S. DUFFIELD, plaintiff, produced as a witness on behalf of complainants, being first duly sworn, testified:

Direct Examination.

(By Mr. DEY.)

Q. What is your full name?

A. Morse S. Duffield.

Q. What is your business?

A. Mining and mining engineering.

(Testimony of Morse S. Duffield.)

Q. How long have you followed your profession as such? A. Fourteen years.

Q. What education did you have?

A. I graduated from Harvard University in 1897.

Q. And in what places have you followed your profession? A. In the Western States and Alaska.

Q. Were you one of the locators of the lode mining claims described in the amended bill of complaint herein? A. Yes, sir; I was.

Q. Shown on Exhibit 1 before you?

A. Yes, sir.

Q. Who joined you in locating those claims?

A. Mr. Lewis A. Jeffs.

Q. When did you go upon the ground?

A. November 14, 1907.

Q. Who was with you? A. Mr. Jeffs.

Q. Anyone else? A. No, sir.

Q. What did you and Mr. Jeffs do in the way of making mining locations, or lode locations?

A. On November 14th—

Q. What year?

A. 1907, we started in on the outcrop on the Overton lode, just north of the Montpelier Canyon wagon road, and walked northerly along the outcrop by Gertch Hollow, until we came to the north quarter post of section 31, township 12 south of range 45 east. With that point as a basis, we located the discovery of the Overton lode on the outcrop of the phosphate [86] vein. We erected there a substantial post, a cottonwood post, and proceeded to survey our—

Q. Well, wait a moment. Give us a little more in

(Testimony of Morse S. Duffield.)

detail there. Tell us about the post, how it was erected, its size and dimension.

A. The post was a good sized cottonwood.

Q. That don't express anything.

A. About 8 inches in diameter at the butt, and about 6 inches at the top, and about 5 feet long. It was cut right near there upon the ground.

Q. Then, tell us about the post further—what was done with it?

A. Well, we set it up in a mound of rock at its base, right on the outcrop of the vein. Then, after we had measured our claim, we put our location notices—

Q. What was there there in the way of a discovery of mineral?

A. Well, the phosphorite outcropped there; the phosphate rock outcropped at that point.

Q. Was it in place? A. Very much so.

Q. Go ahead.

A. Well, then, we walked north along the outcrop and established the northeast corner of our claim, the Obey claim.

Q. What? A. Obey claim—Obey lode.

Q. What did you do there?

A. We erected here a pine post, a hewn pine post, about 6 or 8 inches at the butt, and about 6 inches at the top, and about 5 feet long, set it firmly in the mound and proceeded from what we call here post No. 2—

Q. Mark it in any way?

A. Marked it—

(Testimony of Morse S. Duffield.)

Q. At that time?

A. —at the time, and blazed it facing the interior of the claim and marked “northeast corner post No. 1 of Obey lode.” [87]

Q. What did you mark it with?

A. A carbon stick, a heavy carbon stick. At the north end center, 300 feet westerly from post 1, we erected the north end center, which was also a hewn pine of good substantial size about 5 or 6 feet at the top—or 6 or 7 feet at the top.

Q. 5 or 6 feet?

A. 5 or 6 inches in diameter at the top, and about 6 or 8 inches at the butt, and set it firmly in the ground.

Q. About how long?

A. About 5 feet long, set it firmly in the ground and marked it “north end center of Obey lode.”

Q. Where was that?

A. On this Exhibit 1, it would be slightly north of a point which would show here.

Q. Where was the mark placed? Which way did it face? A. Faced the interior of the claim.

Q. Any mound or stone there?

A. No; there was not there.

Q. Proceed.

A. From there we proceeded westerly and established out post No. 2, the northwest corner of the Obey lode, which was also a hewn pine, similar to the others. It was cut right near there on the ground.

Q. How long?

A. About 5 feet long, and about 6 inches in diameter at the top, blazed and marked facing the interior

(Testimony of Morse S. Duffield.)

of the claim; marked "Obey lode, post No. 2, north-west corner," with the names of the locators and dates.

Q. With the names of the locators and dates?

A. Yes, sir.

Q. On each corner?

A. Yes, sir; all of them.

Q. Go ahead.

A. And then we came back to the discovery and established our end center, south end center, which was a cottonwood, a crooked cottonwood pole, about 4 inches in [88] diameter, and blazed it and marked it "south end center" facing the discovery. We also—

Q. How long was that?

A. That was about 5 feet long, and we set it in the ground with a base of rocks around the bottom of it. Then, we proceeded southerly along the outcrop, and established the discovery of the Obed lode.

Q. What did you do there in the way of making a discovery?

A. We erected a cottonwood post about 5 feet at the top and about 5 or 6 feet long, and set it firmly in the ground.

Q. What do you mean by 5 feet at the top?

A. 5 inches at the top in diameter. I keep mixing those up.

Q. Go on and describe that post.

A. Set post firmly in the ground with some rocks around the base, right in the outcrop of the phosphate rock. Nailed a can to it and put our notice in the

(Testimony of Morse S. Duffield.)

can, just as we had done in the Obey discovery.

Q. Did you do that in regard to the Obey discovery? A. Yes, sir.

Q. Put up a notice?

A. Put a notice in a can, put it in a tin can and nailed the can up on the post.

Q. What was the length of the post at the Obed?

A. About 5 feet long.

Q. The Obed? A. The Obed.

Q. About 5 feet long?

A. Yes, sir. And then, we established post No. 4 of the Obed, and post 1 of the Obey.

Q. A common corner?

A. A common corner; we established it there. Put a cottonwood post there about 5 feet long, and about 5 inches in diameter; blazed it facing the interior of each of the claims; it lies in two angles, [89] and we marked it "northeast corner of the Obed lode, post No. 4" and the southeast corner of the Obey lode, post No. 1."

Then, we returned to the outcrop of the vein, followed that along, measuring as we went with a 400 foot steel tape, and established the discovery post of the Jimtown lode. This was a cottonwood post about 5 inches in diameter at the top, and about 5 feet long, firmly set in the ground right on the outcrop and to that we nailed a tin can in which we posted the notice of the Jimtown lode, and also blazed it northerly and southerly, marking it the south end center of the Obed lode, and north end center of the Jimtown lode.

Q. And discovery also?

(Testimony of Morse S. Duffield.)

A. We put the notice in a tin can.

Q. The same stake being used for the south end of the Obed and the north end of the Jimtown—

A. For the whole three.

Q. The two end centers?

A. And the discovery of the Jimtown?

Then, we proceeded to measure about 300 feet easterly, and we established there a cottonwood post 5 inches in diameter, and about 5 feet long, blazed it on two angles, angling sides, facing the interior of the Obed and the Jimtown, and marked it post No. 4, the northeast corner of the Jimtown lode, and post No. 1, the southeast corner of the Obed lode, giving the names of locators and date of location.

Then, we returned to the outcrop and proceeded to measure our 1500 feet, establishing the south end center of the Jimtown lode on the outcrop. This was a cottonwood post.

Q. Give the dimensions and all about it.

A. The cottonwood post was about 4 inches in diameter at the top, and about 5 feet [90] long, and was blazed on the north side facing the Jimtown lode claim, and marked "South end center of Jimtown lode," with the names of the locators and dates.

We then proceeded along the outcrop to the point marked on Exhibit 1 as discovery of the Fentress lode. There we erected a post, a pine post that was 5 inches in diameter at the top and about 5 feet long, and blazed and marked "discovery Fentress lode."

Q. Larger at the butt, was it? A. Yes, sir.

Q. Go ahead?

(Testimony of Morse S. Duffield.)

A. Nailed a can to it, and enclosed our discovery or location notice in the can.

Then, we proceeded along the outcrop until we had measured to the end of the Jimtown, and established the south end center of the Fentress—established the south end center of the Fentress with a stone monument, a pile of rocks built up by hand, about 4 feet high. In that we enclosed the notice in a can, calling it the south end center of the Fentress lode.

Then, we proceeded southwesterly along the outcrop of the vein and established the discovery of the Cumberland lode. Here we erected a 4 by 4, 4 feet and 8 inches long and marked it "Discovery of the Cumberland lode" with the names of the locators and dates, and nailed to it a can in which we enclosed our location notice.

From there we proceeded southerly, southwesterly, and established the south end center of the Cumberland lode. This was a large round post about 8 inches in diameter. We blazed it on the south side and marked it "south end center of the Cumberland lode" and north end center of Overton lode."

Q. And facing each of the claims respectively?

A. Naturally, [91] yes, sir. From there we proceeded southerly, establishing the discovery of the Overton lode. Here we used a 4 by 4, 4.8 feet long and erected it firmly in the ground, and marked it "discovery post, Overton lode"; nailed a can to it and placed our notice in the can.

Then, we proceeded southerly, and by the wagon

(Testimony of Morse S. Duffield.)

road erected a pile of rocks 4 feet high, and put a can—a piece of paper in a can, and put the can among the rocks, and called it the south end center monument of the Overton lode, with the names of the locators and date of location.

Then we proceeded to establish a discovery on the Mt. Pleasant lode. Here we used a 4 by 4, 4.8 feet long, and marked it “discovery Mt. Pleasant lode,” with the names of the locators and dates, and nailed a can to it and placed our location notice in the can.

Then, we established the south end center which would be at a point southwesterly from what Exhibit 1 shows here. We established an old fence post there for the south end center of the Mt. Pleasant. The fence post was about 4 inches in diameter; it was not exactly round, but we faced it up on the side facing the interior of the Mt. Pleasant lode, and called it the south end center of the Mt. Pleasant lode.

Q. Did you mark it? A. We marked it.

Q. In what way did you mark it?

A. We wrote on it with our carbon stick. That is all we did that night.

Q. That night?

A. That day. It was about dark then and we went home, went to Montpelier.

The next day, on the 15th of November, we came out from [92] the town.

Q. “We” means whom?

A. Mr. Jeffs and I; and proceeded up what we call Tennessee Gulch, and established the discovery for

(Testimony of Morse S. Duffield.)

the Arkansas lode. For this we used a pine post about 8 inches in diameter, erected it right on the outcrop of the vein. The post was about 5 feet long. We blazed it and marked it "discovery Arkansas lode" and put the names of the locators and date on it, and nailed the can to it, and put our location notice in the can.

Q. How did you support it at the base?

A. With rocks around the bottom, piled some rocks around the bottom.

Q. You did not set it in the ground?

A. Yes, sir; partly in the ground, about 8 inches in the ground and rocks around it; and then we proceeded to make our—continued our trip along the outcrop of the vein, and we measured along the outcrop of the vein, and discovered we had to have an angle in the claim, and we marked the center line of the lode line, with a discovery monument, or with a monument of rocks piled up approximately 4 feet high, and included a paper notice in a can, naming it the center angle monument of the Arkansas lode. And then we measured along the outcrop to complete our claim, and established at the north end center, established the north end center of the Arkansas lode. This was a pine post, hewn on one side, and we wrote on it "Arkansas lode" on the side facing the interior of the claim; wrote on it "Arkansas lode" and gave the names of the locators and the date, and we called it or named it the north *north* center end of the Arkansas lode.

Then, we proceeded to the Hickman lode, and es-

(Testimony of Morse S. Duffield.)

tablished [93] our discovery in the gulch at this point, marked "discovery" on Exhibit 1. Here we used for discovery post a hewn pine post about 5 feet long and about 8 inches in diameter; blazed it and marked it "discovery Hickman lode"; nailed a can to it and placed our location notice in the can.

Then, we proceeded along the outcrop of the Hickman and established the end center at a point—

Q. Which end center?

A. The south end center of the Hickman lode, at a point which I will have to designate upon this to show the point, if you want me to mark it.

Q. Can you describe it without marking it?

A. Well, a point—

Q. How far from the discovery, would you say?

A. I will have to look at the location notice and figure that out. I have forgotten just what that was.

Q. You established what?

A. The south end center of the Hickman lode, which was a cotton-wood post about 5 inches in diameter and which extended about 4 feet above the ground; blazed it and marked it south end center, Hickman lode, and marked it on the blazed side facing the interior of the claim.

Then, we proceeded along the outcrop and established the discovery of the Columbia lode. Here we used a 4 by 4, 4 feet 8" inches long, and marked it "discovery post, Columbia lode"; nailed a can to it and placed our location notice in it. That is all we did that day.

(Testimony of Morse S. Duffield.)

Q. That is on the 15th?

A. And then on the 16th of November—

Q. That ends what you did on the 15th?

A. Yes, sir.

And then on the 16th we returned to the ground and established a 4 by 4, 4 feet 8 inches long at the discovery of the Wayne [94] lode, called it discovery of Wayne lode and marked it discovery post and nailed a can to it, in which we placed our location notice; and erected a stone monument for the north end center of the Wayne in which monument we placed a can with the names of the locators and dates.

Q. What did you make the monument of?

A. Stone and rock, loose rock.

Q. What dimensions?

A. Approximately 4 feet high.

Then, we proceeded southerly along the outcrop and established two angle monuments to mark the side angles, and then we proceeded along the outcrop southerly again and established two more angle monuments, and then we proceeded to the end line where we erected a cottonwood post.

Q. Whereabouts on the end line?

A. At the corners.

Q. At the corners? A. The two corners.

Q. What claim?

A. The Wayne. Blazed them and marked them to designate what they stood for.

Q. State what you did? A. We marked the—

Q. Which one?

(Testimony of Morse S. Duffield.)

A. The southeast corner was marked "Southeast corner, Wayne lode" on the blazing which was facing the interior of the claim, and marked the southwest corner "the southwest corner of the Wayne" on the blazing facing the interior of the claim.

Q. You have given the dimensions of those posts, you think?

A. They were substantial posts, one of them was about 8 inches at the top, and must have been 10 inches at the butt, and they often were about 6 inches at the top in diameter.

Q. How long?

A. Both about 5 feet long. [95]

Then, we did some further surveying on that day—that was all we did that day. That finished on the 15th.

Q. With what kind of instrument were you doing that work? A. Just a Brunton pocket compass.

Q. What did you have to measure with?

A. We had a 400 foot steel tape.

Q. Well, proceed rapidly?

A. Then we returned to the ground upon the 20th of November, and we brought out a lot of 4 by 4's, which we had bought at the lumber-yard in Montpelier, and cut them up into proper lengths for posts, making three posts out of each, and those were distributed along the road.

Q. Cut at even lengths, or how?

A. Cut so as to divide the posts evenly into three posts of 4 feet and 8 inches long. We brought them out and distributed them along the road until we

(Testimony of Morse S. Duffield.)

come to Gertch Hollow; and here we had to pack them up; and for three days—I can't remember exactly each post—we set from the twentieth to twenty-fifth. We surveyed and set posts.

Q. Now, Mr. Duffield, during that period, did you set a corner post for each of the claims set out in the amended complaint and shown on Exhibit 1, that were not previously set?

A. During those days we—

Q. During that time?

A. We completed our survey thoroughly.

Q. I say, did you set corner stakes?

A. Yes, sir; set all the corner stakes that had not been set before.

Q. And all those parts were of the dimensions you have described?

A. No, sir; not all of them. Those on the Overton, Cumberland, Fentress, Jintown, Obed and Obey were. [96]

Q. Hold on— A. Were 4 by 4's.

Q. Well, beginning with the— A. Overton.

Q. Yes; you completed the setting of the corner stakes making the claims all of a uniform size, did you? A. As near as we could measure them.

Q. What size?

A. 600 feet in width and 1500 feet in length along the outcrop.

Q. Did that by measurement?

A. We did that by measurement.

Q. Did you mark the corner posts that you set at that time?

(Testimony of Morse S. Duffield.)

A. Yes, sir; we marked them plainly with a heavy carbon stick.

Q. What kind of marks? What marks did you put on to identify them with the claim?

A. Put on the name of the claim, the corner of the claim that it was, and the names of the locators and the date of the location.

Q. That was done in each instance on that particular group of claims?

A. For this group here. (Indicating.)

Q. How were the markings as to facing the discovery or the interior of the claims?

A. They were all facing the interior of the claims.

Q. Facing the included area?

A. On the Mt. Pleasant—

Q. Wait a moment. As to those stakes; how were they set and supported?

A. They were set in the ground about 6 inches, some of them right alongside of old stakes. The ground had been located before.

Q. Set in the ground and otherwise supported?

A. Sometimes rocks around the base, and sometimes we tacked them to the original stakes.

Q. Tacked them?

A. Nailed them with a long spike, so that [97] they would be as near to the original stakes as possible.

Q. What did you say about a mound of stones around some of them?

A. Wherever it was handy to get rocks to place around them we did.

(Testimony of Morse S. Duffield.)

Q. You could not readily recollect, could you?

A. No, sir; I could not.

Q. Proceed with the rest of them?

A. To complete the staking of the corners of the Mt. Pleasant, Arkansas, Hickman, Columbia and Wayne lodes, we cut pine posts up near the head of Tennessee Gulch and cottonwood posts from a little grove of cottonwoods just east and up the mountain from the Hickman lode, and from these two sources we got all our posts for the Arkansas, Mt. Pleasant, Columbia and Wayne.

Q. What dimensions were those posts? Any uniform dimensions?

A. Well, as the timber would run—we made an attempt to get posts that would—

Q. What did you get?

A. We did get posts that would go 5 or 6 inches at the top in diameter.

Q. Larger at the bottom?

A. Most of them larger at the butt.

Q. And how long? A. 5 or 6 feet long.

Q. Did they all average that?

A. They would all average 5 feet there.

Q. Long? A. Yes, sir.

Q. And in dimensions at least what?

A. In dimensions, at least they would average 6 inches in diameter.

Q. Now, those posts then for those claims last mentioned were set by you and Mr. Jeffs, were they?

A. Yes, sir.

Q. And how were they supported or set?

(Testimony of Morse S. Duffield.)

A. They were— [98] we had a hand pick and dug holes 6 or 8 inches and set the post in the hole, and piled a few rocks around the base to support them and blazed them and marked them.

Q. What did you blaze them with? A. An axe.

Q. And then each post was marked?

A. Each post was marked on the side facing the included area of the claim to which it belonged.

Q. And marked in what manner?

A. With a heavy carbon stick.

Q. What marking?

A. The name of the claims, the name of the locators, and the date, and the corner.

Q. Designating the corner with the number and direction?

A. Both the number and corner, and name of corner.

Q. Now, was any post set other than the four corners of those last mentioned claims?

A. On the Arkansas lode we had to set two angle posts, which we did erect and mark.

Q. How did you ascertain the place to erect those?

A. By measuring from our preliminary monument on the center end line to the angle monument on the side.

Q. Measure how far? Measure 600 feet?

A. 300 feet each way.

Q. Oh, 300 feet each way? A. Yes, sir.

Q. And the posts were set at the angles in the side lines of the Arkansas? A. Yes.

Q. Any other claims have any posts other than the

(Testimony of Morse S. Duffield.)

corner posts which you and Mr. Jeffs set?

A. The Columbia and the Wayne had; the Columbia had four side angle posts, and the Wayne had four side angle posts.

Q. So that in addition to the four corners of the claims on any and all of the claims that had angles in the side lines, posts [99] were there set and marked, were they? A. Yes, sir.

Q. Blazed and marked? A. Yes, sir.

Q. In the way you have described? A. Yes, sir.

Recess until 2 P. M. [100]

Q. Mr. Duffield, have you got the location notices that you posted?

A. I have copies of them that I recorded.

Q. You made copies? A. Yes, sir.

Q. When?

A. At the time that we wrote them out.

Q. Did you compare them with the originals that you made?

A. Yes, sir; compared them with the originals that were posted in the different monuments.

Q. And they are true and correct copies?

A. Yes, sir.

Q. And what did you do with the copies? Did you record them? A. Yes, sir.

Q. Have you them? A. Yes, sir.

Q. Please produce them? (Witness does so and the same were handed to counsel for defendant.)

Mr. BUDGE.—We have no objection to them.

Mr. DEY.—We now offer the location notices in

(Testimony of Morse S. Duffield.)

evidence, separately marked. [101]

* * * * *

Q. Have you been upon the ground since the official survey was made of those lode claims by Mr. C. P. Brooks? A. Yes.

Q. Have you made any examination of those—were you there at the time the survey was made?

A. No, sir.

Q. Have you made any examination for the purpose of determining upon the ground whether or not the posts that you testified as having been set by you and Mr. Jeffs are substantially at the places where the patent posts of the several lode claims, shown on Exhibit "A," are situated? A. Yes, sir.

Q. How did you find them in that respect?

A. Why, a great many of the original posts are no longer there, but identical locality is practically the same.

Q. I am speaking about the locality.

A. The locality is practically the same.

Q. Are there any exceptions, and if so, state what the exceptions are.

A. Well, the Hickman is the only exception.

Q. The Hickman, in what way?

A. The Hickman was originally located as 1500 by 600 feet, a full lode claim, but was found to overlap there a patented placer, so that the part which lapped on the side of the placer was drawn in and is 50 feet.

[127]

Q. The question is where you set the Hickman cor-

(Testimony of Morse S. Duffield.)

ner posts, or center end posts, or other posts?

A. Where did we originally set them?

Q. Yes, sir; if you can make it clear refer to Exhibit 1.

A. Well, practically the point designated by Mr. Pitts as the southeast corner of the Hickman—that is practically the spot at which we located our corner No. 4 originally, corner No. 4 of the Hickman. The spot designated by Mr. Pitts on Exhibit 1 as L. C. Hickman, northeast corner, that is practically the locality at which we established our post No. 1 of the Hickman, the northeast corner.

Q. Well, now take up the southwest and northwest.

A. Well, the southwest—I will have to designate on Exhibit 1 that approximate locality of post No. 3. The original post No. 3 of the Hickman is a point about 600 feet westerly of the point that we designated as the post No. 4 of the Hickman. That would be practically in here.

Q. Is there anything about the locality on the ground to identify it by?

A. Well, it would be very close to the end line of the Maury lode, which is marked on Exhibit 1.

Q. Take up the other one.

A. The other corner would be—

Q. The northwest?

A. The northwest corner post, original post No. 2 of the Hickman lode, as originally located, would be approximately at a point near the end center of the Tennessee, a little westerly of the Tennessee; it would be about a hundred feet westerly of what is marked

(Testimony of Morse S. Duffield.)

on Exhibit 1 as post No. 7 of the Tennessee.

Q. (By Mr. BUDGE.) How far westerly?

A. About a hundred feet [128] as I measured it upon the ground. Shall I designate it?

Q. What do you purpose to mark it?

A. I purpose to mark it "original post No. 2, Hickman lode."

Q. What is the scale of the map?

A. 200 feet to the inch. I have marked it "Original No. 2, Hickman lode."

Q. Any other exceptions?

Mr. BUDGE.—You had better mark the other one too.

Mr. DEY.—The southwest?

Mr. BUDGE.—Yes.

A. I have marked it original No. 3, Hickman lode.

Q. Now, Mr. Duffield, are there any other exceptions that you observed upon the ground in the location of the patent post, as set, and the original post as placed by you?

A. The corner marked on Exhibit 1 as No. 5, the southwest corner of the Arkansas, I think originally on the ground was perhaps a little closer to the gulch, a little further south, about 100 feet further to the south, as I remember it.

Q. Anything else?

A. Well, there was probably a few corners that were originally too wide, that have been drawn in now on this official survey.

Q. Well, I am speaking from your examination that you saw on the ground and the patent post?

(Testimony of Morse S. Duffield.)

A. Well, I can't testify to any more. Those are the only cases that I took notice of at that time.

Q. Outside of those exceptions that you have mentioned, what is your best recollection from your investigations on the ground as to the patent post being substantially in the position of the original post as set by you and Mr. Jeffs?

A. Well, as I went over the outcrop, the posts that I could [129] see, all seemed to be substantial as they were originally located, with a few minor exceptions which I did not measure out.

Q. Was the ground covered by these several lode locations vacant and unoccupied at the time that you and Mr. Jeffs located the ground?

A. The lodes which we located were unoccupied and vacant at the time we located each location.

Q. And was the ground covered by those several lode locations vacant and unoccupied?

A. Yes, sir; the ground was vacant and unoccupied.

Q. I understood you to say that you had in some instances set posts in close proximity to previously set posts? A. Yes, sir; we did.

Q. What were they?

A. Those were old lode locations which were abandoned.

Q. Prior to the time that you—

A. Prior to the time that we located our lodes over there.

Q. Just explain the topography of the country with reference to the lode locations here situated.

(Testimony of Morse S. Duffield.)

A. There is a prominent canyon cutting right through the group of claims here, and marked on Exhibit 1, as Montpelier Canyon Creek. The canyon approximately follows the line of the creek. The wagon road follows the side of the canyon right through the group of claims; and north of the canyon and south of the canyon is a hilly country. The hills south of the canyon are lower and more rolling than the ones north. North of the canyon there is quite a prominent mountain and along the side of Gertch Hollow, dipping westerly underneath the mass of the mountain is exposed the outcrop of the veins of phosphate rock.

Q. Situated in the mountain?

A. Situated in the mountain. [130]

Q. Any range of mountains that it is known as?

A. That is known as the Preuss Range.

Q. In Bear Lake county, Idaho?

A. Bear Lake county, Idaho, yes, sir.

Q. What is the mining there?

A. The mineral is phosphorite, phosphate rock.

Q. Now, what indications of the existence of a lode or vein was there developed at the time you made those locations?

A. There was a prominent outcrop of phosphorite, which could be easily traced, easily distinguished from the walls on account of its black color, and which at numerous places showed in place between the footwall and the hanging-wall, very easily traceable from one end of the map to the other.

Q. Well, easily traceable in reference to the claims

(Testimony of Morse S. Duffield.)

you located, is what I want to know.

A. Well, those claims were located right along that outcrop which was everywhere locateable, everywhere discernible in most places over the greatest extent by the actual outcrop and places where it was slightly buried, why, you could trace the hanging-wall or footwall of it.

Q. Now, you say it is easily traceable by what? In what manner? Inspecting them?

A. Yes; by visual inspection.

Q. In what manner? Make it clear.

A. Well, you could see the phosphate rock, see float and the outcropping rock in place continuously along the zone of the outcrop.

Q. And does this rock differ from the country rock? A. It is dark and heavy.

Q. Well, how was the country rock?

A. The country rock is a chert, which is easily recognized as the hanging-wall, and the [131] lime, the white lime, that is easily recognized as the footwall.

Q. So it is readily distinguishable and traceable throughout the entire length of these lode claims, is it? A. Yes, sir.

Q. And in each instance was the discovery placed at the outcrop? A. Yes, sir; in every instance.

Q. What work was done, if any, to develop this vein or lode in place?

A. Enough work was done on each claim to comply with the—

Q. I will ask you what work was done on those claims?

(Testimony of Morse S. Duffield.)

A. Well, the work—I will have to tell you as to each claim; they were not all the same.

Q. Very good? A. Beginning on the Obey—

Q. Now, starting in—first, when was it done?

A. Well, the work was done between November 26 and December 9.

Q. Of what year? A. 1907.

Q. Who by?

A. By myself and Mr. Jeffs and Mr. Lemuel Colbach and Mr. Joe Moss.

Q. Now, starting in with some one claim and tell us where the work was done and what it consisted of?

A. The work on the Obey claim was done right close to the discovery, close to the discovery monument, within a very few feet of it, and consisted of an open cut which exposed the vein 10 feet below the lower rim of the outcrop of the vein, and comprised 240 cubic feet of excavation.

Q. Now, did it expose the vein or lode in place?

A. Yes, sir.

The work on the Obed was an open cut by the side of the mountain on the outcrop of the vein, exposing a vein at a depth of 10 feet below the lowest rim of the outcrop of the vein, [132] comprising 240 cubic feet of work, showing the vein in place.

The work on the Jimtown was done next to the discovery, and consisted of an open cut, 240 cubic feet taken out, and exposed a vein at a depth of 10 feet below the lowest outcrop of the vein.

Q. In place? A. In place.

The location work on the Fentress was partly an

(Testimony of Morse S. Duffield.)

open cut and partly an incline shaft exposing the—

Q. Tell us what part, and all about it?

A. Well, I don't remember the exact dimensions, but it exposed the vein 10 feet below the lowest rim of the outcrop of the vein and comprised 240 cubic feet of work, and exposed the vein in place.

Q. Well, where was it located?

A. At the discovery.

Q. Are they marked on the map so that you can see the proper places?

A. The discovery or the mark?

Q. No; the work?

A. Mr. Pitts said—he gave some figures or numbers, anyway, which would identify it, that is, he numbered the location posts as No. 1 and so forth, and the discoveries were marked “discovery.” In both of these places the work on the Jimtown lode was close to the discovery lying practically right at the discovery over under the post, or to one side of it.

Q. The vein was exposed to a depth of 10 feet in place, was it? A. Yes, sir.

Q. Proceed?

A. The work on the Cumberland lode was done at discovery by an open cut—I made a mistake as to the Fentress. The Fentress was entirely an open cut, and I want to correct it.

Q. You can correct it right now?

A. The location work of [133] the Fentress was done at the discovery, and was an open cut exposing the vein 10 feet below the outcrop of the vein, comprising 240 cubic feet.

(Testimony of Morse S. Duffield.)

The location work of the Cumberland was done approximately at the discovery and was an open cut and partly an incline and exposed that vein at a depth of at least 10 feet below the lowest outcrop of the vein, and comprised at least 240 feet of excavation.

The location work of the Overton was done at the discovery and was an incline shaft partly, and partly an open cut, disclosing the vein at a depth of at least 10 feet below the lowest outcrop of the vein.

Q. It showed the vein rock in place?

A. Showed the vein in place, and comprised at least 240 cubic feet of excavation.

The location work of the Mt. Pleasant was done at the discovery and was an open cut and exposed the vein at a depth of 10 feet below the outcrop of the lowest portion of the vein, and comprised 240 cubic feet, and showed the vein in place.

The location work for the Arkansas was done at the discovery, and was an open cut, comprised 240 cubic feet of work, and exposed the vein at a depth of 10 feet below the lowest outcrop of the vein.

The location work for the Hickman, an open cut done at the discovery, and comprised 240 cubic feet of excavation, and exposed the vein at a depth of 10 feet below the lowest outcrop of the vein, and exposed the vein in place.

The discovery of the Columbia, the location work of the Columbia was done at the discovery of the Columbia, and was an [134] open cut, comprising 240 cubic feet of excavation, and exposed the vein at a 10 foot depth measured on the vein below the lowest

(Testimony of Morse S. Duffield.)

outcrop of the vein.

The location work on the Wayne was done at the discovery approximately, and comprised 240 cubic feet of work, and it exposed the vein at a depth of 10 feet below the lowest rim of the outcrop of the vein.

Q. In place? A. In place.

Q. You have given them all now? A. Yes.

Q. Was there any mining district there at the time you located those claims there?

A. It was an unorganized mining district at that time.

Q. I say, was there a mining district?

A. There was no mining district there at that time.

Q. What do you mean by unorganized—I asked you if there was an organized mining district?

A. No; there was not an organized mining district.

Q. There has been since, has there?

A. I don't know of any having been formed since.

Q. By the way, after you had originally set the posts in November, 1907, was anything further done about the posts after that, and during the year 1908, by you? A. Yes, sir.

Q. What did you do? A. We had placed—

Q. What did you do?

A. We placed new location notices in many of the monuments from which the location notices had disappeared.

Q. In other words, did you place new location notices in all places where— A. No. [135]

Q. Where they were gone?

A. In all places where they were gone, we placed new ones.

(Testimony of Morse S. Duffield.)

Q. Were they copies of the ones that had been placed there originally?

A. They were copies of the recorded notices, and we also during 1908, had to renew many of the stakes.

Q. Who did that work?

A. I did part of it and Mr. Colbath, Mr. Moss, the persons doing our assessment work helped, and we had to renew a good many stakes.

Q. Did you supervise the renewal of the stakes?

A. Only partly.

Q. What do you know as to whether they were all renewed that were down in 1908?

A. Well, I know—I don't know whether they were all renewed; I have to take the word of some of the men that we employed for part of it.

Q. And then, we will have to go into detail if there is any question about it. What ones? Do you know?

A. Well, I do know that we renewed the southwest and southeast of the Overton.

Q. Well, that was the Overton?

A. The Overton.

Q. Well, give the rest, and cut it short, if you can?

A. Well, you can't cut it short; it is so long, and there are so many of them, but I renewed post No. 1 of the Overton, which the creek had undermined, and they had to set it up on the bank of the creek, and we renewed post No. 4 of the Cumberland, and post No. 1 of the Fentress, as marked on Exhibit 1. We renewed 3 and 4 as marked on Exhibit 1, of the Fentress lode; we renewed the discoveries of the

(Testimony of Morse S. Duffield.)

Obed and the Jimtown, that is post No. 1 of the Obed and post No. 4 of the Jimtown. Those were the ones that I personally superintended the renewal of.
[136]

Q. Well, do you know of your own knowledge whether they were all renewed that were down in this group of lode claims?

A. Why, there were a few I did not go to, but I went to a good many of them.

Q. Well, on any of the claims do you know and can you give us the names of the claims?

A. Well, I don't know about all on the Wayne nor all on the Columbia, I knew about some on the Columbia.

Q. Is that all?

A. I don't know about all on the Arkansas. Those are the only ones I don't know all about it.

Q. For the Wayne, Columbia and Arkansas, of your knowledge, you know that the stakes were renewed in the year 1908, that had fallen down and disappeared? A. Yes, sir; I do.

Q. And were they set in the same place that they had been originally set by you?

A. Yes, sir; approximately.

Q. And as to the character of the stakes, how were they as compared with the former stakes?

A. In some cases we found the old stakes had been carried away or washed away, and reset them, and wherever a new stake was needed, we used a 4 by 4.

Q. How long? A. 4 feet and 8 inches.

Q. And marked how?

(Testimony of Morse S. Duffield.)

A. Properly marked, marked for the claim that it was intended for.

Q. Facing the claim?

A. Always facing the claim.

Q. Now, the Columbia you know in particular about, you say? A. Yes.

Q. To what extent and what corners?

A. The corners that are marked on Exhibit 1 as 1 and 8.

Q. Now, in 1909, was there anything in the way of renewing [137] the stakes that were gone?

A. Yes, sir.

Q. Who did the work? A. Mr. Hoff.

Q. You did not?

A. No, sir; I did not.

Q. Did you see it done afterwards?

O. I saw on one visit; I saw that some of the posts were missing and instructed Mr. Hoff to renew them.

Q. You were not there afterwards to know whether it had been done or not? A. No, sir; I was not.

Q. Now, who performed the annual labor for the claims for the year 1908?

A. Mr. Wilcox, Mr. George E. Wilcox, and I forget the name of the other Wilcox, and Mr. Samson.

Q. The two Wilcox's? A. Two Wilcox's.

Q. And Mr. Samson?

A. Samson and Colbath and Mr. Moss, and there was another man with the Wilcox's, but I have forgotten his name just now.

Q. Do you know where the work was done for 1908? A. Yes, sir.

(Testimony of Morse S. Duffield.)

Q. When ?

A. The annual work for 1908 for the Cumberland, Fentress, Jimtown, Obed and Obey, was done partly in tunnel 24, so marked on Exhibit 1—no; not 24—21, and the balance in tunnel No. 17. I am not exactly sure about 21, whether it was done in 1909 or 1908.
[138]

Q. Was proof of annual labor made for 1908 ?

A. Yes, sir; I have the affidavits.

Q. Please produce them. A. For those claims ?

Q. Produce all of your 1908 proofs, and I will have them marked as exhibits for identification. [139]

* * * * *

Mr. DEY.—You may cross-examine.

Cross-examination.

(By Mr. BUDGE.)

Q. Mr. Duffield, when did you first become interested in phosphate or lime phosphate deposits ?

A. About 1902.

Q. Where ? A. Tennessee.

Q. And in what portion of Tennessee, Mr. Duffield ? A. Mt. Pleasant.

Q. Mt. Pleasant. Is that the eastern portion or western portion ? A. Well—

Q. Or the central ?

A. That is about the central portion.

Q. About the central portion. What form of phosphate deposits were they ? A. There ?

Q. Yes. A. They were covered by alluvium.

Q. Well, was it—were they what are known as

(Testimony of Morse S. Duffield.)

pebble deposits? A. No; it was rock.

Q. Rock phosphate? A. Rock phosphate.

Q. And to what extent were you interested in those deposits?

A. Oh, I was not financially interested in them at all. I was interested in studying the subject of phosphates.

Q. Studying the subject of phosphates?

A. Yes, sir.

Q. How long, or during what period of time were you engaged in the study of that field?

A. Why, about 6 or 8 months, off and on. [165]

Q. Do you, or did you have anything to do with the entering of claims, or the locating of claims?

A. It was all patented land there; all deeded land, farming land.

Q. All deeded land. How were the claims acquired there?

A. They were not claims at all; you would just buy a farm and take the phosphate that was under it.

Q. Simply bought it by the acre, as you would buy any other land? A. Yes, sir.

Q. Describe to us, Mr. Duffield, the nature of that deposit there in Tennessee.

A. Well, as I remember it, it was—the phosphate deposit itself was overlain by clay and alluvium, and the phosphate deposit itself was limestone that was disjointed and decomposed, evidently carbonate of lime leached out. It rested upon a solid rock in place as I remember it.

Q. How deep was the overlying deposit above the phosphate?

(Testimony of Morse S. Duffield.)

A. It varies all the way from a few feet up to twenty or thirty feet, according to the topography, as I remember it.

Q. How deep or how thick was the deposit of the phosphate? A. From 4 to 8 feet.

Q. And the underlying stone was what?

A. I don't remember now what it was.

Q. Did you study the formation there?

A. No, sir; I did not study the formation particularly then.

Q. You were not studying the formation of the fields? A. No, sir.

Q. What did you concern yourself with when you were making this investigation?

A. The business of mining the rock, or the phosphate business. [166]

Q. Simply the business of taking it out and marketing it? A. The marketing conditions.

Q. Did you have to do with the mining of this rock?

A. No.

Q. Not at all? A. No; not at all.

Q. And did you ever make any investigation of the ground as to the extent of this deposit? A. No.

Q. No investigation whatever? A. None.

Q. You have been upon the ground, have you?

A. Where? In Tennessee?

Q. Yes.

A. Yes, sir; visited a good many of the mines.

Q. And been in them? A. I have been in them.

Q. And how do they mine it, Mr. Duffield?

A. By stripping off the overburden of alluvium

(Testimony of Morse S. Duffield.)

and then mining the phosphate rock as it is exposed.

Q. In what way did they mine it?

A. It is decomposed and disjointed and they mine it with a pick and shovel.

Q. A pick and shovel?

A. Sometimes they blast to facilitate matters.

Q. And it is different in some places from what it is in others as to being hard or solid?

A. Why, I understand there are parts of Tennessee where it is hard.

Q. Well, in this particular field where you were interested, in the study of this subject?

A. Well, the differences were slight; it was mostly decomposed and disjointed limestone.

Q. Hard enough in some places, however, for blasting?

A. Hard enough so that blasting would be economical.

Q. And would have been the cheaper way to mine it? A. Yes, sir. [167]

Q. In what position was this bed of phosphate? How did it occur?

A. Well, slight dip from a horizontal.

Q. Do you know what the dip was?

Mr. DEY.—I would like to interpose an objection to this as not proper cross-examination and is immaterial and irrelevant to any issue in the case.

Q. Do you remember that?

A. I think the greatest dip that I saw there was about 15 degrees.

Mr. DEY.—I understand that this objection may

(Testimony of Morse S. Duffield.)

extend to all of this class of testimony without repeating it?

Mr. BUDGE.—Yes.

Q. Now, in this deposit in Tennessee, was it all one deposit of phosphate of lime, or was it cut up into different strata of different kinds of materials, different kinds of rock?

A. I don't remember now—that is, the details.

Q. Haven't any recollection about it? A. No.

Q. You don't know whether a clear bed of phosphate of lime, or not?

A. No, sir. It is so long ago, I would not say.

Q. You don't know *whether any* chert there?

A. I don't remember anything about that.

Q. Do you know anything concerning the analysis of that phosphate deposit there in Tennessee?

A. I don't remember anything accurately. I have read the Government report on it. That is all.

Q. But from your own investigations?

A. No, sir.

Q. You did not study that particularly?

A. No, sir.

Q. You did not study the mining of it, except to see it mined in a [168] few instances?

A. I studied the general method of mining there.

Q. How is that?

A. I looked into the general methods of mining.

Q. Just as you observed it?

A. As I observed it.

Q. Not to make any special study of it? A. No.

Q. And you say that you have no recollection at

(Testimony of Morse S. Duffield.)

all as to the underlying deposit below of phosphate?

A. No, sir; I don't remember that at all.

Q. Where was your next experience with phosphates? A. Montpelier Canyon.

Q. Is that on these claims, concerning which you have testified? A. Yes, sir.

Q. That is the next experience you had with this particular substance after leaving Tennessee?

A. Yes, sir.

Q. Now, where did you obtain your information as to this particular deposit near Montpelier where these claims are situated?

A. From an article in the Engineering and Mining Journal.

Q. By whom? A. Mr. C. C. Jones.

Q. And what led you to go to this locality to make this investigation?

A. I wanted to become interested in the ownership of phosphate land.

Q. The ownership of phosphate lands?

A. Yes, sir.

Q. Have you an acquaintance with Mr. Jones?

A. I met him once or twice in Salt Lake City here.

Q. Did you meet him prior to going up to Montpelier at the time of which you testified?

A. I met him in 1904, I think it was. [169]

Q. 1904. That was about three years prior to the locations? A. The first time I saw him.

Q. Did you get any information from him then as to these deposits? A. Why, nothing especially.

Q. Well, did you get any information?

(Testimony of Morse S. Duffield.)

A. Why, yes; he told me about his claims up there.

Q. He told you that he had located there, did he?

A. Yes, sir; he told me he had located claims there.

Q. Did he tell you what kind of claims they were whether lode or placer?

A. I don't think he went into the details at all.

Q. You don't remember whether or not he made any statements to you as to the nature of his claims?

A. No; he never told me.

Q. But he described the phosphate to you?

A. He described it in that article.

Q. Didn't he describe it to you when you talked to him? A. No; he did not.

Q. He said no more to you except to mention the fact he had some phosphate claims near Montpelier?

A. That is about all.

Q. Did you ever meet him after that?

A. I don't think I have ever met him since then.

Q. Not since then at all?

A. I am pretty sure I have not.

Q. Now, when you went up there, Mr. Duffield, who was with you? A. When I went up there when?

Q. To make these locations concerning which you have testified? A. Mr. Jeffs.

Q. Is he the only one?

A. He is the only one. [170]

Q And where did you say that you began the locating or the establishment of the discovery points and corners?

A. I began on the Obey lode claim, marked on exhibit 1.

(Testimony of Morse S. Duffield.)

Q. That is your northernmost claim?

A. Yes, sir.

Q. Now, when you were up there in that country, did you discover any posts of other claims?

A. I found old lode location posts.

Q. Old lode location posts? A. Yes, sir.

Q. Did you have any knowledge as to whose claims they were? A. Yes, sir.

Q. And what knowledge did you have?

A. All the knowledge I could get from the county records at Paris.

Q. And whose claims were they?

A. Those were C. C. Jones' claims. I think there were some claims here owned by Glenn and somebody.

Q. Glenn and Brennan?

A. Brennan and some of them—but I forget that just now.

Q. You mean the claim, Mr. Duffield, that was taken up, the claim or claims taken up by Glenn and Brennan as coal claims?

A. No, sir; they were recorded as lode claims as I remember it originally in the record.

Q. Are you sure on that?

A. Yes, sir; pretty sure of that.

Q. Now, did you find—did you see any map at any time of those locations, these old lode locations, before you went up there to locate? A. Yes.

Q. And whose maps?

A. One I made from the records.

Q. One you made from the records?

A. Yes, sir. [171]

(Testimony of Morse S. Duffield.)

Q. Did you ever see any other map? A. No.

Q. You did not see any in Salt Lake? A. No.

Q. And that was the only map that you saw?

A. I went and spent quite a while at the records there and made my own maps of the whole—

Q. Now, when you made your own maps from that record that you got there at Paris, did you make your locations then in conformity with that map?

A. Practically.

Q. Practically? A. Yes, sir.

Q. And in establishing these corners to the various claims, as you have testified, you stated, I believe, that in a number of instances you found old posts. Is that correct? A. Yes, sir.

Q. And that you nailed your corner posts to those in some instances. Is that correct?

A. Some instances, and in order to make the discovery posts exactly join with the original discovery posts I would spike it in without setting in the ground.

Q. Didn't you spike some corners that way?

A. I don't remember any corners now; there might have been one or two.

Q. Haven't any recollection about that?

A. I think there were.

Q. How was that?

A. I think there were one or two on the Overton and Cumberland.

Q. Can you tell us which corner?

A. The corner marked on Exhibit 1 as "1 of the Cumberland" and "1 of the Overton lode."

(Testimony of Morse S. Duffield.)

Q. That is 1 of both of them? A. Yes, sir.

Q. Of the Overton and the Cumberland?

A. A common corner.

Q. A common corner. Any others?

A. There is an old [172] post upon that and a new post set right alongside to it.

Q. Nailed to it?

A. I don't remember the nailing exactly.

Q. Any other one?

A. This one, number 2, 2 of the Cumberland and 4 of the Overton.

Q. Any others?

A. No; I don't remember any others.

Q. It was in 1907, three years and a half or a little more than three years and a half ago when you made these locations? A. Yes, sir.

Q. Can you remember the particular kind of posts that you placed at each one of the discovery points and at these corners?

A. I have a pretty good memory of them because I was very careful at the time.

Q. Did you take any note? A. No.

Q. Do you remember the particular kind of posts that were placed at each particular corner on these various claims?

A. I can remember it pretty accurately, I think. I can explain to you how I am enabled to remember it.

Q. All right, I would like that.

A. There is a patch of pine timber up in there at which we cut the posts—

Q. Up in where?

(Testimony of Morse S. Duffield.)

A. Immediately north of the bed, right on the north end of the Obey lode and just below the discovery of the Obey and Obed, there is a bunch of cottonwoods from which we cut posts, and just above the Hickman, a patch of cottonwoods where we could get posts, just up the mountain east of the Hickman where there is a grove of cottonwoods and where we cut posts, and up at the head of Tennessee gulch, which would be east of the Arkansas and Hickman, there is quite a patch of [173] pine timber, where we cut a lot of posts.

Q. East or west? A. East.

Q. A patch of pine timber?

A. Yes, sir. Now, the rest of the posts were those we bought at the lumber yard. I remember them pretty well.

Q. So the fact that you saw patches of pine timber, does that enable you to state what *kind posts* that you placed at the southeast corner of the Arkansas lode, for example? A. Yes.

Q. Does it enable you to tell what kind, or to remember distinctly cutting that post—well, do you remember the southwest corner?

A. Yes, sir; I remember that.

Q. Particularly from the fact that there was a patch of pine below?

A. That I went in over there and cut a post to do it with.

Q. At that particular corner?

A. At those two corners.

(Testimony of Morse S. Duffield.)

Q. Do you remember that was not for the Hickman corner?

A. I also cut some for the Hickman there too.

Q. Right at that same time?

A. Well, I think I cut cottonwoods for some of the Hickman corners there.

Q. You cut cottonwoods for some of the Hickman corners? A. Yes, sir.

Q. Now, does the fact that there was pine timber along the edge of these claims, or quaking-asps enable you to tell specifically which particular kind of posts were placed at each particular corner?

A. It assists my memory very greatly.

Q. And you always selected posts, did you, from about 5 inches in diameter at the top?

A. I selected posts that would be good measure, anywhere from 5 to 8 inches at the top and 5 to 10 inches. [174]

Q. At the butt. Is that correct?

A. Yes, sir; some were 10.

Q. That is correct, is it? A. That is correct.

Q. You have in mind now for all of these eleven claims the particular kind of posts that you placed at each particular corner and at the discoveries?

A. No; I am not going that far.

Q. Didn't you testify so on direct examination as to the particular kind of posts you placed at each particular place?

A. Of the eleven claims, yes, sir; I was thinking of the Maury and the Tennessee. Yes; I have a pretty good memory there.

(Testimony of Morse S. Duffield.)

Q. Do you remember particularly and specifically each corner and the particular kind of a post that was placed there on all these eleven claims?

A. Pretty certainly.

Q. From locating them three years and a half ago?

A. Yes, sir; and going there constantly since.

Q. They have been changed since, some of them?

A. Yes, sir.

Q. And not the same kind that you placed there in the first place? A. Yes, sir.

Q. So that you would not know it from having seen it since?

A. I would know what ones were changed pretty well.

Q. Even if you went there and you could not find it? A. Yes, sir.

Q. Now, when did you put those posts there in 1907? How long was it before you went up there to examine the posts at the various corners, how long afterwards?

A. January 6, 1908, I started to do some assessment work, but abandoned that on [175] account of the snow and at that time we checked over some of our corners, which already at that early date had been destroyed.

Q. Well, after that, when did you make any other effort to examine those posts and corners and so on, during the year 1908?

A. Why, I went over the ground several times in 1908, but I don't remember as I paid especial attention to the posts.

(Testimony of Morse S. Duffield.)

Q. In other words, you did not make any changes, or re-establish any posts during 1908 that you remember of? A. Oh, yes, in 1908, I did.

Q. When? What time of year?

A. In November.

Q. You are sure that was in November?

A. Well, it is about the time we began the assessment work, and while we were doing the assessment work.

Q. To the best of your recollection it is in November?

A. It was in November; it may have been an earlier date, but I know that we did look over some in November. I won't say that was the only time of the year, though.

Q. Did you ever at any time before that?

A. Well, I don't remember; I made two or three trips there but I don't remember just what attention I paid to the posts earlier than that, but I know that in November I paid especial attention to them.

Q. You haven't any recollection now that you ever re-established any corners prior to November?

A. Well, as I tell you in January we established them.

Q. I mean after January? A. No.

Q. Between January and November?

A. I don't recollect of any now, at our first visit.

Q. When you were staking these claims out, did you see any other [176] posts of any placer claims there on that ground?

A. I saw one post on the Waterloo placer.

(Testimony of Morse S. Duffield.)

Q. Is that the only post?

A. I think I found—I think I found a post that would be a common post of the Inman, Winfield and Colcock placer, approximately at the north center corner of section 31. I think those were the only two placer posts I ever saw.

Q. Didn't you see any placer post at the northwest corner of the Waterloo?

A. Yes, sir; that is the one I saw, the one I mentioned.

Q. That is the one you mentioned? A. Yes, sir.

Q. Did you see any down at the northeast corner of the Waterloo?

A. There were a lot of old 2 by 4's in the snow lying there. That might have been posts.

Q. Lying there?

A. Yes, sir; but no marks on them.

Q. Did you see any at the northeast corner of the Winslow? A. No.

Q. Did not see any there?

A. I made an effort once to find one there but I never could.

Q. When did you make that effort?

A. I made that effort in—while we were surveying the claims, or staking out the claims.

Q. What made you make an investigation to find out whether a post was there?

A. I wanted to find that corner. There is a correction in that township line and I wanted to find that.

Q. Didn't you find any corner at the center of sec-

(Testimony of Morse S. Duffield.)

tion 31? A. No.

Q. Did you look for any?

A. No; I did not look for any there.

Q. But you saw this common corner of the Inman, Colcock and [177] Winfield, you say at the time?

A. I saw at the point marked on this exhibit as a common corner of that, I found a placer post marked "Colcock"; it was not marked Inman and it was not marked Winfield.

Q. You are sure of that?

A. I could not distinguish it. All I could distinguish on it was Colcock.

Q. You have a distinct recollection, however, that it did have on it "Colcock"?

A. Yes, sir. That is the way I recollect it.

Q. Do you know what was on the other post at the Waterloo?

A. The letters "loo" is all we could ever distinguish upon that, made with a blue pencil.

Q. Now, before you made any locations here on this ground did Mr. Colbath and some others of your men do any work along this deposit?

A. Before I made a location?

Q. Yes. A. No.

Q. Before you made any survey, before you made your location? A. No.

Q. Did they do any work before you filed your notices? A. Certainly.

Q. And do you remember about the time that you were making this survey of a conversation you had in Montpelier with Mr. Ferrier, W. F. Ferrier?

(Testimony of Morse S. Duffield.)

A. I remember a conversation with Mr. Ferrier.

Q. And who was present at the time?

A. Why, Mr. Taylor and Mr. Sullivan, but that was not at the time at which your question implies it was.

Q. At the time you made this survey, was it not?

A. No, sir; it was— [178]

Q. When was it?

A. It was in December, I think December 6th.

Q. December 6th, 1908? A. No; 1907.

Q. Was it not November 6?

A. No, sir; we hadn't located the claim then.

Q. I understand, but was it not before you located the claims you had this talk with him?

A. With Mr. Ferrier? I never heard of Mr. Ferrier before December 6th.

Q. How do you fix that date?

A. From my expense account.

Q. From your expense account? A. Yes, sir.

Q. What does that have to do with your expense account?

A. Well, I was able to locate it that way, because I paid off one of my men just three days after that.

Q. And does that fix in your mind when you had the talk with Mr. Ferrier?

A. Yes, sir; that is the time.

Q. Well, this talk was on December 6, was it?

A. Yes, sir.

Q. And what was that conversation?

A. It was an argument on the lode and placer.

Q. What did Mr. Ferrier tell you?

(Testimony of Morse S. Duffield.)

A. Mr. Ferrier said that he had written a report for the United States Geological Survey and had settled the question that they were placers.

Q. What else did he tell you?

A. That is all I remember of him telling me.

Q. Didn't he tell you that the San Francisco Chemical Company claimed this ground here, over which you were attempting to make locations?

A. I don't remember of his telling me that.

Q. You have no recollection of that?

A. No, sir. [179]

Q. Would you say that he did not tell you that?

A. I am pretty sure—yes; I will say he did not tell me that.

Q. Will you say he did not tell you in substance and effect that the company claimed this ground upon which you were attempting to make locations and forbade you to make any locations or do any work there?

A. He did not say anything about locations; no, sir.

Q. Or to go upon the property?

A. He never said anything like that.

Q. Never said anything like that at all? A. No.

Q. Where was this conversation?

A. As I remember it I was in a buggy right in the middle of the road.

Q. Right in front of the office of the San Francisco Chemical Company, was it not? A. Yes, sir.

Q. And didn't you tell him on that occasion that you were going to locate it as lodes, it had not been

(Testimony of Morse S. Duffield.)

settled and you proposed to locate anyhow, even if they did claim it?

A. I don't remember any such conversation as that.

Q. Would you say that you did not say that?

A. Yes, sir; I would say that I did not.

Q. Now, did you have any conversation with Mr. Sullivan about the 6th day of January, 1908, up in Montpelier Canyon? A. Yes.

Q. What was that conversation?

A. Mr. Sullivan asked us if we were going to contest his placer claims on the ground that they had not done—

Q. On the ground that the San Francisco Chemical Company had not done the annual work upon the placers?

A. We told [180] him no; we had had lode locations and would confine ours to rock in place.

Q. Is that all you said?

A. That is about all I remember. There was more said. That was the meaning of what was said.

Q. Didn't Mr. Sullivan tell you that the San Francisco Chemical Company claimed this ground upon which you had been making locations as lode claims and notified you that you were trespassing upon ground claimed by the San Francisco Chemical Company?

A. No; he never notified us about that at all.

Q. He didn't say that in substance or effect?

A. No.

Q. And didn't he tell you that you must desist

(Testimony of Morse S. Duffield.)

from further trespassing and from working and performing any work upon that ground?

A. No; he did not say anything like that. We kept right on there and we left our tents for months.

Q. He did not say that in either substance or effect? A. No, sir.

Q. Did not Mr. Sullivan tell you on that occasion that the matter of the lode placer had been threshed out in the Waterloo case and that you had no right there to attempt to make lode locations?

A. He said something about the placer and lode question being settled.

Q. Didn't he tell you what I have stated?

A. No, sir.

Q. In substance or in effect? A. No, sir.

Q. And didn't you say in reply that it was not a case for the Land Department to decide but a case for the courts to decide and you proposed to have the courts decide it? [181]

A. I talked that way on the question of lodes and placers, that it was a question for the courts.

Q. That is what I am asking you. Didn't you tell Sullivan that on this occasion? A. Yes, sir.

Q. And you told him on that occasion that you proposed to go ahead with your lode locations notwithstanding his objections?

A. He had no objection. He was tickled to death to think that we were not going to contest his placers with other placer locations on the ground, they had not done the annual work.

Q. He was glad? A. Yes; he was.

(Testimony of Morse S. Duffield.)

Q. He was glad to have you with him up there in that locality?

A. He thought our lodes were worthless.

Q. He was glad that you made them?

A. Glad we made them lodes in stead of placers.

Q. Didn't you on the occasion which I have referred, when you talked to Mr. Ferrier in the presence of Mr. Sullivan and Mr. Taylor down in the street, didn't you ask why your men had been forbidden to work on those claims and had been ordered off? A. No; I asked no such question.

Q. You asked no such question. You did not ask— A. My men had not been ordered off.

Q. Didn't you come down town and on that occasion ask if he was not the sheriff?

A. Yes; I asked if he was the sheriff.

Q. You were very much excited at that time?

A. I?

Q. Yes; you. A. No.

Q. Never get excited? A. No. [182]

Q. You were angry and proposed to find the sheriff and find out whether you could stay upon this ground? A. No.

Q. Don't have any recollection of that either?

A. I was not angry.

Q. Haven't any recollection of that? A. No, sir.

Q. What did you want the sheriff there for?

A. I wanted to know where he was.

Q. Just as a matter of general information?

A. General information, is all.

Q. Did you know at that time that your men had

(Testimony of Morse S. Duffield.)

been ordered off?

A. Mr. Colbath and another man, they had had a little conversation with somebody up on the Mt. Pleasant lode.

Q. You knew that, didn't you?

A. That is all I knew.

Q. That is what brought you down town, was it not?

A. No. I just went out to visit the camp that day and I was coming in anyhow.

Q. Coming in any how. Did they tell you he had ordered them off? A. Yes, sir.

Q. And who did they tell you had ordered them off?

A. They said Mr. Taylor had ordered them off.

Q. Ordered them off?

A. I think it was Taylor; it might have been Sullivan.

Q. One or the other?

A. One or the other. That was on the Mt. Pleasant.

Q. You knew at that time and from that time, that this ground was claimed by placer locations, didn't you? A. I knew that all along, all the time.

Q. You knew that before you ever went upon the ground at all, didn't you, Mr. Duffield?

A. Yes, sir. [183]

Q. You had always had the knowledge that all this land was covered by the placer locations of the San Francisco Chemical Company, that is, the placer locations which afterwards had been conveyed to

(Testimony of Morse S. Duffield.)

the company? A. Yes, sir.

Q. And after you made your map from the location notices, and in accordance with which you made your locations of those lode claims you understood then the manner in which your lode claims conflicted with the placer claims, didn't you?

A. I understood it thoroughly.

Q. Thoroughly? A. Yes, sir.

Q. And you understood at that time that the San Francisco Chemical Company was doing this work on the claims and had been doing assessment work, both from the records and proofs made of labor, and also from your observations of the work that had been done?

A. No, sir; I don't remember that I felt so sure that they had done their work on all their placers.

Q. On all the placers. Well, what placers hadn't they done work upon?

A. None of those north of the canyon.

Q. None of them north of the canyon. Were there any affidavits on file?

A. No affidavits on file for 1907.

Q. For 1907? A. Yes.

Q. There were none, you say? A. No.

Q. When? A. If I remember rightly—

Q. At what time?

A. That is when—the time we located them.

Q. You mean in November, 1907? A. Yes, sir.

Q. There were no affidavits on file for that year?

A. I don't remember, but that is my recollection. The records [184] will show.

(Testimony of Morse S. Duffield.)

Q. There was plenty of time to file them after that, wasn't there?

A. Yes, sir; if they had done it.

Q. You did not examine the records after that?

A. I am not sure that they did the work in 1906 either.

Q. You are not sure that they did not either, are you?

A. No. Your question would make me sure that they did.

Q. What?

A. Your question implies I am sure that they did.

Q. I understood you to say that you made an examination of the records over there concerning this property?

A. Yes, sir.

Q. And concerning this entire country, didn't you?

A. What do you mean by the entire country?

Q. Between your Obey lode and the Wayne lodes?

A. Yes, sir; I examined those records.

Q. Yes. From those records. And you made inquiry and investigation not only as to the manner of the location but the manner that the country had been located in which it had been located, and also as to the proofs of labor, didn't you?

A. I did not look up the proofs of labor especially.

Q. Oh, you didn't? You didn't look them up especially. And then you haven't any recollection as to whether the work was done in 1906 or not?

A. No; only hearsay. I did not look them up myself.

Q. When you say that this ground was unoccu-

(Testimony of Morse S. Duffield.)

Q. Now, you wish to qualify that, don't you Mr. Duffield, by the statement that it was claimed as placer property at the time you made your locations?

A. I don't think the statement that it was claimed to be a [185] placer conflicts at all with the statement that it was unoccupied.

Q. In other words, you claim, of course, that the placer occupancy was no occupancy?

A. Was no occupancy.

Q. But assume that it was an occupancy, assume for the sake of the argument that it was an occupancy, then they were occupied.

A. If you can call a placer location there an occupancy, then they were occupied.

Q. And so far as they could be occupied by placer locations then, all those claims and all the property covered by your lode claims was occupied at the time you made those lode locations?

A. Well, not all of them.

Q. Not all of them. Well, what ones were not?

A. Some of them I did not consider valid locations.

Q. Well, what ones were not occupied?

A. The Winfield, the Winter and the Wonder and the Winslow were not valid locations.

Q. Well, that is your—you are just simply interpreting that, the validity of those locations according to your idea? A. No.

Q. There had been attempts to locate them, hadn't there?

A. There had been attempts to locate them, yes.

Q. And there was work done there?

(Testimony of Morse S. Duffield.)

A. There was work done by the claimants that located ahead of them.

Q. There had been work done by them, too, hadn't there, on these placer claims? A. No.

Q. You say that there was no work there?

A. No.

Q. Never had been done by the placer claimants up to 1907? [186]

A. The Winter, the Wonder and the Winfield and the Winslow.

Q. That is what I am asking you about. I say, do you know and do you testify that there was no work done upon those placer claims, on those four claims up to 1907?

A. Yes, sir; there was none done under those names on those claims.

Q. None done under those names at all?

A. Yes.

Q. You are positive of that, are you?

A. Yes, sir; the record is the best proof of that.

Q. I am asking you of your own knowledge. You say you had some information about it. I want to find out?

A. Well, I would refer you to the records in case I am in error.

Q. I am not asking you about the record. We will have the record at the proper time. I am asking you whether you know there was no work done on those four claims, and whether you will testify now of your own knowledge that there was no work done on those placer claims, those four claims?

(Testimony of Morse S. Duffield.)

A. No; I don't know really what the record shows.

Q. Now, you don't know whether they were properly located at that time because you did not examine the corners? Haven't you so testified you did not examine the corners?

A. As far as that would enable me to judge whether they were properly located or not, I don't know whether they were properly located.

Q. You don't know whether they had been or not. But you knew and did have information that the San Francisco Chemical Company claimed these claims which are shown on this map, at the time you made your locations? A. Yes, sir.

Q. And their occupancy at that time was the occupancy that a [187] placer location could give them? A. Yes, sir.

Q. And of all those claims?

A. Well, on some of them it was not such an occupancy as a valid placer location would give.

Q. That is your opinion about it?

A. I won't say that altogether.

Q. There was some occupancy and some evidences of work done, was there not? A. Yes, sir.

Q. And you had knowledge of this work that was done at the time you made these locations—saw it there?

A. I saw work there. I don't know what it had been done for.

Q. Well, there was open cuts, wasn't there and some tunnel work on those claims? A. Yes, sir.

Q. And there was plenty of evidence there indicat-

(Testimony of Morse S. Duffield.)

ing that someone was working this property?

A. It would not be evidence that someone was working it.

Q. They were digging holes in it, and pits?

A. There was some evidence that somebody had been.

Q. Of course, they were not there every day, but there was evidence there that some one had done work on all of these claims? A. On what claims?

Q. The placer claims?

A. Well, it might have been done for the old lodes, for all I know.

Q. I am not asking you what it was done for. That was on the property covered by the placers?

A. I don't know what it was done for.

Q. It was on the property covered by these placer claims? A. Yes, sir.

Q. On all of them? A. Yes, sir. [188]

Q. Now, you say that those old lode locations had been abandoned when you made your locations?

A. Yes, sir.

Q. How did you know that they were abandoned?

A. From the record.

Q. What did you get from the record that convinced you of that fact?

A. The work for 1905 and 1906 had not been done.

Q. Are you sure of that?

A. I was pretty sure of it.

Q. Are you sure of it now?

A. Yes, sir; that the records do not show any affidavits or proof of labor for those years.

(Testimony of Morse S. Duffield.)

Q. You are as positive of that as anything else you have testified to in regard to these claims?

A. No; I am positive about this according as I know them.

Q. I asked you whether you are positive about this. Do you know this?

A. I don't know only what the record shows.

Q. I am asking you what you know, what it was that established in your mind the fact that these old lode locations had been abandoned?

A. The records show no work had been done.

Q. And you know that to be a fact that the records do show that?

A. Well, as I remember the facts at the time, that is the way I found the records.

Q. That is your recollection of what the records show? A. Yes, sir.

Q. Now, the Hickman claim differs from what it was when you established it by drawing in the claim from the east—that is, drawing in your east side line, owing to a conflict with a patented placer. What placer was that? A. The Waterloo placer.

Q. That is a placer that is patented to the San Francisco Chemical [189] Company?

A. Yes, sir.

Q. On this same deposit? A. Yes, sir.

Q. You knew at the time you made these locations, didn't you, Mr. Duffield, that you were going right into or would likely go into a contest with the placer claims on this property? A. Yes, sir.

Q. You had that information before you made any

(Testimony of Morse S. Duffield.)

surveys or any locations or established any corners or discoveries? A. Yes, sir.

Q. And you understood that after you had made your map concerning which you have testified, and you understood that the location of all of these claims, every single one of those claims which are your lode claims, would be in conflict with the claims with the placer to that mineral deposit of lime phosphate? A. Yes, sir.

Q. Had you ever discussed the location of these lode claims with Mr. Jones? A. No, sir.

Q. At no time? A. Never.

Q. Or with anyone representing him?

A. No, sir.

Q. Has he any interest in these lode claims, or any of them? A. No; absolutely none.

Q. Absolutely none. Has he ever had any interest in any of them? A. Never had any.

Q. Did you acquire any information concerning the fact that this country here where you have these lode claims located was claimed by the placer people, that is, claimed by the San Francisco Chemical Company, from any other source than the record prior to going up to Bear Lake?

A. Why, I think Mr. Jones told of a litigation he had on the question [190] of a lode or placer.

Q. Did you have any information that Mr. Jones had at any time located these as placers?

A. Only such as the records show.

Q. And you knew that, did you? A. Yes, sir.

Q. And you saw that at a time before you made

(Testimony of Morse S. Duffield.)

your locations? A. Yes, sir.

Q. And did you know or have any information that Jones had afterwards made the locations, the old locations upon this same property?

A. I had the information that the records show. I don't recollect as to that point just now.

Q. Don't you know that the lode locations showed a later date than the old placer locations?

A. I don't remember that just now.

Q. Did you have any information that Mr. Jones at one time was in litigation with the San Francisco Chemical Company over the Waterloo property?

A. Yes, sir.

Q. You knew about that? A. Yes, sir.

Q. And you knew, did you not, that Mr. Jones had been in the employ of the San Francisco Chemical Company prior to that litigation?

A. No; I did not know that.

Q. Well, you had information to that effect, didn't you?

A. As I understood he represented the Mountain Copper Company; he had been working for the Mountain Copper Company.

Q. That is your information that he represented the Mountain Copper Company?

A. That is the way I remember it. I don't think I ever heard of his representing the San Francisco Chemical Company. [191]

Q. Did you ever know that he was employed by the San Francisco Chemical Company?

A. No; I never knew that.

(Testimony of Morse S. Duffield.)

Q. Now, calling your attention, Mr. Duffield, to the discovery of the Wayne, what kind of a post or monument did you place there?

A. I think that was originally a cottonwood and I replaced it with a 4x4 later on.

Q. Give us the size and dimensions of the particular post which was there?

A. There was an old post there about 8 inches in diameter, evidently the original post, and right alongside of it we placed a 4x4.

Q. Was that all at the same time when you—

A. Well, during the ten days that we were staking.

Q. Well, did you put the second post there at a different time, or put them there about the same time as the other post?

A. I think it was just at the time when we were checking up.

Q. Have you now any recollection that that particular post at the discovery of the Wayne, the discovery point of the Wayne, was replaced prior to November of 1908?

A. No; I have not any recollection of that.

Q. You don't know?

A. No; I don't remember that.

Q. Calling your attention to the angle stake on the Columbia; I will ask you to describe the angle stake, all the angle stakes, the four angle stakes on this Columbia claim.

A. The four angle stakes on the Columbia as I remember them were cottonwoods.

Q. Well, give us the size of them all.

(Testimony of Morse S. Duffield.)

A. They were all from 4 inches in diameter as originally placed, were 5 feet long and every one of them had a little base of rocks, a little [192] mound of rocks under it.

Q. That is the description of all of them. They were all practically the same in that regard as to size and manner in which they were placed?

A. That is practically the description of them as originally placed.

Q. Now, then, were they changed in any way or replaced prior to November, 1908, when you say that you paid especial attention to the stakes?

A. I don't remember about them in 1908. The men that were doing our assessment work had instruction to replace them all where they needed it.

Q. You haven't any recollection as to what was done? A. I don't recollect that just now.

Q. What?

A. I don't recollect there. Now, I recall the angle post No. 2 of the Columbia was replaced by a 4x4; that is right at our workings.

Q. When was that replaced?

A. That was done while the assessment work was being done.

Q. That was after or during November?

A. It was during.

Q. I am speaking whether any changes had been made up to November that you know, or if you don't know.

A. I don't know; I don't remember about those.

Q. Now, then, as to the angle in the Hickman. I

(Testimony of Morse S. Duffield.)

call your attention to the south end center of the Hickman. What kind of a post did you have there?

A. I think that was a cottonwood.

Q. Have you a distinct recollection in regard to it?

A. No; I have not.

Q. Give us the size and so on, the manner in which it was placed?

A. Well, all the stakes that I used and cut were good sized. [193]

Q. That doesn't mean much?

A. And I placed such a one there.

Q. Give us the size of the stake, the center end stake.

A. I don't remember that exactly, but I am pretty sure it was at least 4 inches.

Q. At the top? A. At the top.

Q. How long? A. 5 feet as originally placed.

Q. Any mound around it?

A. I don't recollect that.

Q. Was there any change made in that post up to November, 1908, to your knowledge?

A. No; I don't remember of any.

Q. Calling your attention to the discovery post of the Hickman: describe that to us.

A. It was a 4x4 replacing a—I replaced that in 1908.

Q. That was in November?

A. I replaced the original pine stake there before—well, let us see, that is along about the time the assessment was done.

Q. I am asking you about November, just before

(Testimony of Morse S. Duffield.)

that, Mr. Duffield. Was that post replaced before November, 1908?

A. No; I am not sure. I think it was.

Q. You think it was? A. I think it was.

Q. What kind of a stake was put in its place and when?

A. I think a 4x4 was put in its place.

Q. When, and by whom?

A. I don't remember now just by whom.

Q. When?

A. I think that was in January, along early in January, 1908.

Q. 1908, in the early part of January, 1908?

A. Yes.

Q. After that was any change made up to November? [194] A. I don't know of any.

Q. Calling your attention to corner No. 3 of the Mt. Pleasant, what kind of a stake was there there?

A. I think that was a fence post, an old fence post I brought down from town with us, either that or a 4x4 and I don't remember distinctly about that now.

Q. Can you give us any idea as to the form, size and dimensions, and manner in which it was placed at that particular corner?

A. Well, as I don't remember the post distinctly I can't very well do that.

Q. All right. Calling your attention then to the northwest corner of the Mt. Pleasant, what kind of a post was there there and how was it placed?

A. The northwest? That was a 4x4, four feet eight inches long set in a ground with rocks around the base.

(Testimony of Morse S. Duffield.)

Q. You remember that particularly?

A. I remember that as originally located.

Q. Was there any change made in that up to November, 1908? A. I don't know of any.

Q. And the north end center of the Overton, what kind of a post did you have there?

A. We had a 4x4.

Q. You remember that, do you? A. Yes, sir.

Q. And how was it placed?

A. It was placed right alongside by the old unmarked post which we had temporarily used.

Q. Nailed to it?

A. I don't recollect that; it may have been.

Q. How long was it?

A. Four feet eight inches. [195]

Q. Set in the ground?

A. Yes, sir; right at the base of the other, right alongside of the old post.

Q. Did you dig any hole for this new post that you put in there, or merely set it up against another one?

A. Oh, we dug a hole about four or five inches I should say and piled a few rocks around it.

Q. And then nailed it to the other post?

A. I don't remember now.

Q. Have no recollection of that? A. No.

Q. And how about the end center?

A. The other end center of the Overton?

Q. To the south?

A. Well, that was a monument further up right in the wagon road.

Q. Now, then, how high was that?

(Testimony of Morse S. Duffield.)

A. Well, that was a good height. The rocks were plentiful there.

Q. How large a base did you have?

A. That had a base there of about four feet.

Q. How high was your monument?

A. It was fully four feet.

Q. Did you measure it? A. Yes, sir.

Q. How? A. By eye.

Q. By your eye? A. Yes, sir.

Q. Can you measure by your eye?

A. I can tell pretty well.

Q. I am not asking you how well, but I am asking whether you can measure the exact number of feet simply with your eye, without any instrument and without a tape or other means?

A. I can get a good common sense measurement with my eye.

Q. That is the kind of measurements you made here?

A. That particular one, but I had a special reason for doing that. [196]

Q. Did you measure all of them at that time?

A. No, sir.

Q. You took a tape to the others?

A. No; not always.

Q. What did you take? You didn't trust your eye, did you? A. Sometimes.

Q. When? A. Whenever it was handy to do so.

Q. But you didn't make any measurements, you did not make it a rule to make measurements of any of those posts?

(Testimony of Morse S. Duffield.)

A. As a rule our posts are so large we didn't need to measure them.

Q. You didn't measure them?

A. There was no need to measure them; they were so obvious that we didn't need to measure them.

Q. You didn't measure them? A. No.

Q. And the monuments you erected at different places in placing posts, you did not measure them, did you? A. How do you mean by measuring?

Q. Take any measurements as to the height with a tape or other means of—

A. We did measure them with a tape or other means.

Q. Any of the monuments? A. Some of them.

Q. You measured some that way? A. Yes, sir.

Q. Which ones?

A. Well, most of our discovery stakes as we set them we measured them.

Q. I am talking about the monuments, I mean stone monuments. A. Well, a stake is a monument.

Q. I say stone monuments, not the stakes.

A. Well, on [197] the stone monuments we used common sense in the measurement.

Q. Never measured any of them?

A. Oh, yes; measured them.

Q. Never measured anything?

A. You state "never measured anything"?

Q. I say measured any of them?

A. Yes, sir; such measurements as I have described.

Q. Did you receive a notice from Mr. Taylor, the

(Testimony of Morse S. Duffield.)

agent of the San Francisco Chemical Company, during the month of April 1910, here at Salt Lake?

A. I have forgotten it if I did.

Q. Did you receive a registered letter from him?

A. I don't remember of any.

Q. Don't remember any letter at all?

A. April, 1910?

Q. Yes, sir. A. No; I don't remember it.

Mr. BUDGE.—I will ask you, Judge Dey, if you have made any endeavor to find the letter that was sent to Mr. Duffield by Mr. Taylor during the month of April, 1910, which was received here at Salt Lake as I remember it on the 16th day of April.

Mr. DEY.—Mr. Jack, will you do that?

WITNESS.—The 16th of April?

Mr. BUDGE.—Yes; I think about that date.

WITNESS.—Was it Jeffs or Duffield?

Mr. BUDGE.—It was signed for by Mr. Jeffs but sent to Mr. Duffield.

Mr. JACK.—I have some recollection of such a letter.

WITNESS.—I don't think I ever saw it. [198]

Mr. DEY.—I have no objection to your using a copy of it.

Mr. BUDGE.—I have a carbon copy of it here.

Mr. DEY.—All right; submit it to Mr. Jack.

(Letter submitted to Mr. Jack.) We will admit that this is a copy of the original that was received by Mr. Jeffs.

Q. Mr. Duffield will recollect it by seeing it, possibly.

(Testimony of Morse S. Duffield.)

A. No; that was evidently filed without my ever seeing it. I do not recollect it.

Mr. BUDGE.—Well, we will read this into the record as follows:

[**Exhibit: Letter, Dated April 13, 1910—Jos. J. Taylor to M. S. Duffield.**]

SAN FRANCISCO CHEMICAL COMPANY:
Telephone 52.
Post Office box 87.

Montpelier, Idaho, April 13, 1910.

Mr. Morse S. Duffield,
Dooly Building,
Salt Lake City.

Sir:

Mr. George Hoff to-day attempted to commence work on our claims here claiming that he was acting under your orders. He was notified that he was trespassing and *would held* responsible for such trespass. On behalf of the owners of these phosphate claims I wish to notify you that any such acts by him or anyone else claiming to act under orders will be considered a trespass and you and your agents *will held* responsible for all damage or trouble that may result from *shuch* trespass.

Yours,

JOSEPH J. TAYLOR. [199]

Mr. BUDGE.—You admit, Judge Dey, that this letter was received on or about April 16th, by Mr. Jeffs, one of the complainants?

Mr. DEY.—Yes; by Mr. Jeffs, one of the complainants.

(Testimony of Morse S. Duffield.)

Q. Do you recollect some controversy arising during the fall of 1908, at the time you were doing your assessment there on those claims? A. Yes, sir.

Q. You do remember. Just tell us what occurred there?

A. Why, as I remember it, my men, the Wilcox brothers, drove onto the Overton lode claim with a wagon and camping outfit and started to pitch camp, and I don't know who it was, but somebody pretending to represent the San Francisco Chemical Company ordered them off.

Q. Yes; and the Wilcox boys went off?

A. Yes; and reported to us, to Mr. Jeffs and myself, here in Salt Lake City, and we commenced suit then, I think.

Q. You got out an order of injunction, did you not?

A. I don't remember.

Q. Restraining these people from interfering with your doing assessment work?

A. I don't know just what the legal steps were.

Q. Don't you remember there was an order issued to that effect, or do you remember?

A. I think that is what it was.

Mr. JACK.—The injunction applied to all of the claims.

Q. Now, were you familiar with the arrangement that was entered into between the San Francisco Chemical Company and yourself, or your attorneys after this suit was instituted with reference to work to be thereafter done?

A. Why, as I remember [200] it, the case was

(Testimony of Morse S. Duffield.)

dismissed without prejudice to either placer or lode claims.

Q. Do you remember whether or not there was any understanding at that time that you would be permitted to go on this land and do assessment work for the year 1908 only? A. No; I don't think so.

Q. You don't remember anything about that?

A. No.

Q. Did you consult with your counsel as to the arrangement that was made in this matter?

A. Yes, sir; I left the matter in their hands.

Mr. BUDGE.—Judge Dey, I desire to submit to the witness some letters and telegrams that I want to put in on cross-examination simply to explain the whole situation. Have you any objection to those?

Mr. DEY.—We object to them as wholly immaterial.

Mr. BUDGE.—I will read them in evidence as follows:

[Exhibit: Letter, Dated November 19, 1908—Charles C. Dey to Goodfellow & Eells.]

DEY and HOPPAUGH.

Counselors at Law.

Auerbach Block.

Salt Lake City, Utah, November 19, 1908.

Charles C. Dey.

Al. L. Hoppaugh.

George W. Parks.

Messrs. Goodfellow & Eells,

Counselors at Law,

430 California Street,

San Francisco, California.

Gentlemen:—

Pursuant to understanding with your Mr. Eells, I have, upon my return, submitted to clients and associate counsel, the suggestion that they direct a dismissal of the bill of complaint [201] filed in the U. S. Circuit Court for the District of Idaho, and of the restraining order issued thereon. This they are willing to do, with your assurance that they may proceed to do, or cause to be done, the annual assessment work upon the thirteen lode locations described in said bill of complaint, for the year 1908, and annually thereafter until the question of the validity and right of possession thereof, as against the placer locations, may be adjudicated in an adverse suit when either party makes application for U. S. Patent. It goes without saying that neither of the parties are in any manner to be prejudiced in asserting and maintaining their several and respective rights, nor do they waive any right of possession they are, or may be, lawfully entitled to, or any legal rights whatsoever by reason of such permission being given to said complainants as aforesaid. Also, it is to be understood that said complainants, in doing such annual work, shall not unnecessarily interfere with any of the workings of the placer claims, or remove from the premises any phosphorite, or any other valuable minerals, or impede in any manner, the performance of the annual labor upon the unpatented placer mining locations.

Upon receipt of this, if you will wire (at my expense) your approval, with such appropriate modifications as you desire, and permit the assessment work to commence on Tuesday next, November 24th,

I will see to it that an order is at once entered dismissing the bill of complaint, etc.

Yours truly,

CHARLES C. DEY.

CCD/CC [202]

[**Exhibit: Letter, Dated November 23, 1908,
Goodfellow & Eells to Charles C. Dey.]**

(Copy.)

Charles C. Dey, Esq.,

Auerbach Block,

Salt Lake City, Utah.

Nov. 23rd, 1908.

Referring to your letter of 19th inst., we represent persons claiming both placer and lode locations prior to yours on lands mentioned, besides Waterloo patent. Nevertheless, to avoid present litigation and perhaps violence, we agree that plaintiffs in Duffield vs. Goodfellow, may peaceably perform assessment work on lode claims described in that complaint for this year only, without otherwise disturbing our clients possession or prejudice to any claims for lode or placer asserted by your clients or ours; conditions otherwise as stated in your letter. If you will dismiss actions on these terms, wire us and we will instruct Idaho agent accordingly.

GOODFELLOW & EELLS.

[**Exhibit: Telegram, Dated November 24, 1908,
Charles C. Dey to Goodfellow & Eells.]**

THE WESTERN UNION TELEGRAPH COMPANY

Received at S. E. Corner Pine and Montgomery Sts.,
San Francisco, Calif.

5 S. X. R R H G 21 paid x 209.

Salt Lake, Ut., Nov. 24-08.

Goodfellow and Eells, Attorneys,

430 Calif. Street, San Francisco.

Immediate answer required.

We dismiss action upon conditions stated in your telegram covering this year's work leaving future work for adjustment when occasion arises. [203]

CHARLES C. DEY.

9:33 A. M.

[**Exhibit: Letter, Dated November 24, 1908, Charles C. Dey to Goodfellow & Eells.**]

DEY and HOPPAUGH,

Counselors at Law.

Areubach Block.

Salt Lake City, Utah, Nov. 24, 1908.

Charles C. Dey.

A. L. Hoppaugh.

George W. Parks.

Messrs. Goodfellow and Eells,

Counselors at Law,

430 California Street,

San Francisco, California.

Gentlemen:—

I now confirm respectively telegram of November 23rd, reading:

“Referring to your letter of 19th inst., we represent persons claiming both placer and lode locations prior to yours on lands mentioned, besides Waterloo patent. Nevertheless, to avert present litigation and perhaps violence, we agree that plaintiffs in Duffield versus Goodfellow, may peaceably perform assessment work on lode claims described in that complaint for this year only, without otherwise disturbing our

clients possession or prejudice to any claims for lode or placer asserted by your clients or ours conditions otherwise as stated in your letter if you will dismiss action on these terms wire us and we will instruct Idaho agent accordingly."

And my reply of this date, reading:

"We dismiss action upon conditions stated in your telegram covering this year's work, leaving future work for adjustment [204] when occasion requires."

The statement in your telegram referring to your "lode" location is something I have not been advised as to.

I sincerely trust this matter will continue to be amicably arranged until the question involved can be finally determined, and I have no doubt if you remain in charge of the same that such will be the outcome.

I have instructed Mr. Gough to immediately enter dismissal of bill of complaint.

Yours truly,

CHARLES C. DEY.

[Exhibit: Letter, Dated November 28, 1908—Dey & Hoppaugh to Goodfellow & Eells.]

DEY and HOPPAUGH.

Counselors at Law.

Auerbach Block.

Salt Lake City, Utah, November 28, 1908.

Charles C. Dey.

A. L. Hoppaugh.

George W. Parks.

Messrs. Goodfellow and Eells,

430 California Street,

San Francisco, California.

(Testimony of Morse S. Duffield.)

Gentlemen:—

Enclosed please find copy of praecipe sent to the Clerk of the U. S. Circuit Court at Boise, Idaho.

Yours truly,

CCD/CC

DEY and HOPPAUGH.

Q. Do you know what work was done by your employees at the time they went there in 1908, after the arrangement had been made **[205]** between the San Francisco Chemical Company and yourself and after that suit had been dismissed?

A. The work for 1909 was done immediately following the work for 1908.

Q. You stayed there and did work for both years?

A. Yes; without objection.

Q. Well, were you there?

A. I made several visits while they were doing the work.

Q. Do you know whether any objection was made or not except when you were there?

A. I never heard of any from my men.

Q. You don't know of your own knowledge except when you were there?

A. Only when I was there, but my men would have reported it when I was not there.

Q. You knew at the time you made these lode locations and at a time you understood that there were placer locations upon this same property? You knew from the notices of location of the placer claims, as well as from the work that had been done upon those claims that the property was being claimed by the placer locators for this particular deposit of lime phosphate? A. Yes, sir.

(Testimony of Morse S. Duffield.)

Q. Now, calling your attention to that deposit, Mr. Duffield, you say that the phosphate is between limestone, two layers of limestone, one above and one below? A. Yes.

Q. Now, just describe to us this phosphate deposit, the phosphate, not the other surrounding rocks, but just the phosphate.

A. The phosphate measures consists of about sixty to eighty feet of strata of high grade phosphate vein varying or alternating with smaller strata of shale and smaller strata of limestone. [206]

Q. And smaller strata of chert?

A. Occasionally.

Q. Yes; and it alternates throughout the entire series, does it? That is, it is a series of lime phosphate? A. It is a zone of phosphate.

Q. A series. Now, what is chert, Mr. Duffield?

A. Chert is a silicious lime, silicious limestone.

Q. Silicious limestone. And does that occur many times in this series, chert? A. In the series?

Q. Yes.

A. I don't remember seeing much chert in the series.

Q. Very little? A. No.

Q. Well, there is some you remember, do you?

A. No—well, I don't know; occasionally a nodule maybe.

Q. Didn't you say in your direct examination that it was overlaid by chert?

A. Well, the hanging-wall north of Montpelier Canyon is chert, I think, a mass of chert limestone that lies next to it.

(Testimony of Morse S. Duffield.)

Q. Is that what you call chert?

A. I never examined it carefully. I always considered it chert.

Q. The hanging-wall of what did you call it?

A. Of the phosphate series.

Q. You say that was on the east side of the canyon?

A. The north side of the canyon.

Q. And that what you call the hanging-wall is what you call chert, is it?

A. Well, I don't know that it comes right down exactly to the phosphate series so as to make an actual hanging-wall, but in the general description, I should call that chert the hanging-wall. [207]

Q. Now, I think you stated in this series there was there alternating deposits of phosphate in between alternating deposits of limestone and so on?

A. And shale.

Q. And shale? A. Yes, sir.

Q. That is true? A. Yes, sir.

Q. And they are of varying thickness?

A. Yes, sir.

Q. That is, limestone might separate two deposits of phosphate and shale might separate two more?

A. Yes, sir.

Q. That is correct. Do any of these what you have called veins of phosphate, connect with another, or are they simply distinguished from one another?

A. I don't think enough work has been done in the whole field to tell whether they do or not.

Q. Well, from your observation what is the condition? So as to explain myself, do you know whether any of this, what you have called veins of

(Testimony of Morse S. Duffield.)

phosphate rock— A. Yes.

Q. Broke through the shale or limestone in between the two veins and connect with one another, or do they lie parallel to each one of the series?

A. I don't think they break through the shale anywhere, but the shale disappears in places.

Q. But they run parallel where more than two or more than one vein of phosphate, as you call it?

A. There is not enough work done to tell whether that will hold true throughout the entire region.

Q. So far as you have observed?

A. I have seen a few things that leads me to think that there will be a lens formed in these phosphate veins.

Q. What do you mean by that?

A. They will be more or less oval shape, and they will pinch out and bulge out. [208]

Q. Have you seen any there widen and narrow out?

A. Why, I have seen—I don't recollect just where I have seen it now—yes; I think I have seen that right on the Cumberland lode.

Q. On the Cumberland?

A. If I remember right.

Q. Just describe the condition that you have seen on the Cumberland?

A. There is some strata there, small strata of phosphate rock that is separated from other strata by shale, and I thought I detected there instances of the shale petering out and the phosphate widening; as the shale would narrow the phosphate would widen out.

(Testimony of Morse S. Duffield.)

Q. In other words, when you come to the end of where the shale pinched out the phosphate was there as a bed, was it? A. Yes.

Q. Have you noticed that on the Cumberland?

A. I think there is an instance there.

Q. Is that the only instance that you know of?

A. There are other instances in the field.

Q. Where?

A. Down at Brazer Canyon, I think there is one or two places where there has been enough work done to give you that idea.

Q. Is it a question of idea or fact?

A. It is all a question of idea.

Q. Is it a fact that you have seen this condition *that have* described down in Brazer Canyon?

A. It is a fact in Brazer Canyon that the vein of phosphate exists and—

Q. I am not asking you that at all. That is not the question. A. That is what you said. [209]

Q. I am asking you whether you have seen any condition in Brazer Canyon where the shale in between the phosphate beds had ended and had been superseded by a solid deposit of phosphate?

A. I won't say that it actually ended there, but it varies in thickness, the shale.

Q. Varies in thickness, but other layers where the shale exists, it is between the two beds of phosphate, but the phosphate does not break the shale?

A. Well, there has not been enough work to tell whether it does it or not.

Q. Have you ever seen it?

A. Not where it actually broke through.

(Testimony of Morse S. Duffield.)

Q. You never see it on the Cumberland vein where it actually broke through, do you?

A. I don't remember it breaking through.

Q. What you assume is that the Cumberland is of a similar condition that you see down at Brazer Canyon? That is, that the shale was simply of varying thickness and the phosphate beds came closer together—the phosphate beds on either side of the shale came a little closer together than they did at other places. Is that what you mean?

A. I mean the particular fact that the shale and the phosphate vary in thickness shows that some day they may break through.

Q. That is only a conclusion. You haven't seen it.

A. That is only a conclusion, that it does not break through.

Q. You haven't seen any place where it does?

A. No; I have not.

Q. And you see in many instances where it does not, and in fact every instance that you know of it does not? Is that true?

A. In a great many instances, because there is not enough [210] work done.

Q. Wherever you have examined this series it has always been true that the phosphate vein as you call it, does not break through the wall in between it and the other phosphate vein?

A. So far as work is done.

Q. Now, you said on your direct examination that this phosphate lime was easily discernible along this locality where these claims are located?

(Testimony of Morse S. Duffield.)

A. Yes, sir.

Q. And that it was quite apparent that you simply go along there and see this outcrop of phosphate rock following along these claims?

A. Well, the outcrop does not stand right out all the way.

Q. Oh, no.

A. But enough so that you can trace it.

Q. So as to be traceable?

A. To be traceable.

Q. It is not any more traceable than the limestone that is with it? A. No.

Q. It occurs just like the limestone, does it not? That is underneath and over it?

A. Yes, sir; just about like it.

Q. The same shape? A. The what?

Q. The same shape. It has the same appearance there along the line except as to color?

A. It is the same shape so far as being in place with the other strata, the other masses of rock.

Q. And if you were searching for limestone you would just as readily discover that as you would discover the phosphate in your search for that?

A. Yes, sir.

Q. I now call your attention to the phosphate, how do you determine, [211] Mr. Duffield, that certain deposit is phosphate?

A. By taking a sample of it and sending it to the chemist.

Q. Is that the way you determined this?

A. No.

(Testimony of Morse S. Duffield.)

Q. How did you determine this?

A. Well, that is right; we did send it to the chemist.

Q. You did send it to the chemist? Now, how does this compare in appearance and in other characteristics to the Tennessee deposit, concerning which you spoke?

A. As far as it is lying in place in the solid mass of the mountain, it is utterly different from the Tennessee deposit.

Q. Well, I am asking you about the principal nature of the rock itself.

A. Well, the Tennessee rock is as I remember it oolitic in structure and the texture is similar to this.

Q. This is the oolitic, is it? A. Yes, sir.

Q. Now, you say the manner of occurrence is different you say from what is down in Tennessee?

A. Yes, sir.

Q. You stated, didn't you, you did not know what was under that bed down in Tennessee?

A. No; I don't know.

Q. You don't know? A. I don't know.

Q. And it is only different then so far as your opinion goes, as to what is over it?

A. And that is enough to make a mighty big difference.

Q. That is the only difference?

A. That is the only difference.

Q. It has a dip to it?

A. The same, except perhaps this is a greater dip.

Q. This is a much greater dip?

(Testimony of Morse S. Duffield.)

A. Yes, sir; a much greater dip. [212]

Q. A greater angle?

A. Yes, sir; a much greater dip to it. The other has a dip of 15 degrees in some places as I remember it.

Q. And in other respect the rock itself is practically the same thing, isn't it?

A. No; the Tennessee rock is disjointed and filled with clay and alluvium in the cracks and joints and broken up like.

Q. Well, there may be more impurities in it, that is to say, there may be more materials in it that are not phosphate rock, but the phosphate rock itself is practically of the same quality, isn't it?

A. Practically the same.

Q. And the same color? A. No.

Q. Except as it is stained by those other mixtures?

A. These phosphates here are dark and in Tennessee they were grey, as I remember it.

Q. That is your recollection of this particular deposit in Tennessee is that it was grey?

A. The rock there was a grey rock.

Q. It was not loose in the gravel down in Tennessee? A. No; but overlain by gravel.

Q. The rock itself was not the gravel?

A. No.

Q. It was a solid mass as this is a solid mass?

A. Well, it was not near so solid as this is.

Q. It was solid and required blasting to economically mine it, didn't it?

(Testimony of Morse S. Duffield.)

A. It was disjointed and broken up.

Q. It required blasting so as to economically mine it?

A. Yes, sir; although it was not absolutely necessary.

Q. And it is not absolutely necessary here, is it?

[213] A. Yes, sir.

Q. The only way you can do anything with it?

A. The only way you can do anything with it here.

Q. The only way that you can mine it, no other way except to blast?

A. I don't know how you could do it.

Q. You don't know of any other way? A. No.

Q. And that was the way that was done down there? A. The way what was done, the mining?

Q. Yes. A. As I remember it.

Q. Now, then, so far as the underlying rocks of the two deposits, the Tennessee deposit and this, they may be the same for all you know?

A. They may be.

Q. And the only difference as to the manner of occurrence of these deposits is that this has a greater dip and a different covering?

Mr. DEY.—I object to the question as not being cross-examination and as immaterial, irrelevant and incompetent to any issue in this case.

A. Practically that is the only difference.

Q. Now, you have had considerable experience, have you not, Mr. Duffield, as a practical miner?

A. Considerable, yes, yes.

Q. And you understand, do you not, that limestone

(Testimony of Morse S. Duffield.)

is locatable as a placer? A. Yes, sir.

Q. That if you intended to locate the limestones, if any of them were of a commercial value adjoining this phosphate or in this phosphate series, that they would be locatable as placers?

A. Yes, sir; if you wanted it for the limestone.

Q. That is what I say, if you wanted it for the limestone. Now, this phosphate is limestone. [214]

A. No.

Q. What is it? A. Phosphorite.

Q. It is limestone that is impregnated with phosphoric acid? A. No; it is mineral.

Q. A mineral? A. Yes, sir.

Q. Isn't the underlying rock mineral?

A. Yes; a different mineral.

Q. It has more mineralization than limestone, hasn't it?

A. How do you mean? I did not catch that.

Q. May be more mineralized than the phosphate itself? A. Possibly.

Q. The underlying rock?

A. I don't know in what sense you used the word mineralized there.

Q. Possesses a higher percentage of mineral matter? A. Not as mineral as—

Q. I am not asking you whether valuable or not, I am asking you about mineral.

A. Well, I would not say it is possessed of a higher percentage of mineral matter.

Q. Do you know whether it is or not?

A. No; I never tried it.

(Testimony of Morse S. Duffield.)

Q. You never tested it and you never made any examinations have you, or made any chemical tests to ascertain? A. Myself?

Q. Yes. A. No.

Q. Is there any lime in this phosphate rock?

A. A little.

Q. How much? A. About 40 per cent.

Q. How much—

A. I don't know how much there would be. [215]

Q. Well, considerable, isn't there?

A. Well, there is 30 to 40 per cent.

Q. And the only difference between this and the underlying limestone is the fact that this is lime phosphate and the other is carbonate of lime, isn't it; both limestone? A. No; they are not limestone.

Q. Not limestone? A. No.

Q. You still insist that it is not a limestone?

A. No; it is not a limestone.

Q. Simply because it has phosphoric acid in it?

A. No; because it is phosphorite.

Q. Phosphorite? A. Phosphate mineral.

Q. What is the composition of phosphorite? Do you know? A. Phosphorus.

Q. Do you know what the composition is?

A. A little iron, a little alumina, a little calcium and phosphorus from the analyses I have seen.

Q. From analyses you have seen. Now, then, what is in the other limestone?

A. Nowhere near the same amount of phosphorus.

Q. I am not asking you about anywhere near, but tell the Court what is in it.

(Testimony of Morse S. Duffield.)

A. I don't know what is in it in these particular cases.

Q. No. Now, all this limestone that is in between these layers of phosphate has got phosphoric acid in it, hasn't it?

A. I don't know. I never tried any.

Q. You don't know anything about it? A. No.

Q. Now, Mr. Duffield, calling your attention again to this deposit: [216] you said that the phosphate deposit had a hanging and a footwall, a hanging-wall of chert and a footwall of limestone. Is that correct?

A. I believe that is the way I described it.

Q. Now, in mining, as a practical miner, when you discover a vein that is actually known as a vein or lode, it is not material how thick either the hanging or the footwall may be on each side of the mineralized area, is it?

A. Not if that delimits the mineral.

Q. That is what I say. In other words, if the mineral is between two certain walls, it is not material how thick they are, those walls? A. No.

Q. If the vein is there, it is a vein no matter how thick the walls are. Isn't that true? A. Yes, sir.

Q. Now, there are alternating beds or layers or strata of limestone between these phosphate beds, or phosphate vein deposits? Is that true? A. Yes.

Q. So that you have got any number of hanging and foot walls between the various deposits of phosphate throughout this series, haven't you, just as much as you have a hanging and foot wall on either side of the whole series?

(Testimony of Morse S. Duffield.)

A. If you choose to classify it that way, that may be so.

Q. Mr. Duffield, how many of these phosphate claims have you? A. That I have an interest in?

Q. I mean you and Mr. Jeffs.

A. In these thirteen claims here, and thirty-three claims in Utah, thirty-three lode claims in Utah.

Q. Yes.

A. And twelve lode claims at Thomas's fork; [217] three lode claims at Paris, Idaho.

Q. Yes; any others?

A. I think those are all now.

Q. Those are all your lode claims? A. Yes, sir.

Q. Well, what interests have you in placer claims?

A. I have an interest in four placer claims in Utah.

Q. Yes.

A. And three at Raymond, at Thomas's fork.

Q. In Idaho?

A. No; they are in Wyoming.

Q. Are your lode claims also in Wyoming, the Thomas fork claims? A. Yes, sir; they are.

Q. Any others? A. No; that is all.

Q. Now, where are those thirty-three Utah lode claims? A. They are in the Crawford Mountain.

Q. And where are those twelve on the Thomas's fork?

A. In the Sublette range, north and south of Raymond canyon.

Q. Three at Paris? A. Yes, sir.

Q. And three in Idaho?

A. In Bloomington Canyon.

(Testimony of Morse S. Duffield.)

Q. And the four placers in Utah?

A. They are in the Crawford Mountain.

Q. And in Thomas's fork over in the Sublette Mountains? A. In the Sublette.

Q. Those are all the claims, Mr. Duffield, in which you have any interest?

A. I am pretty sure I have got them all there now.

Q. Seventy claims in all?

A. Thirty-three and thirteen make forty-six and twelve more make fifty-eight.

Q. You gave fifteen in Idaho?

A. Thirteen in Idaho.

Q. Thirty-three in Utah, thirteen in Idaho, twelve in Thomas's fork and three in Paris?

A. Add them up? [218]

Q. Is that right? A. Yes, sir.

Q. And seven placers? A. Seven placers.

Q. Did you attempt to locate any claims in Georgetown?

A. I forgot those; three claims in Georgetown.

Q. When did you locate them?

A. I located them in the first part of this year, in January. Those I had forgotten. I think there are three, may be four—no; three.

Q. Lode or placer? A. Lode.

Q. Locate those in Georgetown as nearly as you can with reference to the town.

A. They are about five or six miles east of Georgetown, up Georgetown canyon.

Q. They are within the withdrawn area?

A. In the withdrawn area.

(Testimony of Morse S. Duffield.)

Q. Are you familiar with the extent of this deposit, this phosphate deposit, that is as to how far it extends on the dip? A. No.

Q. You don't know. There is evidence that it extends to a very great distance, however?

A. Well, it might be a fault would cut it off.

Q. How is that?

A. There might be faults that would cut it, shorten it.

Q. But if there are no faults it extended to a considerable distance as is indicated by the erosion of the creek and the different hills there, along the hills and depressions?

A. Yes, sir; there is evidence that it extends, but it may not be of the same value.

Q. But irrespective of the value it extends to great distances. To what distance? What is the greatest distance of which you [219] know of this phosphate bed extending on the dip?

A. Where do you speak of?

Q. Any place, in this locality here in question; any of this deposit covered by any of these claims.

A. I don't think these claims go to very great depth on account of the evidence of a fault just west of the map here.

Q. West of the claims, you say? A. Yes, sir.

Q. Do you have your evidence from the character of the dip, the evidence of the fault?

A. No; I am just judging that evidence from the hills lying west of the Wonder and Inman placers.

Q. What evidence is there of a fault there?

(Testimony of Morse S. Duffield.)

A. Why, just for structural reasons, I should judge there was a fault there.

Q. What are the reasons? Explain them in detail what reasons there are for leading you to believe that there is a fault there.

A. I never made an examination in detail. My reasons are simply from looking at the topography.

Q. And it is not an opinion that you would consider of very much weight then, even to yourself, in ascertaining whether there is a fault there?

A. I don't think any opinion is worth anything.

Q. You haven't made any examination, as you say?

A. No.

Q. Even as a mining man? A. No.

Q. To ascertain whether there is any fault. It is just a casual looking at the country there. Is that it?

A. Yes, sir.

Q. To what extent in—that is, how long a distance do your claims [220] extend, that is, your lode claims along this deposit?

A. About two and one-half miles.

Q. Two and one-half miles. Now, then, what is the extent of your other interest in miles, in the Crawford Mountains?

A. Well, they are—it would be on an average of about three and one-half claims to the mile down there.

Q. And thirteen of them?

A. Thirty-three of them.

Q. Thirty-three, I should say.

A. Three and one-half to the mile.

(Testimony of Morse S. Duffield.)

Q. And in Thomas's fork you have twelve more?

A. Yes, sir; that would be about three miles at Thomas's fork.

Q. And how many in the Crawford Mountains?

A. Well, that would be about ten.

Q. And in Paris about a mile?

A. Hardly a mile; about a mile.

Q. Three quarters of a mile? A. Yes.

Q. And in Georgetown about three-quarters of a mile? A. Yes, sir.

Q. That totals about seventeen miles altogether?

A. I should say it would be about that.

Q. Are those claims, both lode and placer, owned by—that is, are they claimed by you and Mr. Jeffs alone, or is there anyone else interested in them?

A. We own them; the title stands in our name.

Q. Anyone else interested in them?

A. Yes, sir.

Q. Besides yourselves? A. Yes, sir.

Q. Who? A. Two associates of mine.

Q. And do they live in this country?

A. Yes. [221]

Q. This section of the country in the west?

A. No.

Q. Do you mind giving us their names?

A. No.

Q. How are they?

A. Mr. Stinchfield of Detroit, Michigan.

Q. What is his first name? A. Charles.

Q. Who else? A. Mr. D. C. Whitney of Detroit.

Q. Any one else?

(Testimony of Morse S. Duffield.)

A. And Mr. Jeffs' brothers. I don't know exactly—

Q. Brothers, one or two?

A. Two of them, I think.

Q. They are all interested with you in these claims? A. Yes.

Redirect Examination.

(By Mr. DEY.)

Q. Do you know what ore is?

A. Why, I think I know what you mean by ore practically.

Q. Are you not experienced in these matters, is what I am getting at, one way or the other?

A. I never devoted any thought or study to technical definitions and fine drawn distinctions.

Q. Or posed as an expert?

A. No; I never posed as an expert.

Q. You know generally what ore is?

A. Yes, sir.

Q. Is this phosphate rock ore?

Mr. BUDGE.—We object to that as calling for a conclusion of the witness.

A. Yes, sir.

Q. Are the walls you have referred to of limestone ore? A. No; it is not ore.

Q. Well, then, the difference between the phosphate rock and the [222] wall material is that one is ore and the other is not ore. Is that true?

A. That is the difference.

Q. Now, along in December, 1907, you testified on cross-examination there was some interference with

(Testimony of Morse S. Duffield.)

your men doing work? A. It was in 1907.

Q. About what day? A. On December 6th.

Q. At that time, had the work, preliminary work of discovery cuts or workings and the marking of the boundaries of the claims been performed?

A. On all except the Mt. Pleasant, and it was in the act of being performed on the Overton.

Q. All except the Mt. Pleasant?

A. It was being done at the time on the Overton.

Q. On the Overton? A. Yes, sir.

Q. With the exception of the Overton and the Mt. Pleasant it had all been done up to that time?

A. Yes, sir.

Q. Well, were you kept from going on and completing the work on the Overton and the Mt. Pleasant? A. No, we were not.

Q. Did you go right along with it?

A. We went right along the next day.

Q. Any objection? A. No objection.

Q. You stated that you are interested in some placers? A. Yes, sir.

Q. Please tell the Court when and how you became interested in those placers?

A. Mr. Jeffs and I own certain lodes in the Crawford Mountains, and certain lodes in the Sublette Range, in Wyoming; these lodes were in conflict with certain placers—

Q. Claimed by whom?

A. Owned by the Union Phosphate [223] Company, and the Union Phosphate Company deeded us their placer claims in those two localities in exchange

(Testimony of Morse S. Duffield.)

for certain lode claims that we deeded them in other localities.

Q. In a laudable effort to avoid extravagant litigation?
A. Yes, sir.

Q. How long ago was that?

A. That was very recently.

Q. Well, this month or last month?

A. April 27th, I think.

Q. What year? A. 1910.

Q. What date?

A. I don't remember the date—1911, I mean.

Mr. BUDGE.—What month?

Mr. DEY.—April, 1911.

WITNESS.—It was March 27th.

Q. Please get it approximately correct, Mr. Duffield.

A. Well, I can't do it without chasing it up; I think March, 1911.

Q. Now, in making locations, you and Mr. Jeffs, have you located placer claims?

A. Yes, sir; I have located placer claims.

Q. Of this phosphate rock? A. No; never.

Q. That is what I am talking about.

A. In my career I have—

Q. All your other locations that you have made have all been lode locations? A. Yes, sir.

Q. In performing the annual labor for 1909, you performed it when?

A. In the latter part of January and February, in 1909, and continued down until April, I think; and a little more work finishing up, was done in the fall

(Testimony of Morse S. Duffield.)

for final affidavits.

Q. And more was done in the fall?

A. Yes, sir. [224]

Q. In the fall of that year? A. Yes, sir.

Q. Was there any objection made on the part of the San Francisco Chemical Company, or any interference with you in doing the annual work for 1909?

A. No objections.

Q. Or 1910?

A. Only this objection now called to my attention.

Q. The letter that Mr. Jeffs received, that has been read? A. Yes, sir.

Q. Did you see that letter?

A. I have seen it to-day, which is the first time I ever saw it.

Q. Did you see it at the time it was received?

A. No; this is the first time I have seen it.

Q. Or your attention called to it by Mr. Jeffs?

A. No, sir.

Mr. BUDGE.—I object to that as immaterial.

A. Not that I remember.

Cross-examination.

(By Mr. BUDGE.)

Q. What course did you take in Harvard University?

A. I took a degree as Bachelor of Arts.

Q. Did you take a course in mining engineering?

A. Not a full course, but I attended courses in it while there.

Q. How long did you study mining engineering?

(Testimony of Morse S. Duffield.)

A. In my four years I always had a few courses in that.

Q. And ever since that time and after your four years of study in which you took courses in mining engineering, you have been engaged more or less in the mining business? A. Yes, sir.

Q. And yet, you say you have no technical understanding of terms? [225]

A. No; I did not say that. I have a common sense understanding.

Q. Didn't you say you did not rely upon technical definitions and that you did not understand technical definitions relating to mining?

A. I did not say that. I said I had never devoted much time to the study of technical definitions and distinctions.

Q. And you are not familiar with the technical distinctions?

A. More or less, but I am not an authority upon the subject.

Q. You understand technical distinctions, you think, as they are employed in practical mining?

A. I think I do.

Q. Now, how do you determine that phosphate is ore?

A. Because it is mineral that is commercially valuable.

Q. Is that the reason?

A. That is a sufficient reason for me.

Q. Is that the only reason?

A. That is the only reason I have ever gone into it.

(Testimony of Morse S. Duffield.)

Q. The only reason that you have gone into it is that it is mineral that is commercially valuable?

A. Yes, sir.

Q. And that, you say, is the whole and only reason upon which you base your statement that phosphate is ore?

A. I think that is plenty, a sufficient reason.

Q. I ask you if that is the one?

A. That is the only one I care to pass my opinion on.

Q. Now, it is not like any other substance that you call ore, is it, that you know of?

A. Why, yes.

Q. What? A. Any ore you want to name.

Q. It is? A. Yes.

Q. Is it like lead? A. Yes. [226]

Q. In what particular like lead?

A. It is valuable for the ingredients that it contains; phosphorus.

Q. Is that the only reason that it is like lead and should be classed as an ore, and as lead is classed as an ore? A. That is a sufficient reason.

Q. Is that the only reason?

A. Well, that is the only reason I will—

Q. You say it is the same kind of ore that lead is, or belongs to the same classification of ores that lead does?

A. You can classify things until there is no end of it.

Q. Is that it?

A. You can classify lead as a metal.

(Testimony of Morse S. Duffield.)

Q. This is not like any other ore that you know of in mining? A. Yes, sir.

Q. It is not a metallic ore?

A. No, but that does not prevent it being like other ore.

Q. It is not a metal? A. Not a metal.

Q. You don't know of any ore that is not a metal other than this, do you?

A. There may be other ores that come under—

Q. Do you know of any in your experience as a practical miner? Do you know of any other ore that is not a metal?

A. I would not call cinnabar a metal.

Q. You would not? A. No, sir.

Q. You would not call that a metal?

A. Any more than phosphorus can be called a metal.

Q. It is in the same classification as phosphorus, cinnabar? A. No.

Q. Well, how does it differ in classification then?

A. Well, it is not the same classification.

Q. You put it in the same class then as phosphorus? [227] A. Yes, sir.

Q. Where would you class native quicksilver?

A. That is not a metal.

Q. Is it not a metal? A. No.

Q. What about native silver?

A. That is a metal.

Q. And native quicksilver is not a metal?

A. No.

Q. That is your idea of what is not a metal?

(Testimony of Morse S. Duffield.)

A. That is my idea, now.

Q. Now, this is phosphate of lime, isn't it?

A. It is a phosphate of lime.

Q. That is what it is and it is not anything else but a phosphate of lime, is it?

A. That is what it is.

Q. Now, talking about these placers, you were interested in placers before March, 1911, were you not, in placers covering phosphate deposits?

A. Before March, 1911?

Q. Yes; before March. A. I think not.

Q. Didn't you have an interest in a claim near Cokeville, placer claims on phosphate, buy an interest in with the Union phosphate people?

A. At Cokeville?

Q. Near Cokeville. A. Near Cokeville?

Q. Yes. A. Why, no; I did not.

Q. Or in the Crawford Mountains?

A. No; it was about the 27th of March.

Q. Of this year? A. This year.

Q. Is that the first you ever had?

A. That is absolutely the first I ever had.

Q. Ever had any interest in a placer location upon phosphate?

A. That is absolutely the first time. [228]

Q. All right. Now, these placer locations you have lately acquired were some which were covered also by lode locations?

A. They were on conflict with lode locations.

Q. You still have two lodes on them?

A. Yes, sir.

(Testimony of Morse S. Duffield.)

Q. Abandon the placers? A. No.

Q. Intend to abandon them?

A. I don't know. I have plenty of time to make up my mind.

Q. But you haven't determined whether you are going to abandon them or not? A. No.

Q. And you don't regard yourself as having any right by reason of your placer location, do you?

A. Well, only such right as might accrue should Congress enact any legislation on that subject.

Q. You don't consider that you are in the occupancy of any of that territory within the boundaries of the placer claims?

A. I am not abandoning any rights that may go with the placer.

Q. I am asking you if you regard yourself as possessing any rights in or possession of them as placers?

A. I think I possess just such rights as a placer location gives me; no more and no less.

Q. That is the only reason you care to give about that? A. That is all.

Q. You say some work was done in the fall of 1909 on these claims?

A. Yes, sir; I think there was a few days' work done.

Q. Do you know about it?

A. I don't know positively. I can look it up.

Q. Were you there? A. No.

Q. And anything you have stated with reference to work having been [229] done there is hearsay,

(Testimony of Morse S. Duffield.)

isn't it? A. Except for 1908.

Q. I say for 1909. For 1909, anything you have said with reference to work having been done in the fall of 1909 is hearsay?

A. Yes, sir; reports from my foreman, if you call that hearsay.

Q. You don't know anything about the work having been done personally?

A. No, sir; simply from reports of my men.

Q. And you don't know that you received any reports that work was done at that time?

A. Yes, sir; I do.

Q. You are sure of that?

A. I am pretty sure I can verify that.

Q. In the fall of 1909? A. Yes, sir.

And thereupon the further taking of the testimony in this cause was by consent of said parties, by their respective solicitors and counsel, adjourned until tomorrow morning, Thursday, the 18th day of May, 1911, at the hour of 9:30 o'clock in the morning.
[230]

Thursday, May 18, 1911, 9:30 A. M.

MORSE S. DUFFIELD et al.

vs.

SAN FRANCISCO CHEMICAL COMPANY.

At this day comes again said complainants by Messrs. Charles C. Dey and C. B. Jack, their solicitors and counsel, and the said defendant, by Mr. Jesse R. S. Budge, its solicitor and counsel also come; and thereupon the further taking of the depositions herein is resumed pursuant to adjournment.

**[Testimony of Morse S. Duffield, for Complainants
(Recalled).]**

MORSE S. DUFFIELD, plaintiff, produced as a witness on behalf of complainants, heretofore duly sworn, being recalled, further testified:

Direct Examination.

(By Mr. DEY.)

Q. Mr. Duffield, do you know Mr. Sterling and Mr. Wilson? A. Yes, sir.

Q. In company with you did they visit the grounds shown upon Exhibit 1? A. They did.

Q. When?

A. Well, I will have to look that date up.

Q. Approximately when?

A. I think it was in October.

Q. October of? A. 1910.

Q. 1910?

A. About the middle of the month, I think.

Q. Who showed them where the claims were?

A. I went over the claims with them, or showed them all the discoveries. **[231]**

Q. Of all of the claims in controversy shown on Exhibit 1? A. Yes, sir.

Q. You showed them the discovery points, did you?

A. I took them up Gertch Hollow to the discovery of the Obey and then to the north end center of the Obey and the northeast corner of the Obey and from there we started severally along the outcrop, visiting all the discoveries.

Q. Were any of the workings pointed out by you to these gentlemen? A. Yes, sir.

(Testimony of Morse S. Duffield.)

Q. All the workings?

A. All the workings that we could find.

Q. Did you acquaint them with the location of the placer locations?

A. No, sir. In a general way I gave them to understand that the placers overlaid our lodes.

Q. Who was with you at the time besides Mr. Sterling and Mr. Wilson?

A. Mr. Hoff was with us, Charles Hoff.

Mr. DEY.—That is all.

Cross-examination.

(By Mr. BUDGE.)

Q. Did you on that occasion visit simply the workings on the lode claims, that is your workings?

A. No; we went into every—went into all the workings that there were except one, except one working on the Obed.

Q. That is to say, you inspected, did you, all cuts, open cuts and all tunnels throughout the entire area covered by these lode and placer claims?

A. We inspected all the workings except that one on the Obed covered by these placer claims, and those lode claims except the Waterloo placer and the lodes on the Waterloo. [232]

Q. What was it you did not visit on the Obed?

A. A tunnel or cut.

Q. A tunnel?

A. A tunnel marked "9" on Exhibit 1.

Q. How long were you in making this inspection, Mr. Duffield?

(Testimony of Morse S. Duffield.)

A. We were there one entire day and half of the next day, until noon of the next day; a day and a half.

Mr. BUDGE.—That is all.

Redirect Examination.

(By Mr. DEY.)

Q. Do you know how stakes would become down or missing?

A. Well, there are a number of different causes after you put up stakes to cause them to be missing.

Q. On this ground? A. On this ground.

Q. What are they?

A. In some places the hillside is very steep and the snow slides a little and the earth slides a little. In some places the gulches wash them out or could wash them out and some of our stakes have evidently been deliberately destroyed and taken away.

Q. You know nothing about that, do you?

A. I have actual proof of one or two.

Mr. DEY.—That is all.

Mr. BUDGE.—That is all.

MORSE S. DUFFIELD. [233]

[Testimony of Charles Hoff, for Complainants.]

CHARLES HOFF, a witness produced by the complainants, being first duly sworn, testified as follows:

Direct Examination.

(By Mr. DEY.)

Q. What is your name? A. Charles Hoff.

Mr. DEY.—The deposition of this witness is taken by consent. He lives, I think, within a hun-

(Testimony of Charles Hoff.)

dred miles, but we will take it by consent.

Mr. BUDGE.—Oh, yes; it can be taken now by consent.

Q. What is your name? A. Charles Hoff.

Q. What is your business? A. Mining.

Q. How long have you been engaged in mining?

A. Well, off and on since about 1872.

Q. Do you know the complainants, Messrs. Duffield and Jeffs? A. I do.

Q. Been in their employ? A. Yes.

Q. For how long?

A. Since August, 1908, August 10th.

Q. 1908. How soon after you entered their employ did you visit the ground covered by these lode mining claims shown on Exhibit 1?

A. In December, 1908.

Q. Was that your first visit?

A. No, sir; not over that ground. That was my first visit while in their employ, but I had previously been all over the ground.

Q. Previously been over the ground?

A. Yes, sir.

Q. When prior? A. In 1905.

Q. Were you working there then?

A. Yes, sir; in the employ of Mr. Charles C. Jones.

Q. What was your work there principally at that time? A. Doing location work. [234]

Q. Making locations?

A. Doing location work.

Q. Doing location work for Mr. Jones?

A. Yes, sir.

(Testimony of Charles Hoff.)

Q. Do you know the claims that you were doing work on, whether lodes or placers?

A. Yes, sir; they were lodes.

Q. Lode claims on phosphate rock?

A. On phosphate rock.

Q. In December, 1908, what was the object of your going upon this property?

A. While in the employ of Duffield and Jeffs, Colbath and other men were up there I went up to the camp, and also went over the ground at the time Mr. Duffield and Mr. Sterling and Mr. Wilson, with them; I went over the ground when they measured up all the work.

Q. Was that in 1908?

A. That was in 1909, but I went over the ground ahead of the other men who had worked in 1908 while—

Q. After Mr. Sterling and Mr. Wilson?

A. How was that?

Q. After Mr. Sterling and Mr. Wilson?

A. That was in 1909, I believe.

Q. Was not that last fall, 1910?

A. Well, perhaps so that they went over it—that is right; I had been over the ground so much I got somewhat mixed up on it.

Q. Did you do the assessment work for any year?

A. In 1910, I did.

Q. For the year 1910? A. For 1910.

Q. What was the character of the work?

A. Open cuts and tunnels on each and every claim.

Q. Do you know the value of the work?

(Testimony of Charles Hoff.)

A. Yes, sir.

Q. What was it?

A. Something about thirteen hundred dollars, thirteen hundred and some odd dollars on the claims, [235] on the thirteen claims.

Q. Do you know the value of the work on each claim? A. Yes, sir.

Q. How much?

A. Not less than a hundred dollars.

Q. Was it work that tended to develop the claim?

A. Yes.

Q. Now, in 1910, when Mr. Sterling and Wilson were there, what did you do?

A. I just simply went along with them and pointed out the work that belonged to—

A. Well, just tell us briefly what you pointed out to them?

A. I pointed out the work which belonged to Duffield and Jeffs and also the work that belonged to the San Francisco Chemical Company.

Q. Can you tell by the map what work you pointed out as belonging to Duffield and Jeffs?

A. Yes, sir.

Q. Start in at the north end, please, and I think they go by numbers, and just briefly describe them.

A. There is an open cut and tunnel No. 4—you want the amount of work I done?

Q. Do you know that, did you measure it?

A. I think so. The work done in 1910—I have it in a book somewheres if I can ever find it. No. 5 on the Obey, an open cut $4 \times 6\frac{1}{2}$, thirteen feet long,

(Testimony of Charles Hoff.)

with a ten foot face.

Tunnel 4x6 seven feet—

Q. Let me ask you, Mr. Hoff. Didn't you point out to Mr. Wilson and Sterling 1, 2 and 3 marked on here?

A. Yes, sir; on the east side of the canyon.

Q. I want all the work that you pointed out to Messrs. Wilson and [236] Sterling, a general description of it. I want you to separate them as you told them?

A. Beginning on the east side of the canyon on the Obey claim, I pointed out tunnels 1, 2 and 3 belonging to the San Francisco Chemical Company.

Q. (By Mr. BUDGE.) That is 1, 2 and 3 as marked on that claim there in red figures? A. Yes, sir.

Q. Have you got the dimensions of them?

A. Not of these, I have not. I did not take the dimensions only of this other work in 1910.

Q. All right.

A. And then down to No. 4, which also belongs to the San Francisco Chemical Company, and from there to No. 5, which belongs to Duffield & Jeffs, I will now give you the correct dimensions of that if possible: open cut 4x14, ten foot face; tunnel 4x6, seven feet long; and then there is marked a stripping here as shown upon the map which was done by the San Francisco Chemical Company and some work done at the point of discovery which was used to determine, as the stripping was all about the same; it was done at the time of the discovery work, but at each discovery at the discovery, there had been work

(Testimony of Charles Hoff.)

done, location work.

Q. Tell us when you get onto a new claim.

A. All right. Now, I go on the Obed. The next work was done at No. 6, which belongs to the San Francisco Chemical Company, and then there was a continuous stripping down to No. 7 on the Obed, work done in 1910 for Duffield & Jeffs.

Q. (By Mr. BUDGE.) Was that stripping at No. 7?

A. No. Open cut 4x10, six and one-half foot face; tunnel 3½x6, ten feet long; and then there is more stripping down to [237] No. 8 with a small open cut and tunnel.

Q. (By Mr. BUDGE.) Is No. 7 Duffield & Jeffs?

A. No; that is the San Francisco Chemical Company. No. 9 is also San Francisco Chemical Company. Now we go onto the Jimtown, Duffield & Jeffs, open cut 4x10, seven foot face; tunnel 4x6, twenty feet long, No. 10.

Q. (By Mr. BUDGE.) Is that Duffield and Jeffs?

A. Duffield and Jeffs. Next we go to the Fentress; but here is 11. I omitted No. 11. It is just a small open cut.

Q. (By Mr. BUDGE.) Whose is that?

A. San Francisco Chemical Company. We get down on the Fentress to No. 12, San Francisco Chemical Company; open cut and tunnel. No. 13, Duffield & Jeffs, open cut 4x11, seven foot face; tunnel 4x6, nineteen feet long. On the Fentress there is some stripping all the way, and small open cuts along the lode, along the vein.

(Testimony of Charles Hoff.)

Q. Belonging to whom?

A. This is San Francisco Chemical Company.

Discovery of the Fentress is also in an open cut belonging to—all the rest, the discovery and the location work, belonging to Duffield & Jeffs.

Q. What is 14? A. 14 is an open cut.

Q. (By Mr. BUDGE.) Whose?

A. San Francisco Chemical Company. No. 15, open cut at discovery?

Q. Whose is that?

A. Duffield & Jeffs. 16— [238]

Q. Still on the Fentress?

A. On the Cumberland now, I beg your pardon for not telling you. An open cut 4x12, with nine foot face; and then incline 4x5, nine feet long.

Q. (By Mr. BUDGE.) You didn't tell us who that belonged to.

A. Duffield & Jeffs, No. 16. There is some striping along the vein there.

Q. Without interrupting tell who they belong to.

A. No. 17 is striping of the San Francisco Chemical Company—no; wait a minute—that is down on the tunnel. It is marked here "17" as tunnel and cross-cut, 17 and 18, tunnels and cross-cuts belonging to Duffield & Jeffs, a long tunnel; I haven't the exact dimensions of that. Passing down, or measuring along with Mr. Wilson and Mr. Sterling; No. 19 at the discovery, there is a small open cut that had been done at the time of the location by Duffield & Jeffs. Nos. 20 and 21, San Francisco Chemical Company. Nos. 22, 23, 25 and 26 were also by the San

(Testimony of Charles Hoff.)

Francisco Chemical Company. We are on the Overton lode now. 27 is also San Francisco Chemical Company and 28 San Francisco Chemical Company; 29, tunnels of Duffield & Jeffs. There is fifty feet of work done in the tunnel last year, in the old tunnel that there had been work done on before, some thirty-five or thirty-seven feet. They done fifty feet more work in that tunnel in 1910, belonging to Duffield & Jeffs. The tunnel is in the neighborhood of eighty-six or eighty-seven feet long altogether; an open cut 4x10— [239]

Q. Is this No. 30?

A. No. 30; six foot face; tunnel 31½x6, twenty-two feet long.

Q. (By Mr. BUDGE.) Whose is that?

A. Duffield & Jeffs. Another tunnel of Duffield & Jeffs that Mr. Wilson and Sterling have the measurements of. I simply took measurements of what work was there last year. That is 32. I haven't got 31 yet. There is some discovery work done, small open cut and tunnel, No. 31, Duffield and Jeffs. No. 32 is also Duffield & Jeffs, which as I said before I have not the measurement of. 33 is a stripping and an incline shaft that has been done years ago, hunting for coal. I believe that finishes the Overton. Next is the Mt. Pleasant, 34, San Francisco Chemical Company 35, San Francisco Chemical Company. 36 San Francisco Chemical Company. No. 37, San Francisco Chemical Company. 38, Duffield & Jeffs. 37 is San Francisco Chemical Company; that is right—it is Duffield & Jeffs instead of San Francisco Chemical. No. 38, Mt. Pleasant, open cut 4x6.5, by 13

(Testimony of Charles Hoff.)

feet long; tunnel 3x6, fifty feet long. No. 39, small open cut by San Francisco Chemical Company. No. 40, Duffield & Jeffs, which I have not the measurement of, made in 1908 and 1909. The next is Arkansas lode, 43 on the Arkansas—we have to skip to 43. Tunnel No. 43, Duffield & Jeffs, which I did not measure but other parties have the measurement of, done in 1908 and 1909. No. 44, tunnel by San Francisco Chemical Company. [240] No. 45—I gave you 43, Duffield & Jeffs. 44, San Francisco Chemical Company. 45, San Francisco Chemical Company. 46, Duffield & Jeffs. There is work done on that this year, open cut $3\frac{1}{2}$ x6 feet face, 8 feet long; tunnel $3\frac{1}{2}$ x6, 12 feet long; and that concludes the Arkansas lode.

Q. The next is the Hickman lode?

A. Yes, sir; there is a discovery cut on the Hickman; that is not numbered is it? That is not numbered—you simply want the numbers, I suppose? No. 47, Duffield & Jeffs; open cut 3.5 by 23 feet long, 8 foot face; tunnel $3\frac{1}{2}$ by $5\frac{1}{2}$, 8 feet. No. 48, discovery pit, Duffield & Jeffs—hold on a minute; that is a long tunnel there that I have not the measurement of, done in 1908 and 1909.

Q. (By Mr. BUDGE.) Is it or is it not a discovery pit?

A. No; that is a tunnel right by the side of the discovery No. 49 on the Maury—No/50—I will have to skip those. The next is on the Columbia lode, No. 51, Duffield & Jeffs, on the Columbia claim—tunnel. I have given you open cut, 6x5, seven foot face; tun-

(Testimony of Charles Hoff.)

nel 31½ by 6, twenty-two feet long; also tunnel No. 52, which I did not measure, but the other people measured it, belonging to Duffield & Jeffs. The next is the Wayne, 53, Duffield & Jeffs; open cut 3x7, eighteen and one-half feet long; tunnel 3x5½ and eighteen and one-half feet long. Nos. 54, 55 and 56, done by the San Francisco Chemical Company. I believe that concludes all the workings.

Q. Look again at No. 55 please, and see if you can identify that work? [241]

A. Didn't I give it, No. 55?

Q. 55, you said was done by the San Francisco Chemical Company. Is that the fact?

A. I guess not.

Q. I don't want any guessing about it, if you know say so and if you don't know, say so.

A. That is a tunnel that I run myself.

Q. What?

A. A tunnel that I run myself; I gave it to the San Francisco Chemical Company, but I made a mistake.

Q. Now, ascertain, and give us the real fact.

A. The last measurement I gave you should be for 55.

Q. Before you gave the measurement of what?

A. 53, was it?

Q. Just get it straight is all I want, Mr. Hoff.

A. No. 53 is right as I had it before.

Q. What is right now?

A. The last measurements on 53.

Q. I think you had better straighten it out now,

(Testimony of Charles Hoff.)

and if you have made any error correct it so that the notary can get what you say.

A. I have got it now: 55 was done in 1908 and 1909; that is Duffield & Jeffs work, as I remember it. I remember distinctly now the tunnel in the bottom of the hill.

Q. Any other mistakes that you have made?

A. How?

Q. Any other mistakes that you have made?

A. I don't think so.

Q. When you say the work was done by the San Francisco Chemical Company, what knowledge have you about that? A. Well, no personal knowledge.

Q. No personal knowledge? A. No, sir.

Q. What information did you have?

A. I knew that the [242] San Francisco people were working there off and on, being close by there and traveling back and forth.

Q. Well, did that include work that you did in 1905 for Jones?

A. Well, I done some work, location work on all of these claims in 1905.

Q. Did you classify that as San Francisco Chemical Company's work?

A. I did. All the work that I gave, that I gave, that I pointed out as San Francisco Chemical Company's work, that had been done by Jones and by them too.

Q. So that the fact is that all the work that you have pointed out that was done by Duffield and Jeffs, you have called work done by the San Francisco

(Testimony of Charles Hoff.)

Chemical Company? A. Yes, sir.

Q. And you have no personal knowledge, as I understand you, as to whether or not that company did the work except in part?

A. Just by knowing that they were working there and had men to work as anybody would know by observation.

Q. Well, I don't understand you. You say also it includes work done by Mr. Jones?

A. The work that I pointed out to them, yes.

Q. And the work done by Mr. Jones, you classified here as work done by the San Francisco Chemical Company?

A. Well, I suppose it all belonged to them, and therefore I gave them credit for it.

Q. Do you remember when Mr. Pitts and Mr. Brooks made the survey? A. I do, sir.

Q. Were you with them?

A. I was with them every day from the beginning to the finish.

Q. Who showed Mr. Pitts the ground?

A. I did.

Q. And the stakes? A. I did. [243]

Q. The discoveries? A. I did.

Q. In cases where the stakes could not be found, what did you do?

A. We replaced the stakes.

Q. No. Now, what did you do with reference to identifying the corner or place?

A. I had been over the ground so much I knew

(Testimony of Charles Hoff.)

where the corners were whether the stakes were there or not.

Q. That is to say, you had been over the ground previous to Mr. Pitts and Mr. Brooks being there?

A. Many times.

Q. And you became familiar with the corner stakes? A. I did, sir.

Q. And the angle stakes and the discovery stakes rather, all of the stakes, were they all standing when you went into the employ, or went upon the ground, after you entered the employ of Messrs. Duffield and Jeffs? A. Not all of them.

Q. How did you know then where the corners were when the stakes were not there?

A. Because I had previously been over the ground and also stakes or monuments of some of the claims were in position so that I knew exactly where the corners were.

Q. Previous to the time that you entered the employ of Duffield and Jeffs, but after they had made these lode locations? Is that what you mean?

A. I had been over the ground before and after.

Q. And afterwards?

A. I was very familiar with the ground before.

Q. When the stakes were standing?

A. Yes, sir.

Q. Placed by Duffield and Jeffs? A. Yes, sir.

Q. And those places that you pointed out to Mr. Pitts or Mr. Brooks or both of them as the corners, were they the corners and places [244] where the original stakes had been set?

(Testimony of Charles Hoff.)

A. Yes, sir; or very nearly so, so near that in one or two instances on the Jimtown the stake was swept out of the gulch where the creek-bed, where it was liable to be destroyed and also at the corner between the Overton and the Cumberland, the northeast corner of the Overton, and the southwest corner was set down in the creek-bed, but the stakes or corner was re-established there.

Q. Originally were stakes set down in the creek-bed? A. Yes, sir; I have seen it there.

Q. Seen it there? A. Been to it, yes, sir.

Q. Is that where Mr. Pitts and Brooks established them? A. They established it right there.

Q. Did you observe the size and dimensions and length of the original stakes? A. I did.

Q. What is the size and length and dimensions?

A. And the kind?

Q. Yes.

A. Some quaking-asps, some were pine and some were 4x4's sawed timbers, and from natural observations I would judge them to be 4½ feet long, from that to 5½, some longer. The round timber was perhaps from 5 to 8 inches in circumference—or in diameter, rather.

Q. How much in diameter?

A. 5 to 8 inches.

Q. Were there any that were less than 4 feet above the ground?

A. I did not notice any that was, that I would judge to be less than four feet; I did not measure them, of course.

(Testimony of Charles Hoff.)

Q. Were they marked as original stakes?

A. Yes, sir.

Q. How marked?

A. Marked Duffield and Jeffs, northeast [245] or southwest corner, or whatever the corner it was indicating the claim, facing the interior of the claim.

Q. Marked on the interior side of the stake?

A. Yes.

Q. In towards the claim? A. Yes, sir.

Q. Any of them hewed? A. Some of them.

Q. Well, what ones were hewed?

A. At the northwest corner.

Q. Not where they were located, but what kind of stakes, and how hewed.

A. Hewed pine, red pine stakes hewed to conform to the size, hewed enough to make it practicable to describe them.

Q. Where the marks were on those round timbers, was it hewed?

A. It was hewed so that they could do the writing on them.

Q. Were the stakes re-established each year while you were connected with Duffield and Jeffs?

A. I re-established them in 1909 myself.

Q. And in 1910, the patent survey was made?

A. Yes, sir.

Cross-examination.

(By Mr. BUDGE.)

Q. Mr. Hoff, you have been over all the ground, practically all of it, included within the placer claims of the San Francisco Chemical Company and within

(Testimony of Charles Hoff.)

the boundaries of these lode claims a great many times, haven't you? A. I have.

Q. And particularly since 1905?

A. 1905 I was and part of 1906, but not again until 1908.

Q. And as you stated you observed that the employees of the San Francisco Chemical Company were working at various places on [246] this ground. That is correct, isn't it? A. Yes, sir.

Q. Now, calling your attention to these workings described on the Obey lode claim, and within the Colcock placer as 1, 2 and 3, marked in red figures, which you said was the workings of the San Francisco Chemical Company, were any of those workings which you made when in the employ of Mr. Jones?

A. No, sir.

Q. Calling your attention to No. 4 on the Obey lode and on the Colcock placer, was that work done by you or anyone else that you know of in the employ of Mr. Jones? A. No, sir.

Q. Now, calling your attention to the Obed lode claim, and to the work done at No. 6 on the Inman placer, and which you have stated was the San Francisco Chemical Company work, was that done by you for Mr. Jones, or on his behalf?

A. No; all the work I done for Jones was right up at the discovery.

Q. So No. 6 was not done by you for Mr. Jones?

A. No.

Q. How about No. 7, which is on the Inman placer claim and within the Obed lode claim?

(Testimony of Charles Hoff.)

A. Not done by me. I done no work only at the discovery.

Q. It was not done by Jones?

A. Not by Jones.

Q. I will ask you before proceeding further if you are personally familiar with all the work that was done under the supervision of Mr. Jones?

A. Not all of it.

Q. Well, for what period of time were you familiar with it?

A. From the time Mr. Jones made lode locations on this ground.

Q. Oh, from the time he made the lode locations?

A. Yes, sir.

Q. And that was at what time?

A. In 1905, I think. [247]

Q. In 1905? A. I would not be right sure.

Q. Was there work done prior to that?

A. There was.

Q. And is any of this work as to which you testified work which was done prior to 1905?

A. I think it was done in 1905.

Q. What I want to get at is this, is any of this work, which has been designated on this Exhibit 1 by these red figures as the work performed by the San Francisco Chemical Company, was any of this work done by or on behalf of Mr. Jones, prior to his location of his lode claims?

A. Yes; there was some work done there.

Q. I mean any of this that you pointed out?

A. I don't think so.

(Testimony of Charles Hoff.)

Q. According to your best information and knowledge then, none of this work which is designated by the red figures on any of these claims was done by Mr. Jones prior to the location of his lode claims. That is correct, isn't it?

A. It is possibly No. 16 on the Cumberland and some stripping on the Cumberland; in fact, I am satisfied it was done by Jones prior to the lode locations. Also on the Overton at what we call the old claims there was a lot of work done by Mr. Jones there prior to the lode locations.

Q. No. 16 the Hickman and strippings on the Hickman? A. Not the Hickman.

Q. Yes; strippings on No. 16?

A. No; Cumberland.

Q. Excuse me; it is the Cumberland. And what else on the Overton? A. That is the old—

Q. Number what? A. No. 33.

Q. No. 33, Overton. Now, your best information is that some of this [248] work was done by Mr. Jones, or on his behalf prior to the time he made his lode locations? A. That is right.

Q. Now, was all of it done at No. 16 and 33 in this stripping? Was all of the work that now appears to have been done there done by Mr. Jones prior to the location of his lode claims?

A. Well, it seems to me—

Q. Don't you know? A. Well, I don't know.

Q. All right. Was there any other work which is designated upon this plat as work which you said was work of the San Francisco Chemical Company in

(Testimony of Charles Hoff.)

there other than 16 and 33, and this stripping done prior, done by Jones or on his behalf, prior to the location of his lode claims?

A. Except 16 and 33, not within the claims that are in conflict.

Q. Not within any of the claims that are embraced in this controversy?

A. No, sir; there was work done on the Tennessee, but that doesn't come in.

Q. But on all of these claims, these lode claims and the placer claims that are enumerated in the complaint and answer in this case, there was none of the work which you have described was work of the San Francisco Chemical Company,—that was done by Mr. Jones prior to the location of his lode claims, except what you have stated that number 16 and 33 and a little stripping? A. Yes, sir.

Q. Or some stripping? A. Yes, sir.

Q. Now, do you know whether or not—by the way, all work that Mr. Jones did do, so far as your knowledge extends, was in 1905?

A. Yes, sir; in 1905.

Q. So that if there is any work that is enumerated upon, that has [249] been described to you as the work of the San Francisco Chemical Company, which you claim might have been done by Mr. Jones, or was done by Mr. Jones, so far as is set out on this map, it is Nos. 16 and 33 and the stripping?

A. Exactly.

Q. All the other work described by these numbers and described by you in your testimony is work which

(Testimony of Charles Hoff.)

has been done since 1905 by the San Francisco Chemical Company? A. To the best of my knowledge.

Q. Yes; and as you say you have been over the claims and observed them working in various places along this deposit? A. Exactly.

Q. And you have never seen, have you, Mr. Hoff, any other persons working or digging open cuts or tunnels, or sinking shafts or doing any other sort of mining, digging or any other sort of mining operations on any of this ground, save the San Francisco Chemical Company other than Duffield and Jeffs?

A. None there besides what is shown.

Q. Now, then, calling your attention again to numbers 1, 2 and 3, as designated on the Obey lode claim and within the Colcock placer, I will ask you whether you ever made a personal inspection of those workings?

A. Nothing more than just simply to go into the tunnel.

Q. And have you been into all of these tunnels and observed all of these open cuts? A. I have.

Q. You did not, as I understand it, take any measurements at any time? A. No, sir.

Q. Can you give me the approximate length of those tunnels, numbers 1 and 2 on the Colcock placer and within the Obey lode? [250]

A. I would hate to undertake to do that and come anywheres near right.

Q. Well, have you from going into these tunnels, are you able to give your judgment as to the length of them as you would from observing any other tunnel?

(Testimony of Charles Hoff.)

A. Oh, I don't know as I could do it on the map, I could on the ground tell by observation what the tunnels are.

Q. Now, from your own recollection as to these tunnels, what is your best judgment as to their length and size?

A. I would hate to undertake to tell you.

Q. Well, I am asking you simply as a practical miner and you say you have been engaged in mining off and on, since 1872, and you surely have some judgment as to the size and length of the tunnels after you have been into and over the ground and around about there and into these tunnels on several occasions. Now, what is your judgment as to the length and dimensions or size of those tunnels, 1 and 2?

A. A man that is traveling in open cuts and tunnels on some seventy odd claims all the time, can't hardly remember exactly what this was.

Q. Have you in mind now the particular location and condition surrounding these tunnels, 1 and 2, on the Obey lode?

A. Yes, sir; one of them, No. 2 is timbered for some distance at the mouth of the tunnel.

Q. So that you have in mind now a distinct recollection of this particular tunnel? A. Slightly.

Q. Now, have you of No. 1?

A. I would not be positive on that whether it is timbered or not. I think it is though at [251] the mouth, for some distance.

Q. You have a distinct idea as to those two tunnels?

A. Yes, sir.

(Testimony of Charles Hoff.)

Q. Now, how long were they?

A. I should judge sixty or seventy feet, somewhere thereabouts.

Q. What is the size of them?

A. About 4x6 at the mouth where they are timbered.

Q. What is the average size? A. 4x6.

Q. What about No. 4, which I understand you to say is also San Francisco Chemical work?

A. That is timbered at the mouth, about 40 feet, 40 to 45 feet.

Q. What is the length? A. That is the length.

Q. 4x6? A. 4x6.

Q. What have you to say, Mr. Hoff, as to the size of this open cut No. 3, San Francisco Chemical Company's cut No. 3?

A. It was just a common ordinary open cut.

Q. What is the size of it?

A. I could not tell you that exactly. I paid no particular attention to it, as the parties that had been there with me took the measurements of all those things and I took no more thought about it.

Q. Did they take measurements of all the San Francisco Chemical Company's tunnels and cuts?

A. They did.

Q. Who took those measurements?

A. Mr. Brooks and Mr. Pitts.

Mr. DEY.—I will put Mr. Brooks on next.

Q. Now, calling your attention again to the time when Mr. Jones, or when you did work for Mr. Jones, what time of the year was it, Mr. Hoff, in the spring

(Testimony of Charles Hoff.)

or fall or summer? [252]

A. Along in the summer, I think in the latter part of June.

Q. Now, you refresh your recollection, was it not in 1904 that you did this work for Mr. Jones?

A. It might have been.

Q. Isn't it a fact Mr. Jones left Montpelier, or left that country, quit working there at least, in 1904, in June of 1904?

A. It might have been. I think that was the time come to think about it now.

Q. That is the best of your recollection?

A. Yes, sir. I have no data on that whatever, and I could not say positively, but I am pretty sure it was in 1904, instead of 1905.

Q. Now, you were present, were you, when Duffield and Jeffs made locations on these claims?

A. I was not.

Q. You had no knowledge as to where the stakes were placed by them when those locations were made?

A. Not exactly.

Q. And did you assist in making the old Jones Lode locations?

A. I was not there when the stakes were all set, but right away after, and I went over the ground several times and he showed me.

Q. You testified that you were familiar with where the stake had been placed by Duffield and Jeffs when they made the locations of these various claims?

A. Exactly.

Q. Now, were you familiar? A. I was.

(Testimony of Charles Hoff.)

Q. How did you know and how did you come to have knowledge as to where those stakes had been placed by those parties?

A. I had been shown the stakes by them and was satisfied that they were practically as near to the old location points as in many instances could be.

Q. How did you know where the old location points were, if you were [253] not there when the stakes were set?

A. With Mr. Jones, I had been over the ground.

Q. No; I say as to the Duffield and Jeffs' stakes.

A. I had been shown them.

Q. How long after they had been set?

A. In 1908.

Q. Yes; that was a year afterwards?

A. A year after they located in 1907.

Q. So you did not know where the stakes were set in 1907? A. No; I was not there then.

Q. You did not know, and when you went over the ground with Mr. Pitts and Mr. Brooks and identified certain stakes to them, you had no knowledge whether those stakes or monuments which you pointed out as corners or discovery points were corners or discovery points as they had been established by Mr. Duffield and Mr. Jeffs in 1907?

A. I had been over the ground several times with Duffield and Jeffs, and they had shown me where their corners was.

Q. But you had no knowledge—where you had pointed out to Mr. Pitts and Mr. Brooks those monuments and stakes, you had no knowledge that those

(Testimony of Charles Hoff.)

particular monuments and stakes were at the points where the original stakes and monuments had been placed by Duffield and Jeffs?

A. Only as they were pointed out by them to me.

Q. When had they been pointed out?

A. In 1908.

Q. Just a year afterwards? A. Yes, sir.

Q. And may have been moved from the original locations, for all you know? A. Possibly so.

Q. Now, what kind of stakes did you say were there when you went up upon the ground after Duffield and Jeffs had made *their* [254]

A. There was some pine and some quaking-asps and some 4x4's.

Q. Some cottonwoods?

A. No cottonwoods; it is quaking-asp.

Q. Mr. Duffield testified there were some cottonwoods. Is he mistaken about that and confused them with quaking-asp?

A. He has got the name of the timber mixed.

Q. It is quaking-asp, instead of cottonwood?

A. Yes, sir.

Q. And did you ever take any measurements of any of those stakes? A. Not only by observation.

Q. You did not measure any of the mounds, did you, the rock mounds? A. No, sir.

Q. Didn't cut any of those stakes yourself?

A. No, sir.

Q. Now, in 1908, I understand you went into the employ of Messrs. Duffield and Jeffs on the 10th day of August. Is that correct?

(Testimony of Charles Hoff.)

A. That is correct.

Q. Do you know whether or not the stakes as they had been originally set were moved or replaced between August, 1908, and November, 1908?

A. I don't know anything about that.

Q. You don't know? A. No.

Q. Well, what is your best information as to whether or not the stakes which were there in August were the stakes which were there in November?

A. A great many stakes had been knocked down in various ways, some moved entirely, and every time that any of the employees went over the ground we endeavored to replace them.

Q. But have you any distinct recollection that between August, 1908, and November, 1908, that there was any replacement of stakes or [255] change made in the stakes?

A. Not that I know of. Mr. Colbath was on the ground at that time and had charge.

Q. Do you remember, in 1910, in April, that you did assessment work or went up to do assessment work upon those claims? A. I do.

Q. Did you have any conversation at that time with Mr. Groo, the foreman of the San Francisco Chemical Company? A. I did.

Q. What was it, Mr. Hoff, and where?

A. On the Overton claim?

Q. Yes.

A. I was there with my camping outfit putting up *and* fence and Mr. Groo came along and says, "Mr. Hoff, I want to notify you that you are trespassing."

(Testimony of Charles Hoff.)

I says, "That is all right." And he says, "If you continue to do any work here, you will be yourself held responsible as well as your company," and I told him that I was here to do as my company told me to do the *same* *he* was, and supposed they were able to take care of me and I proposed to go ahead and do the assessment work that is what I was sent there for. That is all the conversation there was.

Q. Did you do the work at that time? A. I did.

Q. Did you remain right on the ground?

A. I did.

Q. You did not go off of the ground at that time?

A. No, sir. I camped, stayed there until we got through in August.

Q. Did you remain there with the camp?

A. Off and on all the time.

Q. Isn't it a fact you left the ground immediately after this conversation? [256]

A. No, sir; my outfit was right there.

Q. I say personally didn't you leave the ground and go down town and stay there for some days?

A. No, sir; I was on the ground every day after the camp was pitched.

Q. And proceeded with your work? A. I did.

Q. Isn't it a fact that you took the matter up with your employers?

A. I wrote them a letter but I never stopped work.

Q. You inquired what you should do under the conditions?

A. I told them that I had been notified.

Q. You told them you had been notified?

(Testimony of Charles Hoff.)

A. Certainly.

Q. And asked whether you should proceed with the work?

A. No; I did not ask; I proposed to continue to work until I was stopped, is all.

Q. You didn't ask whether you should proceed with the work?

A. I simply told them Mr. Groo had notified me I was trespassing, and if you want the exact language of the letter, I think I can give you that.

Q. Well, I don't know that that is particularly material unless you care to give it, but what I am trying to get at is whether or not you continued with the work after you had had this conversation with Mr. Groo, or whether you left the premises and only resumed work upon further instructions?

A. Well, I can positively assure you I never stopped for a minute.

Q. Did you do any work that day other than to set up your tent?

A. Nothing more than to set up the tent, had men doing that.

Q. And worked the next day? A. Yes, sir.

Q. On what claim?

A. We started in on the [257] Overton.

Q. Who was with you, Mr. Hoff?

A. Mr. Cousins, Mr. Sampson and John Lindsay.

Q. At the time of this conversation?

A. Oh, Mr. Lindsay was the only one that was with me; he was putting up the tent.

Q. Who was with Mr. Groo?

(Testimony of Charles Hoff.)

A. I could not tell you the name, I think settlers, but I am not positive, and I did not know them well enough to remember their names.

Q. You have seen Mr. Groo and his men and the other employees of the San Francisco Chemical Company working in these various tunnels and cuts along this property? A. I have.

Q. From time to time and year to year as you have been over the ground back and forth? A. I have.

Q. These workings which you have described and which are set forth on exhibit 1 as 1, 2, 3, etc.?

A. Yes, sir.

Q. Now, Mr. Hoff, this exhibit 1 does not represent all the cuts, etc., which have been made and excavated by the San Francisco Chemical Company, does it?

A. I hardly think so; they have done work this year since—

Q. Haven't they done work there that is not shown here? A. Possibly so.

Q. As a matter of fact, isn't it true, Mr. Hoff, by your knowledge of the ground and being over it a great many times, that on some of these placer claims there are twenty or twenty-five or thirty cuts in addition to what has been shown here all the way along the deposit? A. Possibly so.

Q. Don't you remember that to be the case?

A. Yes, sir; that is about the case. I can show it to you on the Mt. Pleasant. [258]

Q. On the Mt. Pleasant, and for that matter all the way along on the Wonder and the Winter and the

(Testimony of Charles Hoff.)

Winfield and out here on the Colcock, and Overton also and there was twenty to twenty-five or thirty cuts that have been made by the San Francisco Chemical Company that are not shown on this plat at all? A. Oh, yes; there must be that.

Q. On each of these claims? A. Yes, sir.

Q. Do you know Mr. Glenn of Montpelier and Mr. Brennan? A. I do.

Q. And were you familiar with the particular property there that they had an interest in at one time, right along there on the north side of the creek?

A. I am.

Q. And do you know how that land was taken by them in the first place?

A. I don't know anything about it.

Q. You have no knowledge about it?

A. I don't know anything about it.

Mr. BUDGE.—I think that is all.

Redirect Examination.

(By Mr. DEY.)

Q. Mr. Hoff, you on cross-examination stated that the stakes were knocked down in various ways. I wish you would explain what you mean by that.

A. Well, the stakes were knocked down by cattle, sheep and the elements, cloud bursts in Gertch Hollow removed some of the stakes, also in the main Montpelier Canyon slides of rock caused by cloud bursts covered up one in particular that I know of, or removed it in the high water, and other cases it apparently looked as though the stakes had been carried away, for they could not have gone five or six

(Testimony of Charles Hoff.)

[259] hundred feet up on the mountain on different claims from the ones that they were supposed to stand on.

Q. Now, what instance of that kind have you in mind?

A. I found a Jimtown stake that had been used up here on the Obey a 4x4, that had been split with a pick and used in an incline with Duffield and Jeffs name on it.

Q. Whose incline? A. What?

Q. Whose incline?

A. On the San Francisco Chemical Company's claim.

Q. Go ahead.

A. Also the discovery of the Jimtown after I replaced it myself, a 4x4, was found one hundred feet down the mountain in a bunch of maple brush; it did not get there without hand; if it did, I don't see how it could do it and a great many cattle and sheep were destroying and knocking down the stakes in other respects.

Q. Take exhibit 1 in so far as the lode claims with the placers on it, was there other work, underground or surface workings that are not shown upon these claims that you have in mind? A. I think there is.

Q. Well, just point them out. Let us find out.

A. On the Mt. Pleasant there is a series of small open cuts coming along there on the side of the hill. These cuts, the tunnels and open cuts that is perfectly well seen from the canyon road as you go up, and

(Testimony of Charles Hoff.)

shows very plainly. All of them cuts don't come in there.

Q. Where are they?

A. And it is possible that there is an open cut where that had slid in, that Mr. Brooks and Mr. Pitts and myself did not think would cut much figure, [260] and therefore we paid no attention to it, but the work was done, and from the elements, the rain and storms of winter, they had caved in so they did not look as though that any work to amount to anything had been done.

Q. They were open cuts that had been?

A. Had been. That is the idea.

Q. Now, you were there to show Mr. Pitts and Mr. Brooks the property and the work done?

A. Yes, sir.

Q. To make this plat? A. Yes, sir.

Q. Now, didn't you show them all of it?

A. Yes, sir; as I stated before, showed them all the work but it caved off and we didn't make measurements and put it on the map.

Q. On cross-examination the work you have referred to as not being placed upon the map would be old surface strippings which had been since filled in?

A. Certainly.

Cross-examination.

(By Mr. BUDGE.)

Q. Well, do you mean to say, Mr. Hoff, that all of these various open cuts, all the way along this property to which you have testified, are simply open cuts that had been filled in?

(Testimony of Charles Hoff.)

A. Why, the travel of the sheep and the horses and cattle and the elements have naturally filled them in.

Q. Aren't there dozens of open cuts, and as I stated before, from twenty to forty cuts on the claim, the work of the San Francisco Chemical Company, that are not filled in?

A. Not entirely filled in.

Q. Aren't they well defined cuts, dozens of them?

A. No; I would not say there was dozens of well defined cuts, [261] defined enough so that you would know that work had been done there. That is all.

Q. But cuts which had simply been in a condition which had been slightly changed, the appearance of which had been slightly changed simply from the fact that perhaps a sheep herd had gone over them?

A. Certainly.

Q. But otherwise they were cuts and showed that considerable, a great deal of work had been done throughout those various cuts?

A. Certainly; they showed that work had been done.

Q. Now, there was no work that was done by Duffield and Jeffs, either by way of open cuts or tunnels, that is not shown on this Exhibit 1. Is that true? A. I don't think there is.

Q. In other words, this map shows all work of Duffield and Jeffs, don't it? A. Certainly.

Q. And it does not show but a small proportion, or shows only a small proportion of the open cut work of the San Francisco Chemical Company. Isn't that

(Testimony of Charles Hoff.)

true? A. Yes, sir; that is true, that is true.

Q. Now, when you say, Mr. Hoff, that some of these stakes were carried away, of course, you don't know and don't presume to say by whom they were carried away? A. No; I don't know.

Q. It may be that some person—

A. A sheep herder.

Q. Yes; might have carried this Jimtown stake up to wherever you say that was carried?

A. Up on the Obed.

Q. On the Obed lode claim and that it had been laying around there in the sage brush and perhaps got cut in two by a pick and used [262] because it was considered to have been no— A. Oh, no.

Q. No longer useful. How about that?

A. It was simply to show you that the stakes had been moved from their place.

Q. Yes; but I say it might have happened in that way.

A. Yes, sir; certainly; I would not accuse anybody.

Q. You would not say that Mr. Groo or any of his men tore those stakes down? A. No.

Q. Or any other employee of the San Francisco Chemical Company? A. No, sir.

Q. The mere fact in those two instances you cannot account for the position in which those stakes were found, save and except that somebody must have carried them somewheres— A. Yes; exactly.

Q. *Is all* there is of it? A. That is all.

Q. What was it you said was the condition here— I didn't quite understand you?

(Testimony of Charles Hoff.)

A. At the Mt. Pleasant?

Q. On the Mt. Pleasant.

A. There is a series of open cuts which can be seen very plainly from the wagon road; anybody can see them along in here close to these tunnels. This is in with them; these don't show on the map.

Q. What is in with them?

A. The tunnels, the tunnels that are there is in this group of open cuts and the tunnels which I explained was not on this map—they are right in there; here are some.

Q. They are all shown, all the open cuts that are there are all shown? A. That is right.

Q. Is that work of Duffield and Jeffs?

A. No, sir. [263]

Q. That is the San Francisco Chemical Company?

A. Yes, sir; that is what I referred you to.

Q. So that they are on the map Exhibit 1?

A. Right there.

Q. That is it right there then?

A. Yes, sir; that is correct, right there. I did not see them then when I spoke about it before. My sight is not good without my glasses on.

Q. Now, if Mr. Jones left there in 1904, in June, which you stated, I think, was to the best of your recollection, June, 1904— A. I think so.

Q. Now, when was it then you did the work? Was it the summer before that in 1903, the latter part of the summer of 1903 when you did work for him?

A. No, sir; I done the work when he done all the old locating.

(Testimony of Charles Hoff.)

Q. The old locating? A. Exactly.

Q. And what year was that?

A. That was in 1904.

Q. In 1904? A. Yes, sir.

Q. In the summer? A. Exactly.

Q. Following the time he left Montpelier, he came back later and then is when you did the work?

A. Then is when I done the work.

Q. Did you assist in locating these lode claims with Mr. Jones? A. No.

Q. I understood you to say that you put up some stakes.

A. I re-established some of the Duffield and Jeffs stakes.

Q. No; I am asking you about the Jones locations in 1904. A. Not on the Montpelier claims.

Q. Did you have anything to do with them at all?

A. Only doing location work after they were staked. [264]

Q. Did you observe the manner in which they were staked? A. Yes, sir.

Q. And did you see the notices and so on?

A. Yes, sir.

Q. And the stakes. What is your best judgment as to whether those stakes and monuments and discovery points and so on were sufficient and valid to conform to the requirements of locating claims?

A. I think they complied with the requirements of the law all right.

Redirect Examination.

(By Mr. DEY.)

Q. Will you please look again at Exhibit No. 1 and

(Testimony of Charles Hoff.)

see if that, so far as the lode locations are concerned, whether or not there is not shown all the openings in the ground that existed last July, July, 1910, that were then open.

A. I believe I can tell without looking at the map. I know Mr. Brooks was very particular in getting all this work when he was there, but nevertheless there is such a series of pits and open cuts dug along and so many sheep and cattle had traveled over them, so much that I hardly thought it worthy of making mention of on the map, and there was some that was overlooked.

Q. In what condition were they last July?

A. They looked as though there had been work done there and had been filled up by the travel of sheep and cattle and the elements and the storms and everything of that kind.

Q. So that they were not open at that time?

A. No; I would not call them open. [265]

Cross-examination.

(By Mr. BUDGE.)

Q. Do you mean that that condition was true as to all these twenty or thirty cuts on all these claims?

A. I mean that they was not cleaned out or showed up to the extent of what they was intended to be showed.

Q. You don't know as to what the intention was, do you? Now, do you mean to say that these various cuts were not—what you term open cuts of these twenty or thirty, that are on every claim, every claim belonging to the San Francisco Chemical Company,

(Testimony of Charles Hoff.)

or claimed by that company, that those were not open cuts, those that are not shown on this map?

A. Well, they were intended for open cuts.

Q. So the intention was that they were open cuts. But as a matter of fact, they were cuts, a great many of them which had been—work on which had been done during the previous year, a great many of them? A. Stripping and open cuts.

Q. The previous year some of them?

A. Certainly.

Q. Yes; and that was true as to the cuts which occur all the way along this deposit throughout these various claims here? A. Certainly.

Q. Now, as a matter of fact, Mr. Hoff, wasn't there some tunnels, open tunnels which are not shown on these maps? A. I don't think so.

Q. Are you sure of that?

A. Well, I would not be sure of that, but I don't think there is.

Q. So that from your examination on this Exhibit 1, you would not be positive but what there are even tunnels that are not shown?

A. There may possibly be, but I don't think so.

Mr. BUDGE.—That is all. [266]

Redirect Examination.

(By Mr. DEY.)

Q. Isn't there a stripping shown on Exhibit 1?

A. Oh, yes; lots of it.

Q. Is there any that is not?

A. There may be a little on the Fentress that is not shown.

(Testimony of Charles Hoff.)

Q. (By Mr. BUDGE.) That is not shown?

A. That is not shown.

Q. There may be a little on the Fentress?

A. On the Jimtown there is no stripping; it is open cuts there.

Q. That is not shown?

A. Oh, no; it is shown.

Q. I am asking you that which is not shown.

A. None, only on the Fentress here and on the Overton. There may be some open cuts that have all caved in that was not measured.

Q. Mr. Budge says there were twenty to thirty to the claim. Is that what you say?

A. No; I would not say that there is twenty or thirty.

Q. What do you mean to say as to strippings or open cuts last July not shown on Exhibit 1?

A. There might possibly be eight or ten along the lode all the way that is not shown, small open cuts there or strippings or something of that kind, but there is a series of strippings which I think Mr. Brooks took it as a series of strippings.

Q. Are they the ones that were filled up in the manner you have described? A. Certainly.

Q. Can you give the dimensions?

A. No; I could not give the dimensions. I did not take the dimensions. Mr. Brooks has the dimensions of all of them, and therefore I paid no attention to it. [267]

Q. Mr. Brooks took the dimensions of all of those you are now referring to? A. Exactly.

(Testimony of Charles Hoff.)

Cross-examination.

(By Mr. BUDGE.)

Q. Now, calling your attention to that Jimtown lode, Mr. Hoff, isn't it a fact there are open cuts strung all the way along the Jimtown and making a hole almost like a wagon road?

A. No, sir; not all the way.

Q. Well, for a considerable distance along that Jimtown that is not shown on Exhibit 1?

A. From this end line?

Q. Yes. Which end line? The south end?

A. The south end line of the Jimtown along into the hollow there near the discovery there is a stripping for some distance; I would not like to say how much.

Q. Aren't there open cuts?

A. Well, it is open cuts—was at one time, but looks like a stripping now.

Q. Was open cuts? A. Yes, sir.

Q. And in other places there are similar conditions? A. Certainly.

Q. So that all the way along this deposit there are open cuts similar to what you found on the south end of the Jimtown, open cuts which you have termed in one sense strippings, but open cuts nevertheless, that there are open cuts such as this all the way along these claims that are not shown upon this map?

A. Yes, sir—not all the way along.

Q. Oh, no; I don't mean to say that they are altogether there in a string. A. Certainly.

Q. But at intervals? A. There might be.

(Testimony of Charles Hoff.)

Q. Are there not—

A. I would not say there were not. [268]

Q. Don't you know that going over this ground that is the fact?

A. Once in a while we missed some, we did not make a note of.

Q. I am asking you if you don't know from going over this ground that that condition does exist from time to time all the way along and at intervals all along this deposit, open cuts such as there are on that? A. I would not say that I did know.

Q. And you wouldn't say that you don't know?

A. Yes; that is the idea.

Redirect Examination.

(By Mr. DEY.)

Q. How large an opening is there that is not shown on the map, surface opening?

A. I could not answer that question.

Q. Well, what is your best recollection?

A. I paid no attention to that because Mr. Brooks was taking the measurements of all that work and I gave no heed to the size or anything about it.

Q. Do we infer now that he has omitted some that you recall? A. Possibly.

Q. Now, how large were those openings?

A. I can recall one on the Overton where it was nothing but slide rock.

Q. On the Overton, and how large?

A. As to the measurements I could not—

Q. You could not say what it would measure, or how large it had been or was at the present time?

(Testimony of Charles Hoff.)

A. I paid no attention to it and did not think it worthy of measuring; still at the same time you could see there had been quite an amount of work done.
[269]

Q. Now, Mr. Hoff, isn't it a fact that that slide rock that you refer to is outside of the boundaries of the lode? A. Oh, no.

Q. On the claim?

A. In the condition of the mountains, sometimes we have slide rock coming down from the mountains; that is the condition of it; it runs right over the lode, which occurs beyond the Overton.

Q. Well, there is work—there has work been done there within the boundaries of the placer but outside of the exterior boundaries of the lode claims, has there not?

A. I don't know of any work being done outside of the exterior of the lode claims on the placer claims.

Q. You don't know of any?

A. With the exception, I will say, only by observation across the canyon, I think on the Colcock placer, on the east side of the canyon, you can see where there has been a series of open cuts which is done on the Colcock placer.

Q. There is a tunnel on the Mt. Pleasant, there is a tunnel on the Winslow placer, isn't there?

A. All within the boundaries of the lode claims.

Q. That is not within the boundaries of the lode claim? A. I don't know of any.

Mr. DEY.—That is all.

Mr. BUDGE.—That is all. [270]

* * * * *

[Testimony of Guy Sterling, for Complainants.]

GUY STERLING, a witness produced by complainants, being first duly sworn in this cause, to tell the truth, the whole truth and nothing but the truth, deposed and testified as follows:

Direct Examination.

(By Mr. DEY.)

Q. What is your full name?

A. Guy Sterling. [293]

Q. Where do you reside? A. Salt Lake City.

Q. What is your profession?

A. Civil and Mining Engineer.

Q. Where were you educated for your profession?

A. Cornell University, and study since I graduated.

Q. What year did you graduate in? A. 1887.

Q. Since that time have you followed the practice of your profession? A. Yes, sir.

Q. Where?

A. You mean with reference to mining engineering, or both that and civil engineering?

Q. We will limit it to mining engineering.

A. In mining engineering my practice has been in Utah, Idaho, and the western states.

Q. Ever since 1887? A. No; since 1898.

Q. To what extent generally?

A. Well, I have been a Deputy Mineral Surveyor since 1899, I think, and have made mine examinations and mine surveys in private practice since then, comprising metal mines in this state, and also iron deposits in this state.

(Testimony of Guy Sterling.)

Q. Have you any experience in phosphate deposits? A. I have.

Q. In the west?

A. I have been engaged off and on in the study of these phosphate deposits in the northern part of Utah, I think since 1906 or 1907, off and on.

Q. And how extensively?

A. I have been all over the Crawford Mountain area.

Q. Where is that?

A. That is in Rich County, in the northeastern part of Utah; and I have been over these claims here, shown on Exhibit No. 1, and over some ground near Raymond Canyon, which I think comprises the China and Japan lodes [294] and the Fryerson lodes.

Q. In what capacity have you had occasion to make examinations of phosphates generally?

A. On the Badley claim, in the Crawford Mountain area, I was called upon by the Government to make reports there in regard to the mode, occurrence and general geologic conditions there, with reference to these phosphate deposits, and studied that ground pretty thoroughly.

Q. How extensive is the district in which these deposits, as shown on Exhibit 1 and Exhibits "A" and "B," occur?

A. In the whole occurrence, so far as I know it—

Q. In that and the surrounding districts.

A. Well, my acquaintance covers, you might say it actually does cover the ground from the Obey lode to the southern end of the Crawford Mountains, and

(Testimony of Guy Sterling.)

I imagine the deposits between those two extremes would probably be in the neighborhood of ninety miles; I have not measured that, but I presume it is about ninety miles from the southern end of the Crawford Mountains to this Obey lode above and north of Montpelier.

Q. (By Mr. BUDGE.) About ninety miles?

A. I have not measured it, but that is my estimate.

Q. The Obey and other lode claims shown on Exhibit 1, are in the Crawford Mountains, are they?

A. No, sir. The Crawford Mountains are south-erly of this from sixty to ninety miles, I should say, and are in Utah, while the Obey lode is in Idaho, north of Montpelier.

Q. In what range of mountains?

A. Well, I really don't know whether this area is called the Bear River Mountains or not, but I think probably they are a part of the Bear River [295] Range, but I am not sure of that.

Q. You heard it named here yesterday, the Preuss?

A. Preuss? Yes; I believe that is probably right.

Q. Called the Preuss Mountains. Now, what is the mountain range where the China and Japan lodes are situated? A. That is the Sublette Range.

Q. From your examination and investigation, is there a general similarity in the formation and nature in which the phosphate occurs throughout the territory?

A. Yes, sir. I think it was in a general way, I think it was similar and alike throughout, and I think it is unquestionably all within one geological

(Testimony of Guy Sterling.)

formation, the same throughout.

Q. I wish you would then, in general, describe the nature, formation and characteristics of the phosphate deposits throughout this territory that is just referred to.

A. To answer that question, if you will permit it, I have a statement that I prepared on that very question in the spring of 1908.

Mr. DEY.—If there is no objection to it you can read it.

Mr. BUDGE.—We object to that as incompetent.

Mr. DEY.—If there is any objection you may use it to refresh your recollection.

Q. You have prepared a statement of the general characteristics?

A. The part I was going to use applies in general, and does not apply particularly to any one section, in answer to your question.

Q. And is technical in its nature?

A. Yes, sir; somewhat. [296]

Q. Somewhat technical.

Mr. DEY.—Do you still object?

Mr. BUDGE.—Yes; I would prefer to have him describe it himself.

WITNESS.—This is my own statement, and I simply desire to use it because it was more carefully and systematically stated than I would undertake to do it from memory.

Q. There can be no objection, of course, to your refreshing your recollection in answering the questions with that aid.

(Testimony of Guy Sterling.)

A. This deposit of phosphate rock consists of a series of bedded veins of rock containing varying proportions of calcic phosphate—

Q. (By Mr. BUDGE.) You are reading, are you not? A. Yes, sir.

Mr. BUDGE.—For the purpose of the record, we object to the witness reading the report, on the ground that it is incompetent.

Q. You may use it to refresh your recollection, and proceed to answer the question.

A. The individual veins of the series of veins vary in thickness from a few inches to ten or twelve feet. Only a portion of the veins contain rock sufficiently rich in calcic phosphate to be of commercial value, and only a portion of the veins are thick enough to be profitably mined, even when the contained proportion of calcic phosphate is sufficiently high.

Pure calcium phosphate is a chemical combination of phosphorus calcium and oxygen in the following proportions:

Phosphorus.....	20 per cent	
Calcium.....	38.7	“
Oxygen.....	41.3	“ [297]

Calcium phosphate is a mineral substance widely but sparingly disseminated, and an essential but subordinate constituent of many plants, and of all higher animal structure.

Q. (By Mr. BUDGE.) You are still reading, are you, Mr. Sterling?

A. Not absolutely reading it; some of it I am putting in that is not here.

(Testimony of Guy Sterling.)

Q. (By Mr. BUDGE.) Some you are reading?

A. Some I am reading, and some I am not.

Mr. BUDGE.—We make the same objection to this.

A. The mineral apatite is a crystalline variety of calcic phosphate, while the variety found in the veins of this lode location is massive in form, that is uncrystallized, but may be properly termed phosphorite.

Q. You say the veins of this lode location. I am asking you generally, without reference to any specific locality.

A. You ask me what?

Q. Generally throughout this territory that you are familiar with?

A. This is the general description of the whole deposit.

Q. Proceed.

A. Physically, the higher grade vein rock occurring in the veins of the lode claim on this deposit is grayish, bluish-black. It is homogeneous in appearance, and is composed of small colitic rounded grains, cemented together by an extremely thin film of probably calcite and silica. The high grade of vein rock weighs about 180 pounds to the cubic foot. The low grade vein rock is softer and lighter, and is composed of smaller grains, and ranges in color from light brown to intense black. Rock containing above 70 per cent of calcic [298] phosphate, that is, 14 per cent of phosphorus, is, under present conditions, classed as high grade rock. Rock containing 50 per cent to 70 per cent of calcic phosphate is classed as

(Testimony of Guy Sterling.)

low to good grade. The vein rock as mined is known commercially as phosphate rock. Its value depends essentially, and almost solely upon the contained proportion of phosphorus, although commercially the rock is generally classified according to its contained percentage of calcic phosphate. Taken as a whole, the above mentioned series of bedded veins of phosphate rock, and also each of the individual or separate veins of the series, lies between, is conformable to and is bounded by walls of rock, which wall rock is generally limestone, but often is a very silicious or cherty limestone, or a soft sandstone, or a shale, or perhaps a quartzite.

In general the walls and veins of the deposit conform to each other, and while the dip varies from a foot to practically vertical, the strike is generally northerly and southerly. The course of the veins may be traced by the detached pieces of phosphate rock lying on the surface and along on the apex of the vein. From the position of the hanging and foot walls of the series of the veins, I estimated the thickness of the series of veins, taken as a whole, to range from 30 to over 100 feet. The individual veins of the series of veins of phosphate rock are separated from each other by strata of limestone, chert or shale, and these separating strata or walls vary in thickness from less than an inch to several feet. Taken as a whole, the series of veins lies [299] between and is clearly limited and defined in extent and position by solid, massive walls of hard, silicious limestone.

Within the series of veins, the separating strata

(Testimony of Guy Sterling.)

limit and define the extent and position of the corresponding individual veins of the series, and are the walls of those individual veins, and the strike and dip of the veins and walls conform to each other throughout the whole deposit. I thus find that taken separately or as a series, that is, as a whole, the veins are obviously in place between walls, have a well-defined dip and strike, and are an essential part of the mountain on which the deposits occur.

The most striking feature of the surface indications along the deposit is the frequent, prominent, and often precipitous outcrop of the hanging or foot wall formation of the series of veins. The line of demarcation between the veins of phosphate rock and their walls of limestone, shale or chert, is sharply defined and distinct. In other words, the vein rock terminates and the wall rock begins abruptly, and the distinction between the phosphate rock of the vein having commercial value due to its contained percentage of phosphorus, and the wall rock having no commercial value, is readily determined by visual inspection.

Chemical analysis shows that the limestone and chert walls of the veins of phosphate rock contain from one to two per cent, and occasionally as much as ten per cent of calcic phosphate, that is, from .2 of one per cent to 2 per cent of phosphorus, as in fact many deposits of limestone and other rocks do, but such rock has no present value whatever on account of its [300] contained percentage of phosphorus.

(Testimony of Guy Sterling.)

The veins of phosphate rock are mined in the same manner that is followed in mining other veins of valuable ore, containing gold, silver, copper, etc., that is, the locus of the series of veins or of any vein of the series is determined by the dip and strike of the vein or veins, and the veins are explored and the vein rock extracted by means of tunnels, drifts, shafts, etc., care being taken to exclude the wall rock from the vein rock, as the latter is mined.

The limestone strata forming the walls of the bedded veins of phosphate rock, and the veins themselves are sedimentary in origin, and probably belong to the upper carboniferous formation. The existence of the veins of phosphate rock may be accounted for by supposing that a bed of limestone originally occupied the position of one of the veins of phosphate rock, and that the bed of limestone was covered, while in its original horizontal position, with a bed of animal and vegetable remains, shells, excrement, and other material containing free phosphoric acid, and soluble phosphates. Water percolating from above through this mass carried the phosphoric acid and soluble phosphates down to the underlying bed of limestone. By the contact of the phosphoric acid and the soluble phosphates with the limestone, chemical action was brought about, resulting in the formation of a bed of calcic phosphate, where originally was a bed of limestone. In the course of time other beds of limestone and calcic phosphate were successively and alternately deposited one above the other through the entire series of veins. [301]

(Testimony of Guy Sterling.)

Consolidation and concentration of the beds of calcic phosphate thus formed were brought about by the pressure of subsequently deposited formation. After being continued for an indefinite period this process was followed by a series of uplifting and folding movements, which finally brought the veins or beds of phosphate rock and their limestone walls to their present position and condition. That covers a description of the general deposit, and takes up everything except the assays of phosphate rock.

Q. Does it require any treatment?

A. Yes, sir; of course, in order to separate the phosphorus from the rock it requires a chemical treatment, and in order to prepare the phosphate rock for fertilizer purposes it is almost universally the custom to treat that with sulphuric acid to get the phosphorus in soluble form so that plants can take it up.

Q. What is the mineral substance termed?

A. The phosphorus?

Q. Yes. A. Repeat the question.

Q. What is the mineral substance? What is the term of that, for the mineral substance?

A. The term?

Q. Strike that out. Is this classified as ore?

A. Phosphate rock, yes, sir, where it is of commercial value or is liable to be of commercial value.

Q. Directing your attention now to the lode claims shown by Exhibit 1, when did you visit that vicinity?

A. I will have to refer to my notes for that. We began the examination of the Obey lode on October

(Testimony of Guy Sterling.)

29th, 1910, and we continued on the 30th, and proceeded down to the Wayne lode. [302]

Q. Who was with you?

A. Mr. Wilson and Mr. Duffield and Mr. Hoff.

Q. Were there any surface indications of ore?

A. Of ore?

Q. Yes. A. Yes, sir.

Q. Just describe them throughout the claims.

A. Well, in a general way we saw exposures of phosphate rock in digging, and also by the mere stripping of the outcrop of the veins throughout the entire thirteen claims shown on this Exhibit No. 1.

Q. Throughout the entire length? A. Yes, sir.

Q. Now, you started in, did you, at the Obey?

A. Started in at the Obey lode.

Q. Now, Mr. Sterling, in your own way, please start in with your examination there, and describe the nature, formation and characteristics of the ore deposits throughout all of these claims.

A. Well, we began at the north end of the Obey lode; we went to a tunnel which we designated as Tunnel No. 1—I would not be always sure that our numbers corresponded with those numbers upon the map, but I will give the dimensions as we estimated them in a rough way here as being those of the workings, and all of our bearings are magnetic bearings.

We commenced at Tunnel No. 1, which had a bearing of south 73 degrees east, and a length of 60 feet, and in this tunnel found a vein of black phosphate rock that had a dip of 30 degrees to the west, and a strike south 10 degrees east.

(Testimony of Guy Sterling.)

We then went to Tunnel No. 2—

Q. Does that cross-cut the phosphate vein? [303]

A. Practically; yes, sir.

Q. Can you describe the vein there any more?

A. That is all the information I have on that, except there was a vein there of black phosphate rock, which appeared—I haven't got the width and thickness of it.

We went to Tunnel No. 2.

Q. You can state from your recollection, can't you?

A. I think, although I won't be absolutely positive to it, and of course it is so long since I was there, that I have forgotten some of the details,—but my impression is that the tunnel was all in phosphatic material, but I don't think the limitation of that particular vein was clearly shown, although the bedding planes were shown.

Q. Anything shown in the way of walls?

A. I don't think there were any walls shown in that tunnel.

Q. Was that tunnel driven in the direction of the course of the vein, or across it?

A. The vein appears, as I have said, dips to the west; so that even if this tunnel No. 1 was driven on the vein, and as the tunnel has an easterly direction, of course it would cross-cut the tunnel or the veins if it went into them at all.

Q. Well, give the full information as you proceed.

A. We then went to Tunnel No. 2, which had a magnetic bearing of 40 degrees east, and a length of

(Testimony of Guy Sterling.)

about 50 feet. In this tunnel the dip was flat and indefinite, and the phosphate rock was of a black shaly nature, and the entrance to the tunnel was mostly in wash, but the wash was discolored and seemed to be decomposed phosphate rock. [304]

We went to Tunnel No. 3, estimated to have a length of 50 feet, magnetic bearing north 45 degrees east. In the face of this tunnel there was some low grade phosphate rock and some chert and shaly limestone in place. This chert and shaly limestone was unquestionably a wall of that particular vein of phosphate rock that showed there in the face of the tunnel, and the dip of this was 25 degrees westerly, and had a strike of south 15 degrees east magnetic.

We then went across Gertch Hollow, which there drains to the southeast, and went to Tunnel No. 4. This tunnel had a bearing of south 10 degrees east magnetic, estimated to be 55 feet long, and was driven approximately on the strike of the phosphate vein. In this tunnel we observed good phosphate rock on the side of the tunnel; in the roof it showed a limestone wall and shaly phosphate rock in place—that is, both the limestone and phosphate rock were in place. In the face of the tunnel there was some more phosphate rock in place, and it had a dip of 27 degrees to the southwest. We went to cut No. 5. This was 18 feet long and had an 8 foot face, and was driven on the outcrop of the beds of phosphate rock, which outcrop shows along the side of the hill, one of the beds of phosphate rock being exposed. Some of it showed a high grade rock and veins or beds of

(Testimony of Guy Sterling.)

from 4 to 5 feet thick. In one place there was three beds of material shown. In this cut the veins had a dip of 40 degrees westerly, and a strike of south 15 degrees easterly. Cut No. 5, that is [305] this cut, cross-cuts the veins and shows one vein of good phosphate rock 5 feet thick.

We then went to the Obey discovery, and found here an irregular cut showing black phosphate rock, apparently low grade, in place, having a course and dip and strike as heretofore shown.

There was a solid limestone footwall shown, and was also shown in the cuts before referred to on the Obey lode. From the examination of the surface I estimated there that the series of beds of phosphate rock was about 60 feet thick.

From Tunnel No. 4 to the Obey discovery, which I estimated to be 400 to 450 feet, the lower part of the phosphate beds, or series of beds, was stripped, and the outcrop of the phosphate rock in place is clearly shown on this stripped ground. We took a sample from the vein at the Obey discovery.

Q. Is that sample No. 1?

A. We had sample No. 1. I did not take the sample personally. It was taken by Mr. Wilson. I observed him take it, and saw him take it and mark it so that we both would know what the sample was.

Q. How was it taken?

A. We took a pick and picked out some rock out of the phosphate vein, probably about half a pound of rock, of the vein rock. We then went to the Obed lode, which lies south of and adjoining the Obey lode.

(Testimony of Guy Sterling.)

The outcrop which I have just described as being stripped on the Obey lode, was also stripped on the Obed lode, and the length stripped along there I estimated as [306] 800 feet in length.

We then went from the discovery of the Obed lode to what we call cut No. 6 in the tunnel. The cut was at the entrance of the tunnel there, 20 feet long. The tunnel had a bearing of south 75 degrees west magnetic, and showed about the same conditions that I have already described in cut No. 5, except the dip was 38 degrees westerly, and the strike was south 30 degrees east. On the floor of this tunnel we noticed some low grade phosphate rock.

Then we went to cut No. 6, which is at the Obed discovery, and took a sample of the phosphate vein as exposed there.

Q. The number of that sample? A. No. 2.

Q. Did you take it?

A. I think Mr. Wilson took that one also, but I was there and noticed him take it, and saw him mark it.

Q. If you took any of them just remind us when you get to them.

A. Yes, sir. We came to Tunnel No. 7. This was caved in and we could not enter. The phosphate rock showed near the portal and on the dump by the tunnel.

We went to cut No. 8. This is near the center of the Obed lode, and runs at right angles to the strike of the phosphate vein. It showed 6 foot vein of high grade phosphate rock in place, and the limestone wall. The limestone footwall of the series shows ore

(Testimony of Guy Sterling.)

in place at several points between cut No. 8 and the Obed discovery; outcropping above the surface.

On the Obed lode the Winfield placer discovery shows a bed of phosphate rock in place in the bottom of the gulch running across the southerly end of the Obed lode. We came [307] to the portal of the tunnel where men were working, and we were informed that we could not enter.

We then went to the Jimtown lode, which lies to the southerly of and adjoins the Obed lode. We went to cut No. 9, the Jimtown discovery. Now, that is marked on this Exhibit No. 1 as cut No. 10. This discovery in cut No. 9, as I have called it, is near the northern end of the Jimtown lode, and at this cut the hanging-wall of limestone showed clearly in place, and also a bed of phosphate rock. The dip was westerly and the strike southerly.

Q. What was the hanging-wall?

A. Limestone. We took a sample from this cut, which was sample No. 3.

Going southerly from the Jimtown discovery we find the veins of phosphate rock showing in a number of small cuts, but the formation was somewhat broken and twisted, so that the dip and strike could not be accurately taken, but the rock both veins and walls, was clearly in place.

We then went to Tunnel No. 10, which is probably the one marked here as tunnel No. 12. We were given to understand that this was driven by the—what is the name of the defendant?

Q. The San Francisco Chemical Company.

(Testimony of Guy Sterling.)

A. The San Francisco Chemical Company, and we did not enter this tunnel. At the entrance, however, I found the strike of the vein to be south 10 degrees east, and the dip 20 degrees westerly. This tunnel was apparently driven on the strike of the vein, which showed at the entrance of the tunnel $4\frac{1}{2}$ feet of good phosphate rock. [308]

We next went to Tunnel No. 11—this I think is marked on here as Tunnel No. 13—that is called so on here, I mean on Exhibit No. 1. This was driven for a short distance at right angles to or cross-cutting the vein, and then it turned to the right and was driven approximately on the strike of the vein northerly. Here the limestone footwall showed clearly in place.

We then went over to the Fentress lode, and we went to what I have marked as workings No. 12, which is marked I think on Exhibit No. 1 as No. 15. This was an incline shaft about 10 feet deep, and shows the phosphate veins in place, with limestone walls, which had a southerly strike and dip of 40 degrees to the west. 100 feet westerly and above this incline the chert hanging-wall, characteristic of the series of the phosphate beds, outcropped very boldly and plainly.

We then went to the workings No. 13, which are at the discovery cut of the Fentress lode—I am mistaken about that. I should have said this incline shaft I have just mentioned was the discovery workings as I understood, of the Fentress lode. There was a vein there of phosphate rock which appeared to be high

(Testimony of Guy Sterling.)

grade, 5 feet thick. We took the sample No. 4 here.

Q. Sample No. 4 by Mr. Wilson?

A. By Mr. Wilson. At the discovery the vein had a strike of south 30 degrees east, and a dip of 22 degrees west magnetic.

We then went into the Cumberland lode. In going from the Fentress to the Cumberland we went along the vein to the north [309] end line of the Cumberland, which joins the south end line of the Fentress lode, and just within the north end line of the Cumberland we came to the cut and incline which I have designated as No. 14, 10 feet deep, which showed a 6 foot vein of phosphate rock with the limestone wall. The strike of the formation there of the wall and the vein was south 12 degrees east, and the dip was 27 degrees westerly.

From this cut running southerly through the claim for about 300 feet the outcrop of the phosphate vein had been partly stripped, and along this outcrop the footwall outcropped very prominently. We went next to the discovery incline of the Cumberland, and this was designated as No. 15. The incline was about 8 feet deep, and the phosphate vein and the walls shown in this incline were clearly in place, and had a dip of 30 degrees to the westerly, and a strike of south 15 degrees west; and Mr. Wilson here took sample No. 5.

We then went to what we called Tunnel No. 16. This is westerly of the Cumberland discovery, and is probably the one that is designated on the Exhibit No. 1 as No. 17. Tunnel No. 16 is driven approxi-

(Testimony of Guy Sterling.)

mately on the strike of the vein, which we estimated at 150 feet long, and had a cross-cut to the east. In this tunnel the phosphate rock both soft and hard appeared in place, and we took sample No. 6 from the face of the cross-cut, where the vein was about 6 feet thick.

Q. (By Mr. BUDGE.) Where was that?

A. In this tunnel here, Mr. Budge. (Indicating.) [310]

Q. (By Mr. BUDGE.) In the Cumberland, or on the Cumberland?

A. Yes, sir. It is marked here No. 17. We took our sample No. 6a in that cross-cut which runs to the east.

Q. Sample No. 6? A. 6-a.

Leaving this tunnel we went along the vein on the Cumberland lode, and we found several tunnels and cuts showing veins and walls of phosphate rock in place. The Cumberland lode is in the westerly side of the Montpelier Creek Canyon, and its northerly end is near the junction of the Gertch Hollow and Montpelier Creek. I have noted that the dam and intake-house of the Montpelier Water Works are located within and near the southeast corner of the Cumberland lode. You wanted me to stop when I come to the Overton lode.

And thereupon the further taking of the testimony in this cause was, by consent of said parties, adjourned until tomorrow morning, the 19th day of May, 1911, at the hour of 9:30 o'clock. [311]

Friday, May 19, 1911.

At this day come again said complainants, by

(Testimony of Guy Sterling.)

Messrs. Charles C. Dey and C. B. Jack, their solicitors and counsel; and the said defendant, by Mr. Jesse R. S. Budge, its solicitor and counsel, also comes; and thereupon the further taking of the testimony in this cause is resumed pursuant to adjournment.

GUY STERLING, heretofore duly sworn, recalled for further direct examination by Mr. Dey, testified as follows:

Q. You may proceed, Mr. Sterling, where you left off at the adjournment last evening.

A. I begin at the Overton lode. Leaving the Cumberland lode we went to the Overton lode, which is on the westerly side of Montpelier Creek, and joins the southerly end line of the Cumberland lode. We went to Tunnel No. 17, our No. 17. You will notice the last tunnel I had here was our No. 16, and that is marked No. 17 on Exhibit No. 1, and then there are a great many other tunnels; tunnels and other openings upon the Cumberland lode that we went in and looked into, but made no particular note of, and passed over into the Overton lode, so that our tunnel No. 17 is probably the tunnel marked as No. 28 on Exhibit No. 1. This tunnel bears northwest and is mostly in the wash, although the phosphate rock apparently appears in place in the face of the tunnel, which cross-cuts the direction or strike of the vein.

Next to the old incline which we call No. 18, which is [312] about 60 feet northerly of the Overton discovery, and is marked No. 33 on Exhibit No. 1. Here we found a thick bed of phosphate rock in place,

(Testimony of Guy Sterling.)

having the characteristic strike and dip of the formation.

We then went to No. 19, which is at the Overton discovery, and in this cut there is shown two feet of phosphate rock, low grade, and then two feet of limestone, and then four feet of phosphate rock. These were all in place, and the cut is approximately on the strike of the vein. We took sample No. 7 there—Mr. Wilson took it.

Q. That was No. 7?

A. Yes, sir. The strike of the vein there was south 15 degrees west magnetic, and the dip was 37 degrees westerly magnetic.

Q. The last sample I had was 6-a?

A. 6-a; and this is 7. That ends all we did for October 29th.

Q. I want to call your attention a moment to one sample I understood was taken by Mr. Hoff, when you come to that.

A. I don't believe I have designated them. They were all handed—

Q. All right; go ahead.

A. Now, you said yesterday to stop at the gulch; you meant on account of the recess?

Q. On account of the recess, yes, sir.

A. Commencing October 30th, on the Mt. Pleasant lode, we went first to the Mt. Pleasant discovery, which is in the southerly end of the claim, and I will just locate the Mt. [313] Pleasant lode also. It lies on the easterly side of Montpelier Canyon, opposite and practically parallel with the Overton lode,

(Testimony of Guy Sterling.)

the southwest corner of the Mt. Pleasant being near the southeast corner of the Overton, these two corners being in the bottom of Montpelier Canyon.

At the Mt. Pleasant discovery is our Tunnel No. 20, which runs southerly 60 feet or more as estimated by us, and is probably the tunnel marked 40 on Exhibit No. 1. 20 feet from the face of this tunnel on the right side we took sample No. 8 of phosphate rock. In this tunnel the formation was folded, but the strike was about south 30 degrees east, and the dip was 17 degrees 45 minutes westerly. The formation was twisted and folded indefinitely. We took sample No. 8—

Q. (By Mr. BUDGE.) Where was this point that it was folded?

A. It was in this tunnel marked No. 4 on Exhibit No. 1. Sample No. 8 was taken from a bed of **good** phosphate rock about 4 feet thick, along which the tunnel runs, and this vein of phosphate rock was in place.

We then went north 500 or 600 feet in the Mt. Pleasant lode and came to our Tunnel No. 21, which runs southerly about 30 feet and shows a vein of phosphate rock with a limestone wall in place. The strike of the vein here was southerly, and the dip was flat but to the westerly.

We next went to Tunnel, to our Tunnel No. 22, which probably is the tunnel marked 34 on Exhibit No. 1. At this tunnel I took a sight with the clinometer across the canyon to the outcrop of the vein opposite. We found the slope was [314] 12 de-

(Testimony of Guy Sterling.)

grees, which I considered at that time the dip of the beds or veins between those two points.

Q. (By Mr. BUDGE.) Please designate that.

A. The mouth of Tunnel No. 34 and the mouth of the incline at the workings No. 33 on the Overton lode. The idea was to determine approximately the slope or dip of the vein before it was eroded by Montpelier Creek. At this Tunnel No. 22, our 22, the phosphate lime walls were clearly in place, although they were distorted and folded. We estimated the tunnel was 35 feet long and runs southeast, but turns to the left near the face. I have a note here that a sample was taken there from the vein in Tunnel No. 22, but I haven't any number for the sample.

From Tunnel No. 22 we went along the outcrop of the vein to the northerly end of the Mt. Pleasant lode, and observed several workings on phosphate rock, the footwall of which appeared all in place.

We then went to the Arkansas lode. This lode lies southeast of the Mt. Pleasant lode, but is not contiguous to the latter, except the northeast corner of the Mt. Pleasant and the northwest corner of the Arkansas. Within the Arkansas and within about 300 feet south of the north end line, four or five small cuts show phosphate rock and a lime hanging-wall clearly in place. The dip was 24 degrees westerly, and the strike south 10 degrees easterly magnetic. The dip here was nearly parallel to the surface slope of the hill, the surface of the hill.

We went next to Tunnel No. 22 (?), at the discovery of [315] the Arkansas, which we found to be about 25 feet long, and that the lime hanging-wall

(Testimony of Guy Sterling.)

showed plainly, and there was 6 feet of good phosphate rock there also. We took from there sample No. 9 from the face of the tunnel. The dip was flat at that point.

Q. (By Mr. BUDGE.) Tunnel No. —

A. Tunnel No. — It is the discovery, near the discovery of the Arkansas, and I think it must be the diggings there at the discovery or the tunnel No. 46 probably on Exhibit No. 1. This tunnel runs northerly, and is on the north side of the gulch which drains to the west. About 20 feet west of the discovery is a tunnel which we designated as No. 24, which runs northerly for about 60 feet. That is the one that is indicated on Exhibit No. 1 as 45. In this tunnel there was a good vein of phosphate rock, 5 or 6 feet thick, and limestone wall all in place. The limestone wall was the hanging-wall of that particular vein. The dip was 30 degrees to the westerly, and a strike of south 5 degrees westerly magnetic. Both of these tunnels I have mentioned, 23 and 24, are on the southerly side of the Arkansas lode, or southerly end, I will say, of the Arkansas lode.

We found near the southerly end line of the Arkansas lode, and probably within the limits of that lode, although we were not absolutely certain, seven tunnels and cuts, all showing phosphate rock with limestone walls in place.

From here we went to the Hickman lode. This is not adjoining the Arkansas, but has its north end line about 500 feet southerly of the Arkansas discovery. I have noted the [316] northwest corner of

(Testimony of Guy Sterling.)

the Hickman was a 4x4 post in mound of earth and stone, scribed 1-2637. This corner was on the south side of the gulch before mentioned, at the southerly end line of the Arkansas lode.

On the northerly end line of the Hickman lode, which is only 50 feet long—that is, the end line is only 50 feet long,—there are two cuts which show good phosphate rock and limestone walls very clearly in place. Phosphate rock veins are shown here 5 or 6 feet thick, and show what appears to be a good grade of phosphate rock, having a strike of south 5 degrees east, and a dip of 27 degrees westerly magnetic.

We next went to what we call cut No. 25, which was at the discovery of the Hickman lode, and we found a vein of phosphate rock with lime walls showing the dip and strike about the same as at above cuts on this lode, the last mentioned cuts. We took sample No. 10 from the discovery. The discovery cut has a face of 5 to 7 feet, and a length of from 10 to 15 feet.

About 300 feet northwest of the south end line of the Hickman we come to what is our cut No. 26. This is about 15 feet long and had a 17 foot face. This shows some thin beds of phosphate rock and shaly limestone walls in place.

We next went to the Wayne lode from the Hickman lode, and the Wayne lode is found to be on the same series of beds of phosphate rock that occur in the Hickman lode, and about one-half mile directly south of the latter. The Wayne lode claim, as well as part of the Hickman lode, is only 50 feet wide, and is staked out as nearly as practicable on [317] the

(Testimony of Guy Sterling.)

outcrop of the phosphate series.

We come next to Tunnel No. 21 on the Wayne lode, which is probably tunnel marked No. 53 on Exhibit No. 1. This tunnel is 20 feet long, cross-cuts the veins, and bears northwest and is about 40 feet. The entrance of this tunnel is about 40 feet northerly of the Wayne discovery. In this tunnel there is shown 7 feet of phosphate rock, with a lime hanging-wall at the portal of the tunnel, and also a little of the hanging-wall in the face of the tunnel. The dip here was 25 degrees west, and a strike of south magnetic.

We went next to the Wayne lode discovery, which we call cut No. 28. This cut is shallow, and shows phosphate rock with a limestone hanging-wall in place. We took sample No. 11.

I noticed that there was a post marked here "Wayne Discovery." From the discovery of the Wayne northerly for about 200 feet to the southerly end of the claim, the outcrop of the series of beds shows very clearly.

Both the Wayne and the Hickman lodes are on the side of the mountain lying easterly of the Montpelier Canyon, and the surface of the ground in general slopes to the west.

The Wayne is traversed or crossed about 450 feet from its northerly end line by a deep gulch draining to the west. That is all of that group.

Q. That ends that? A. Yes, sir.

Q. You omit the Columbia.

A. Yes, sir; I haven't any notes on it.

Q. Did you make any? A. Let me see—

(Testimony of Guy Sterling.)

Q. Investigation? [318]

A. Wait just a second, please. I understood you didn't want that to-day, and that is the reason I didn't get it. We took it—no, I haven't any notes in regard to that.

Q. Have you any independent recollection?

A. All I remember is that by following the lode through continuously there on the outcrop, and by means of cuts, diggings and uncovered ground, etc., through to the Wayne lode, I noticed it had the same general characteristics all the way through wherever the lode was uncovered.

Q. This lode you have described is lying within the side lines of the lode claims? A. Yes, sir.

Q. Is it in its course and strike all the same lode throughout the length of these claims?

A. Yes; I believe it is absolutely.

Q. At one place you have referred to the lode being folded? A. Yes, sir.

Q. Where is that now?

A. That is in the Arkansas lode and Mt. Pleasant lode, where the lode or beds in their dip are practically parallel with the surface, or they are very near the surface, so that every little undulation there has made a corresponding undulation or a fold and bend in the beds on these particular claims, and of course they are broken and cracked, but the general dip and general strike, wherever the veins are exposed there, is practically the same as it is on the other claims. In other words, these folds are purely local.

Q. At what depth was the vein exposed there at

(Testimony of Guy Sterling.)

that place? A. You mean at the surface? [319]

Q. Yes.

A. Well, except in the side of the mountain on the southerly end line of the Arkansas lode, it was not necessary to go very deep on the Arkansas and Mt. Pleasant lodes to find the vein, because they lie near the surface, as I said before, practically parallel with the surface.

Q. Describe generally the topography, if you please.

A. This Exhibit No. 1 gives a good general idea of it. The characteristic or salient features of the topography are the ridge which shows there running generally southerly, parallel with the lode and westerly of the lode, through section 31, and then there is the Montpelier Canyon running southwesterly along between the Overton lode and Mt. Pleasant lode. Then we cross the canyon, and then you come to rather steep rolling ground, upon which the Arkansas and Hickman lodes are located, and all of this ground slopes of course in general towards the Montpelier Canyon. Now the mountains up and around the Obey lode are pretty high, but the ground where the Arkansas and Hickman lodes are is not so high.

Q. What was the object or purpose you had in making your examination?

A. Well, simply to determine whether the deposit of limestone were rock in place and have in general a dip and strike.

Q. Deposits of what did you say?

(Testimony of Guy Sterling.)

A. Deposits of phosphate rock. Was not that what you asked me?

Q. Yes; but you said limestone. (Question and answer read.)

A. I meant deposit of phosphate rock, having a general [320] dip and strike between walls of rock.

Q. In other words, under the mining law, to what class they belong to? A. Yes, sir.

Q. Class of deposits. How are the walls distinguished from the phosphate vein or lode?

A. You have no difficulty, when you see the two classes of rock, that is the phosphate rock and the limestone walls, speaking of limestone in a general way, with your eye, and distinguishing them.

Q. Different colors?

A. They are of different colors and different textures.

Q. Both? A. Different textures, yes, sir.

Q. Is the line of demarcation between the walls and the phosphate lode distinguishable?

A. Wherever they are in place and are unbroken or undisturbed, the line of demarcation is very clear.

Q. From your examination what do you say as to the phosphate lode having the same character of hanging-wall throughout the entire length of the claim?

A. Yes, sir; it has. The series has a well defined hanging-wall, easy to see and follow, and its relation to the series is easy to determine, and generally the

(Testimony of Guy Sterling.)

outcrop appeared quite prominently in a great many places.

Q. And what is the hanging-wall?

A. In general it is a silicious, cherty limestone, and in some cases contains a good many fossils.

Q. What is the footwall?

A. The footwall is also a limestone, and while it varies [321] in character, it is generally hard and cherty.

Q. Silicious?

A. Yes, sir; chert pertains to anything silicious.

Q. From your examination were you able to determine the breadth between the walls of the phosphate lodes?

A. You mean between the walls of the series?

Q. Yes.

A. There was only one place on this group, as I remember it, that we were able to make much of an estimate of that, and that was on the Obed lode, and I estimated there near the discovery that the series was at least 60 feet thick, as indicated by the position of the hanging-wall, of the hanging-wall and footwall.

Q. Any evidences of its being thicker at any other places?

A. Well, I can't say there is on this group.

Q. I am speaking of and referring to this group.

A. Yes, sir.

Q. Now, this series, as you call it, just describe with reference to this ground what it is made up of.

A. Well, the series of the veins is simply the beds

(Testimony of Guy Sterling.)

included between the hanging and footwall of the series that I have before spoken of.

Q. Well, you spoke of it generally. Now I am referring to this—

A. Yes; and between this hanging and footwall of the series, as a whole, there are alternately beds of phosphate rock and beds of limestone or shale or quartz, or, I would not say quartz, but quartzy limestone, silicious limestone that form the walls of these individual beds of limestone.

Q. Of what? [322]

A. Individual beds of phosphate rock, so that the whole series consists of a number of beds of phosphate rock and limestone alternating.

Q. The thickness uniform or variable?

A. The thickness varies; the thickness of the phosphate rock runs from 6 inches up to 10 feet, and the grades vary, and the thicknesses of the limestone walls vary, although I don't remember of ever seeing a limestone wall within the series much over 3 or 4 feet thick. They are generally from 1 to 2 feet thick; the limestone walls. Of course I use the word limestone there in a general sense. Those walls vary very much, some of them are almost pure silica.

Q. At the place where you were able to make an investigation from the footwall to the hanging-wall, you did not determine there the thickness of the various strata?

A. No, sir; we could not do it; it was not uncovered, and we could not do it.

Q. It was possible to do it?

(Testimony of Guy Sterling.)

A. Oh, yes; it would be easy to strip it and measure it accurately.

Q. Were you on the placer claim shown on Exhibit 1, outside of the exterior boundaries of the lode claims?

A. Well, only as we found it necessary to go across in going to and from the claims.

Q. And are you able to state whether there is any deposit of phosphate rock found on those placer claims shown on Exhibit 1, outside of the exterior boundaries of the several lode locations? [323]

A. Well, I am not positive, but I think I could see and notice some diggings on the Winfield placer east of the Obed and Obey lodes, which showed a dark material on the dump of the workings there, which was undoubtedly phosphate rock. I am not absolutely sure I am correct in regard to that location. It was either on the Winfield placer, though, or the Colcock placer or on ground that would be east of the Colcock placer.

Q. Which is not known there?

A. It has no name there at all.

Q. As a mining engineer how would you classify the phosphate deposit which you have described?

A. Why, I would classify it as a mineral deposit.

Q. Found in what form?

A. In the form of a—well, it is a calcium phosphate, calcic phosphate.

Q. But in what class of ground?

A. Oh, physically?

Q. Physically.

(Testimony of Guy Sterling.)

A. Why, I would class it as a lode.

Q. Did you find any characteristics of a placer deposit throughout the lode claims?

A. No; I did not, because the only place there were any detached or loose pieces of phosphate rock was where it was right near and practically on the outcrop of the vein, and for that reason was actually a part of the vein, although it was detached from it.

Q. Other than that, it was found all in place in the mass of the mountain, was it? [324]

A. Yes; taken in a broad general way. Of course, as I said, there were here and there little pieces of float that had been moved.

Q. What do you understand as a lode in the sense used by miners?

A. I understand the word lode came from the same—has the same meaning as the word lead. It is simply an extension of the formation in the mine which enables the miner to follow the ore, such as the wall and the dip and the strike, and everything of that kind.

Q. And what do you understand by a placer?

A. Well, in its original and intentional meaning I understand the placer to be a deposit something like gravel, that is purely a secondary deposit, alluvial deposit, and that it has no well defined form or position, and that it contains no mineral in what we call a chemical combination, as a rule, although that don't apply strictly.

Q. You may pass now to the China and Japan, shown on Exhibit "A." When did you make an ex-

(Testimony of Guy Sterling.)

amination of those claims?

A. I went down there November 15th, 1910.

Q. For what purpose?

A. For the purpose of examining the Japan and the China and the Fryerson lodes.

Q. With what object?

A. To determine the characteristics of the formation, and whether they appeared to be properly lode claims or placer claims.

Q. You may describe fully the characteristics and formation and the result of your examination and inspection. [325]

A. I went over there with Mr. Duffield, Mr. Hoff and Mr. Wilson. I found the Japan and China lodes were in the Sublette Range, near Raymond, Idaho, although the claims themselves are in Wyoming.

We commenced on the south end line of the Japan lode, which is found at this end line say about 600 or 700 feet, something of that kind, north of Raymond Canyon. We went first to the tunnel on the southerly end line of the Raymond placer, the southerly end line I should say of the Japan lode, which I understood was on the Raymond placer of the San Francisco Chemical Company, and that this tunnel had been driven by that company. This tunnel had a bearing of north 65 degrees east magnetic, and a length of about 75 feet, and it was cross-cutting about 50 feet of the series of this phosphate rock. Some of the veins were 5 and 6 feet thick. I noticed at the portal of that tunnel, or the San Francisco cuts, I noticed the dip of these veins was nearly verti-

(Testimony of Guy Sterling.)

cal, but they have a little bit of an easterly tendency.

We then went to the Japan discovery tunnel, which was just a little ways north of this last tunnel, and found that the discovery tunnel had a bearing of north 70 degrees east, and a length of about 75 feet, with a cross-cut running to the north of about 15 feet in length. This tunnel cross-cut the series of veins also; and in this tunnel the dip was vertical and the strike of the vein was about north 20 degrees west magnetic. From the drift in this tunnel we took samples from a 5 foot vein of good phosphate rock, [326] and the sample was marked F-1. Coming out of the tunnel I noticed that the cherty limestone series very prominently outcropping on the surface just about above the end of this tunnel. I noticed also that the footwall westerly of the entrance to the tunnel was outcropping, and found the face of this tunnel was in hard, cherty lime, and probably was in the footwall or hanging-wall of the series. All of these veins and walls spoken of in the Japan lode were in place. The discovery I estimated was about 500 feet in elevation above the valley. I saw the notice of the Japan lode at the discovery, and read it over, and it appeared to be all right.

We then went to the China lode, which lies north and adjoins the Japan lode. Near the north end line of the Japan lode and south end of the China, there appears to be a throw or fault or something of that kind in the formation there, so that the dip is no longer vertical as it is shown in the Japan lode, but is about 45 degrees westerly, and the strike of the

(Testimony of Guy Sterling.)

vein there was northeasterly. We found but very little float at the north end of the Japan or the southerly end of the China. It appeared to be covered up by the disintegration of the hanging-wall of some of the series.

At the China discovery tunnel, which is driven mostly in wash, we saw at the entrance of this tunnel a dark streak which was undoubtedly phosphate rock and decomposed. We took there sample S-2. This tunnel is about 20 feet long, running southeasterly, and badly caved, but the rock was in place at the portal. The dip and strike of this rock [327] at the portal of this tunnel was indefinite, on account of being twisted and folded, but it was pretty clear that the dip was westerly and the strike was southeasterly.

About 20 feet above the discovery and easterly there was another tunnel running southeast and about 35 feet long. This tunnel was all in the wash, but at the face there was shaly decomposed phosphate rock, and we took a sample from the face.

We then went to the Fryerson lode—shall I continue—

Q. Shown on Exhibit "B"?

A. Shown on Exhibit "B."

Q. Yes.

A. We went to the discovery first. I noted there that the cherty easterly hanging-wall of the series outcropped very prominently. There has been a good deal of the series there stripped, showing a large exposure of the vein towards the north end of the Fryerson lode, and on the southerly side of what is

(Testimony of Guy Sterling.)

known as York Gulch. We found two tunnels there, which were caved, but the formation of the veins which were stripped, and we found that they had an easterly dip of about 60 degrees. I saw one good 4 foot vein of phosphate rock 50 feet east of the discovery, and from this we took sample S-3. The diggings were on the north side of this York Canyon and belonging to the Breathitt lode.

We went then to the discovery of the Francis placer.

Q. Is that shown on Exhibit "B"?

A. Yes, sir; that is shown here; which was about 50 feet south of the south end line of the Fryerson lode, and there [328] at that Francis discovery I found that the dip or strike was south 30 degrees east.

Q. (By Mr. BUDGE.) State how marked.

A. I did not see it marked at all, Mr. Budge. That was outside of the Fryerson lode.

Q. (By Mr. BUDGE.) I understood Judge Dey to ask you if it was not shown on that map.

A. I thought you said the Francis placer.

Q. No; I meant the discovery.

A. Going south from the Fryerson discovery to the Francis discovery, we did not find any float, that is any phosphate float, but the hanging-wall of the series outcropped nearly all the way, so that there was no trouble in telling what was the course of the vein through the Fryerson lode. When we got to the southerly end of the Fryerson lode we found there what we called Francis Canyon, and on the southerly side of that canyon we saw a good deal of work which

(Testimony of Guy Sterling.)

clearly uncovered and showed the phosphate rock in place.

Q. Did you take the dip and strike there?

A. Yes, sir; we took the dip and strike as we went along, and found it of the same characteristic, having the same characteristics as all these workings before.

Q. Did you travel the intervening distance between the China and Japan and the Freyerson?

A. Not between the lode, not on the lode.

Q. Not on the lode? A. No, sir.

Q. You have not been over that?

A. No, sir; we drove along the road, and the range of [329] mountains is clearly in view all the way along, as I remember it, but of course you could not say absolutely from such an inspection as that that there was nothing whatever to indicate an important break in the formation between those.

Q. You stated that the outcrop was visible?

A. Yes, sir; the outcrop of the hanging-wall and in some places the vein rock.

Q. Is the formation and characteristics in respect to the walls the same that you have described in connection with the claims platted on Exhibit 1?

A. Yes, sir; I should say it was the same general formation.

Q. Readily discernible?

A. Yes, sir; take it as a whole.

Q. Did you ascertain the breadth of the series or lode of phosphate?

A. Well, you mean in the China and Japan?

(Testimony of Guy Sterling.)

Q. China and Japan, yes.

A. I mentioned in my testimony I think there, that there was 50 feet of the series cross-cut in this tunnel at the south end line of the Japan lode. I think there were plain indications there that the series was still wider than that at that point. That was a very good showing there, though of course the hanging-wall was clearly in sight and this easterly wall.

Mr. DEY.—You may cross-examine.

Cross-examination.

(By Mr. BUDGE.)

Q. How long have you resided in Salt Lake, Mr. Sterling?

A. Practically continuously since 1899. [330]

Q. You say you attended some school or university? A. Cornell University.

Q. Cornell University? A. Yes, sir.

Q. Are you a graduate of Cornell? A. Yes, sir.

Q. Of what department?

A. Civil Engineering.

Q. And in what year did you graduate?

A. In 1887.

Q. Did I understand you correctly that you said you had been engaged in mining engineering since 1898? A. Yes, sir.

Q. Now, where have you been engaged in that work? A. In Utah, mostly.

Q. Mostly in Utah? A. Yes, sir.

Q. And in what parts of Utah?

A. Well, nearly every mining district in the state.

Q. Well, by whom?

(Testimony of Guy Sterling.)

A. I could not possibly tell you without getting my books in nine or ten or twelve years of pretty near continuous work in connection with mines and surveying underground and surface workings. I could not tell you all the clients I had.

Q. Can you give us the districts in which you have worked, and the mines you have examined?

A. The Iron Mountain District, the district down at Stateline, the Bingham district, Park City district, the Ophir district, and other districts I have forgotten the names of.

Q. Now, take for example the Bingham district. What have you done in the Bingham district?

A. Oh, I have made a study out there of the formation in regard to the development of mines.

Q. When?

A. The last one I made was about three years ago.
[331]

Q. When was the first one?

A. I think the first one I made was when I first began work, about 1898 or 1899 probably.

Q. Along about 1899, that was the first work that you did?

A. I think that was the first work I did after I moved out there.

Q. How much of an examination?

A. It was an examination of a group of claims, about seven or eight claims.

Q. How long were you engaged in the work?

A. Well, it was not all examination; it was surveying as well as examining.

(Testimony of Guy Sterling.)

Q. Well, what period of time was covered by your examination? A. Oh, probably two or three days.

Q. Two or three days? A. Yes, sir.

Q. What sort of property?

A. It was a lead and copper, I think, as I remember it.

Q. What was the nature of your examination, purpose of it?

A. Simply to show what the probabilities were there of finding more ore, or finding pay ore.

Q. More ore?

A. Finding pay ore, not more ore.

Q. Finding pay ore?

A. Yes, sir; and studying the formation with relation to the vein system that existed there.

Q. And you say you were engaged in that two or three days? A. On that part of it, yes, sir.

Q. Well, from this have you any distinct recollection as to where you were next employed?

A. No; I have not any distinct recollection. [332]

Q. Can you give us a general idea as to where you were employed after that?

A. I could not do that without going through my books, and going over the history of my life in ten or twelve years' work.

Q. Can't you give us a better idea as to the extent of the examinations you have made as a mining engineer, and the properties which you have examined?

A. I can tell you one, one that I spent a good deal of work on in my capacity as a mining engineer. There was a case between the Colorado Fuel and Iron

(Testimony of Guy Sterling.)

Company and the Walker Brothers in regard to the iron claims down at Iron Mountain in this state. That was a controversy with regard to whether these claims were placer or lode, and it lasted, I think, about three years. I think that I spent altogether four months' time on that. The greater part had reference to the geology of the situation.

Q. The geology of the situation. What has been the extent of your study in geology, Mr. Sterling?

A. Well, it has been—you mean in the field or theoretically?

Q. No; theoretically first.

A. First the usual course in geology was taken in the civil engineering course. Then I did some—

Q. Can you define that more particularly?

A. I took some lectures on geology by the Professor of Geology at Cornell.

Q. Is that all there was of it?

A. That is all there was to that part of it. [333]

Q. And covering what time?

A. Well, I suppose that took up, that particular part of it probably took up one hour and one or two terms work, but I have forgotten exactly. In addition to that I did some—

Q. How long were the terms?

A. I don't remember.

Q. Did it cover more than one year?

A. I have forgotten. I think the term was about three months, two months, something like that.

Q. Two or three months?

A. Yes, sir; call it four months altogether of lectures.

(Testimony of Guy Sterling.)

Q. Well, is that the extent of your geological study, theoretical study?

A. No; I have been reading continuously ever since I have been in the practice of engineering.

Q. Give us an idea of what you have studied as a geologist.

A. Well, I have read the different geologists.

Q. Give us the names of these text-books.

A. Le Conte.

Q. What name? A. Le Conte and Dana.

Q. Dana?

A. Yes; and I have read a good many Government reports.

Q. Can you give any more definite information than that?

A. I think that is about as definite as I can put it.

Q. Have you studied minerology? A. Yes, sir.

Q. In what work?

A. We used at Cornell Dana's Mineralogy, and took a course in blow-pipe analysis.

Q. What analysis? A. Blow-pipe analysis.

Q. Blow-pipe analysis. Now, is Dana considered a standard work on mineralogy? A. Yes, sir.

Q. And on geology? A. He is. [334]

Q. And did you study them, make a complete study of those works?

A. No; I don't suppose complete, I would not undertake to say whether I have made a complete study or not; I would not know.

Q. Have you read them through?

A. I have at different times, yes.

(Testimony of Guy Sterling.)

Q. Just simply read them at different times, and different portions of the work at different times?

A. Yes, sir.

Q. And that is the manner in which you have studied those works? A. Yes, sir.

Q. Did you ever take any course in mineralogy?

A. I told you a minute ago that I took a course in mineralogy at Cornell.

Q. I didn't understand you. Then I understand you to say you took a course in mineralogy?

A. Yes, sir.

Q. Well, is that the course in geology to which you have referred?

A. No; that was a course in mineralogyl, and it included the blow-pipe analysis I have just mentioned to you.

Q. And what period is covered by that?

A. I am not positive, but I think it was probably two terms.

Q. Two terms in mineralogy?

A. I would not be sure about that; it might have been but one term. I don't believe it would be more than one term.

Q. One term. Any other works on mineralogy?

A. Oh, I have consulted a number of works, but I don't remember the names of them of course. In my work as I have gone along I would consult those works, but I did not make any pretense to try to memorize everything in the book from one [335] end to the other, or anything of that kind.

Q. I didn't ask you that. I asked you what you

(Testimony of Guy Sterling.)

made a study of, and you know whether you made a study of the books, don't you?

A. I can say that I consulted them. I don't know whether you would interpret that as study of them or not.

Q. I am asking what your interpretation is.

A. I don't call it a study of the book. I call it a study of the subject.

Q. All right. A study of the subject as given in the book. Then have you made a study of any particular subject, that is the study of mineralogy as laid down in any particular book, other than what you have given me here?

A. Only as I have studied them when some question came up that I wanted to investigate, when I would consult every book that I could get hold of on the subject.

Q. But other than what you have given, you have pursued no continuous course of study for any particular period?

A. No; I have not made a specialty of mineralogy.

Q. Or a specialty of geology?

A. Nor a specialty of geology

Q. And when you say that you have studied Le Conte and Dana, it has simply been in the manner which you have indicated at odd times, and when you were interested in a particular subject?

A. No; I at one time read both of those books from cover to cover, but I don't mean by that that I never had occasion to consult them afterwards.

Q. I know. Now, do you remember how long ago that was?

(Testimony of Guy Sterling.)

A. Well, probably at various—probably twelve or fifteen years ago when I read the books clear through. [336]

Q. And you have consulted them from time to time since? A. Yes, sir.

Q. Now, can you give us any other information as to your work as a geologist, other than what you have given us, the Bingham examination and the Iron Mountain examination, and what about your Park City experience?

A. Well, that consisted of surface and mine surveys and study.

Q. I am just confining it. Mr. Sterling, to your work in geology.

A. And the study of the formation with reference to the development of mines.

Q. Yes; that is what I want.

A. That is all that amounted to.

Q. Well, what period was covered by that?

A. I don't remember distinctly.

Q. Have no recollection at all?

A. Oh, I know that it was not twenty years ago, and it was not two years ago.

Q. I say, how long were you engaged in that work?

A. Oh, altogether it was probably—you mean in the field or in the office?

Q. In the field.

A. Well, I really could not say, but I should think probably about a month.

Q. One month. Where else have you worked in the field?

A. As I have told you, I worked in all of those min-

(Testimony of Guy Sterling.)

ing camps, practically all of them.

Q. Give us something a little more definite than that as to the time you spent in each one of them.

A. I cannot give it to you definitely, nor even approximately definitely, because I don't have any recollection of the matter. [337] I never made any attempt to keep any track of it.

Q. Well, calling your attention to the Ophir district, what about that?

A. Well, I suppose that I probably spent, probably two weeks altogether there in examination of the geology, etc., and with reference to the mining developments.

Q. What about the Tintic district? Been down there? A. Yes, sir.

Q. How long?

A. It has been a good many years since I have been down there.

Q. Well, how long were you engaged in the study of the geological conditions when you were there? How long have you studied them geologically?

A. I really can't say, Mr. Budge. I can guess if you want me to.

Q. I don't want you to guess particularly, but haven't you some more definite idea than you have given us, as to the time you spent in Tintic?

A. No; I have not.

Q. On how many occasions have you been employed to go down there?

A. I can't tell that without guessing. I will guess on it if you wish me to.

(Testimony of Guy Sterling.)

Q. You can't say anything more about it, than a dozen times?

A. I know from my experience that in things of that kind there is innumerable isolated cases that I forget all about and which I would not remember now, and cannot make any estimate of the time I was there that I spent on that particular thing.

Q. Let me ask you this. Have you been in the Tintic Mining District for the purpose of studying the geological conditions on innumerable occasions?

A. No, sir. [338]

Q. On how many occasions?

A. Well, that is what I tell you I can't tell you.

Q. Approximately half a dozen, for that purpose?

A. I should say certainly a half dozen, but I don't remember distinctly.

Q. Do you remember the properties?

A. I only remember one or two.

Q. Just one or two, and what kind of properties?

A. They were lead and copper, copper mines, and whatever ores there are down there.

Q. And those that you remember, how long were you engaged in?

A. That is just what I told you I could not tell you.

Q. I say as to those two or three you now remember, can you give us any idea?

A. No; I cannot. It would seem like a small matter, to look at it now. It might have taken me several days to form an opinion that I could express in five minutes.

Q. Now, were there any other districts than those

(Testimony of Guy Sterling.)

you have mentioned, Park City, Ophir, Bingham district, and Tintic?

A. State line, didn't I say?

Q. I think perhaps you did say State line. How long were you down there?

A. Well, I made a good many examinations down there in connection with my own surveys. I would not undertake to put any estimate on the time. I am satisfied now if I undertook to make an estimate of the time it would be erroneous, because I don't remember the details of the work.

Q. Do you remember the particular properties you visited there?

A. I only remember one or two, I know there were a good many that I cannot remember the names of except two. [339]

Q. Can you give any idea as to the time you spent on those you do remember?

A. No, because it was a number of different visits. For instance the Johnie mine, I suppose I visited that mine a dozen times— Now, that is merely a guess, but every trip I would probably spend a day or two, but I would not spend all the time on that one particular mine. I would not attempt for a moment to make any estimate of the time I put on it.

Q. Any other district?

A. Well, I remember one more district out here at Lucin, if I remember the name right.

Q. How long were you out there?

A. Well, I suppose I spent perhaps altogether out there about two weeks. I happen to remember that,

(Testimony of Guy Sterling.)

because it is a little more recent.

Q. Two weeks?

A. Probably two weeks on the main examination.

Q. By the way, what was the character of this formation out at Stateline?

A. That was all eruptive and igneous rock.

Q. And at Lucin?

A. Lucin; that is limestone and igneous rock too.

Q. Now, what about the deposit at Ophir. Did you tell us what that was?

A. That was limestone and porphyry dikes, etc.

Q. The limestone you say at Ophir was a limestone deposit there?

A. I said limestone and porphyry dikes.

Q. Of what age was the limestone? Do you remember?

A. Oh, it is carboniferous, but I don't remember with any great exactness as to that.

Q. How about Lucin and Stateline?

A. That is the same, undoubtedly the same formation.

Q. Now, would you say that your work since 1898 has been principally as a geologist? A. No.
[340]

Q. You would not? A. No.

Q. What has it been principally?

A. Well, I would not say; it has been principally either mining or civil engineering; it has been in both.

Q. Been in both?

A. And it probably has been more mining than civil engineering, but that is a matter I would not

(Testimony of Guy Sterling.)

undertake to be definite about. I have been in both lines of work.

Q. Your time has been devoted in your effort along these two lines, has been sort of broken up during this period?

A. I would not call it broken up. It is different lines of work.

Q. You have had different kinds of work. You have not pursued for any particular period the work of geologist, or for any particular period the work of a mining engineer, have you?

A. No; I have taken them just as they came.

Q. Now, all these mines that you have examined—well, I will ask you whether all those mines that you have examined prior to 1910 were metallic mineral mines? A. Oh, no.

Q. What, for example?

A. Do you include iron in that?

Q. Yes.

A. Well, of course, I have examined this phosphate deposit and these phosphate lodes, I should say, beginning on them in 1906.

Q. Well, other than phosphate?

A. I think not, unless it was coal.

Q. Unless it was coal. To what extent have you examined coal and studied it as a geologist?

A. Not very much.

Q. Very limited study?

A. Well, I don't know what you mean by very limited, but I have not studied it very much.

Q. Well, what period of time then?

(Testimony of Guy Sterling.)

A. I have forgotten exactly when it was that I made my examinations in that, but it was simply an examination of the formation, appearing [341] around Price and in that general vicinity.

Q. Is that the only coal work?

A. That is the only coal work that I ever did.

Q. How long ago was that?

A. Well, as I say, I don't remember distinctly; I think probably about six years ago.

Q. What was the extent of your examination? What period of time did it cover?

A. I was in the field there I think about a week or ten days. I don't remember distinctly.

Q. Now, Mr. Sterling, what districts outside of the State of Utah have you performed work in as a geologist?

A. Well, there is a part of this Lucin district—that is of no importance, but you asked that question, and I will answer the question, that a part of Lucin district is in Nevada, and a part of the State line district is in Nevada, and I have been over of course with reference to these phosphate claims in Wyoming and Idaho, but I don't remember of any others outside of Utah, except some work I done in Colorado on silver mines up around Silverton.

Q. When was that?

A. I cannot give you the year.

Q. How long ago, about?

A. I don't know. If I could I could tell you the year.

Q. Can you say within a dozen years of the time?

(Testimony of Guy Sterling.)

A. Yes, sir; it has been within the last twelve years.

Q. Was it more than five years ago?

A. I think it was.

Q. How long were you there in Colorado?

A. Oh, I was there a number of times, probably altogether about, on the ground, probably about eight or nine days.

Q. And no others that you now think of?

A. No; I don't remember of any others. [342]
Now, I don't mean to say there are not any others. I simply don't remember them. I don't call them to mind.

Q. Now, calling your attention to the study of phosphate rock, what has been the extent of your study of this deposit? Just give us the details.

A. Well, I cannot give you any details. It would require me to remember every move and thought I had in regard to the subject since 1896. I cannot do it, anything of the kind. As I told you, I simply tried to find all the information that was published upon the subject, and have gone into the chemical and geological features of the phosphate rock formation and geology as thoroughly as I could.

Q. Is that the best statement you can make?

A. That is the best statement I can make. I will go further and say I have studied it in the field, and made a couple of reports to the Government on the matter, and acted as a witness once in a matter in connection with a suit between the State of Utah and the Bradley Brothers of Boston. I think that

(Testimony of Guy Sterling.)

is practically all I have done on that, in a general way.

Q. Now, you say you have attempted to read all that has been published with reference to phosphate rock?

A. I should not say I attempted to read it all; I attempted to find it all.

Q. Find it all? A. So that I could read it.

Q. Well, what have you read?

A. Well, it has not been a great deal. I could not tell you all I have read.

Q. Tell us something you have read.

A. I have looked up what there was from time to time, although I don't remember distinctly now, what there was in Dana on the subject, and what there was in Geikie on the subject. [343]

Q. Well, what others have you read?

A. I really don't remember anything else, except the chemistry of the subject which I looked up, a number of different chemistries.

Q. Can you give us any—can you tell us, Mr. Sterling, of any particular work on phosphate rock that you have read?

A. Well, it seems to me I have given—of course you mean those—I have read, those two books.

Q. Tell us what they are.

A. One here is Bulletin No. 430.

Q. Bulletin on what?

A. I am just going to give you that. Of the United States Geological Survey of 1909.

Q. Yes.

(Testimony of Guy Sterling.)

A. On Phosphates, by S. H. Gale and R. W. Richards and Blackwelder; and then there is another one, Investigations relating to Phosphates and Phosphorus, by the United States Geological Survey in 1906, from Bulletin 315. Now, I have seen some others, but those are the only ones that I have read, I think.

Q. Who is that last report written by?

A. It does not say.

Q. Doesn't it?

A. Not on the cover here. Wait a minute. Maybe it does inside. Yes, it says by F. B. Weeks and W. F. Ferrier.

Q. Now, any other?

A. I say that is all the Government reports I remember reading, although I have seen some others, and may probably have dipped into them a little bit, but that is all I remember of reading.

Q. Now, calling your attention to the work written by Mr. J. C. Branner, on the Phosphate Deposits of Arkansas, have you read that? [344]

A. No. Now that you mention Arkansas, I do remember a book I glanced through, written by Penrose and Shaler. That is a government publication. I looked it through, but I have not made any effort to commit it to memory, or anything of that kind.

Q. Haven't read Branner?

A. I don't remember it. I would not say I had not, but I don't remember it.

Q. You don't remember that you have? A. No.

Q. Have you read Canfield's Phosphate of Lime &

(Testimony of Guy Sterling.)

Iron Ore Beds?

A. I don't remember of reading it.

Q. Have you read Copp's Geological Sketch of the Florida Phosphates?

A. I don't think I have. I may have.

Q. Have you read Doll and Stanley Brown on Miocene and Pliocene of the Gay Head Martha's Vineyard Phosphates? A. I don't remember.

Q. Have you read Day's Phosphate Rock of South Carolina?

A. Was that a Government publication?

Q. No.

A. No; I don't think I have read it then. I could not tell you whether I have or not. I have looked in so many in the last six or seven years I would not for a moment tell you what I had and had not read.

Q. You say you read Shaler?

A. I looked through that. I remember distinctly of looking through that.

Q. Was it on the South Carolina phosphates?

A. I think it was an attempt probably to practically cover the whole phosphate question in the whole world at that time.

Q. How long ago was it when you read that?

A. Oh, I read it three or four years ago, and I glanced [345] through it a few days ago.

Q. Have you read Safford on Phosphate Rock in Tennessee? A. I don't remember it.

Q. Have you read Shepard on the occurrence of Nodular Phosphates in South Carolina?

A. I may have; but I don't remember it.

(Testimony of Guy Sterling.)

Q. You haven't any recollection, have you?

A. I may have, but I don't remember it.

Q. Can't you answer my question?

A. For I don't remember.

Q. You say you don't remember that you have?

A. I can't, if I don't remember.

Q. Have you read Shepard on the Origin of Phosphates in South Carolina?

A. I may have, but I don't remember.

Q. Smith on Phosphates and Marls of Alabama?

A. I may have, but I don't remember.

Q. And Smith on Cretaceous Phosphates in Alabama? A. I may have, but I don't remember.

Q. Have you read Smith, Lawrence & Jackson on Phosphate Rocks of Florida?

A. I don't think so at all, but I don't remember.

Q. Stubbs' Phosphate Rock of Alabama?

A. The same answer.

Q. Stubbs' Report of Phosphates in Alabama?

A. The same answer.

Q. Wyatt's Phosphates of Florida?

A. The same.

Q. Wyatt's Phosphates of North America?

A. The same.

Q. Wyatt on the Phosphate Occurrences of Florida, a report to the United States Commissioner of Labor in 1903?

A. No; I don't think I have read that.

Q. As I understand it, the extent of your studies from reading which has been done on phosphates is confined to what you [346] might have read in

(Testimony of Guy Sterling.)

Bulletin 430-H, and that bulletin by Weeks and Ferrier and Penrose and Shaler?

A. I have spoken of Le Conte and Dana, haven't I?

Q. I did not understand you to say Le Conte. You may have said it, however. If you did we will include those.

A. And a great many chemical books on the subject.

Q. Well, all right, what are they?

A. As I said before, I don't remember the different—all the names of the different chemistries, but I remember consulting a good many chemical books in regard to phosphate rock.

Q. Tell us who they are. A. I can't remember.

Q. None of them?

A. Well, I think Witthouse was one.

Q. Who else?

A. And an old chemistry called Cook's Chemical Philosophy.

Q. On Phosphate?

A. I read that part of chemistry that applies to phosphate rock, phosphates and phosphorus.

Q. And phosphorus. That is something in your general study of chemistry?

A. No; I say I looked this up when I was studying this phosphate rock question.

Q. In what book?

A. I made special reference to that in that report.

Q. Any other books?

A. And I think Remsen's Chemistry.

